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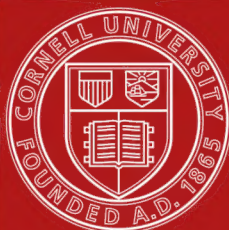
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**Patent cases determined in the Supreme C**



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# PATENT CASES

DETERMINED IN THE

SUPREME COURT OF THE UNITED STATES,

INCLUDING

COPYRIGHT AND TRADE-MARK CASES,

AND A

TABLE OF ALL AMERICAN PATENT, COPYRIGHT, AND  
TRADE-MARK CASES WHICH HAVE BEEN CITED,  
AFFIRMED, OR REVERSED.

BY

CHARLES SIDNEY WHITMAN,

AUTHOR OF "PATENT LAWS AND PRACTICE OF OBTAINING LETTERS PATENT FOR INVENTIONS."

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"The doctrine of Patents may truly be said to constitute the metaphysics  
of the law."—STORY.

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DALLAS, CRANCH, WHEATON, PETERS, AND HOWARD.

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VOLUME I.

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WASHINGTON, D. C. :

W. H. & O. H. MORRISON,

*Law Booksellers and Publishers.*

1878.

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## PREFACE.

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As the Supreme Court of the United States possesses appellate jurisdiction in all actions arising under the Patent Laws, without regard to the sum in controversy, its adjudications are of paramount importance to those interested in this rapidly-growing branch of our national jurisprudence.

These volumes contain all cases relating to Letters Patent for Inventions, Copyrights, and Trade-marks decided by the Court since its organization, and heretofore only to be found scattered through the volumes comprising the Reports of Dallas, Cranch, Wheaton, Peters, Howard, Black, and Wallace.

The first volume includes all decisions of the Court made prior to the December Term of 1861, and reported in the volumes of Dallas, Cranch, Wheaton, Peters, and Howard. The second comprises all cases contained in the two volumes of Black's Reports and twenty volumes of the Reports of Wallace. It also contains, among other useful addenda, a Table of all American Patent, Copyright, and Trade-mark Cases which have been Cited, Approved, Explained, Doubted, Disapproved, Overruled, or Reversed in the Reports of the Federal and State Courts.

In preparing this Table, the author has endeavored to supply a want which has long been felt, and feels confident that his labors will be appreciated by those who are aware of the difficulties and doubts which arise in examining the adjudicated cases relating to Patents, and who are ready to avail themselves of all means within their reach in reconciling conflicting decisions and settling doubtful questions.

It is believed that this Table will prove an indispensable auxiliary to the Digests, as it will enable the practitioner to ascertain at a glance whether a decision has been Overruled, Doubted, Explained, Qualified, or Affirmed, and to trace a principle through the books from its origin to its latest development.

It is proposed to issue a third volume as soon as a sufficient number of cases have been decided to justify its publication, to which will be added an Appendix, containing explanatory notes on all Patent, Copyright, and Trade-mark cases decided by the Court since its organization.

CHARLES SIDNEY WHITMAN.

WASHINGTON, D. C., 1878.





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PATENT CASES

DECIDED IN THE

SUPREME COURT

OF

THE UNITED STATES.

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TYLER ET AL. v. TUEL.

(6 Cranch, 324.)

An assignee of part of a patent-right cannot maintain an action on the case for a violation of the patent under the act of 1793.

THIS was a case certified from the Circuit Court of the District of Vermont.

Tyler and others, as assignees of Benjamin Tyler, the original patentee of an improvement in grist-mills, which he called the *wry-fly*, or side-wheel.

After a verdict for the plaintiffs, the judges of the court below, upon a motion in arrest of judgment, were divided in opinion upon the question "whether the plaintiffs, by their own showing, are legal assignees to maintain this action."

There were two counts in the declaration.

The first set forth the substance of the statutes upon the subject of patents for useful discoveries, the facts necessary to entitle the patentee to a patent for his invention, and the patent itself, together with the specification, dated February 20, 1800.

The averment of the assignment of the patent-right to the plaintiffs was in these words: "And the plaintiffs further say, that the said Benjamin Tyler, afterwards, to wit, on the 15th day of May, in the year last aforesaid, at said Claremont, by his certain deed of that date, by him signed, sealed, and to the plaintiffs then and there by the said Benjamin delivered, and ready to be shown to the court,

## Argument for the defendant.

did, in consideration of the sum of six thousand dollars, to him before that time by the plaintiffs paid, grant, bargain, sell, assign, and set over to the plaintiffs, their executors, administrators, and assigns, all the right, title, and privilege in, unto, and over the said improvement in the said patent described, and thereby vested in the said Benjamin, in any part of the United States, *excepting* in the counties of Chittenden, Addison, Rutland, and Windham, in the State of Vermont."

The second count, omitting the recital of the statutes and of the patent, stated concisely the same facts. The averment of the assignment of the patent-right was as follows: "And the said Benjamin Tyler, afterwards, and before the expiration of the said fourteen years, to wit, at said Claremont, on the 15th day of May, in the year last aforesaid, by his certain deed of that date by him then and there signed, sealed, and to the plaintiffs delivered, assigned to the plaintiffs the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said improvement, in and throughout the United States, *excepting* in the counties of Chittenden, Addison, Rutland, and Windham, in the State of Vermont, as fully and amply as by said letters patent the said Benjamin Tyler was thereto entitled, and all his title and interest in and unto said improvement, *excepting* as aforesaid."

*Hubbard, for the defendant*, contended that the assignment, being of part of the patent-right only, was not such as would authorize the assignees to maintain an action on the statute. Laws U. S., vol. 2. p. 202, §§ 4, 5.

The fourth section of the act declares, "That it shall be lawful for any inventor, his executor or administrator, to assign *the* title and interest in the said invention, at any time, and *the* assignee, having recorded the said assignment in the office of the Secretary of State, shall thereafter *stand in the place of the original inventor*, both as to right and responsibility, and so the assignees of assigns to any degree."

The fifth section provides, "That if any person shall make, devise, and use, or sell the thing so invented, the exclusive right of which shall, as aforesaid, have been secured to any person by patent, without the consent of the patentee, his executors, administrators, or assigns, first obtained in writing, every person so offending shall forfeit and pay to the patentee a sum that shall be at least equal to three times the price for which the patentee has usually sold or licensed to other persons the use of the said invention; which may be recovered in an

action on the case, founded on this act, in the Circuit Court of the United States, or any other court having competent jurisdiction."

It is evident from the whole purview of the statute, especially from the fourth, fifth, sixth, and tenth sections, that no person can be considered as an assignee, under the statute, who is not the assignee of the *whole* right of the original patentee.

*Rodney, Attorney-General, contra.*

Upon a motion in arrest of judgment, if the judges are divided the motion fails, and the judgment must be entered of course. It must follow the verdict, unless sufficient cause be shown to the contrary. 1 Salk., 17; Ld. Raym., 271; 3 Mod., 156.

If there can be no assignment but of the whole right, then the exception of particular counties is void, it being repugnant to the prior words and intention of the grant.

So if the jury find a fact inconsistent with a fact previously found, the latter fact shall be rejected. Cro. Car., 130; 3 East; 6 Bac. Abr., 381; Plowd., 564; 1 Bl. Com., 89; 2 Co., 83; 8 Co., 56; Dyer, 351; 1 Co., 3; 1 Vent., 521; Cro. Eliz., 244.

The whole passed at law by the deed of assignment. The exceptions are in the nature of equitable assignments.

On a subsequent day, the court directed the following opinion to be certified to the Circuit Court for the District of Vermont, viz.:

It is the opinion of the court, that the plaintiffs, by their own showing, are not legal assignees to maintain this action in their own names, and that the judgment of the Circuit Court be

ARRESTED.

---

### EVANS v. JORDAN AND MOREHEAD.

(9 Cranch, 199.)

The act of January, 1808, for the relief of Oliver Evans, does not authorize those who erected his machinery between the expiration of his old patent and the issuing of the new one, to use it after the issuing of the latter.

[TODD, J.—Absent.]

THIS was a case certified from the Circuit Court for the District of Virginia, in which the judges were divided in opinion upon the question whether, after the expiration of the original patent granted to Oliver Evans, a general right to use his discovery was not so



## Argument for the defendant.

vested in the public as to require and justify such a construction of the act, passed in January, 1808, entitled "An act for the relief of Oliver Evans," as to exempt from either single or treble damages the use, subsequent to the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent, and previous to the passage of the said act. The act (vol. 9, p. 20) authorizes the Secretary of State to issue letters patent to Oliver Evans, in the manner and form prescribed by the general Patent Law, granting to him for the term of fourteen years the exclusive right of making, using, and vending for use the machinery in question: "provided, that no person who may have heretofore paid the said Oliver Evans for license to use his said improvements shall be obliged to renew the said license, or be subject to damages for not renewing the same; and provided also, that no person who *shall have* used the said improvements, or *have* erected the same for use, before the issuing of the said patent, shall be liable to damages *therefor*."

*Harper, for the plaintiff.*

The former patent of the plaintiff having expired, Congress, in consideration of the particular circumstances of his case, authorized a new patent to issue for another term of fourteen years. Between the expiration of the old and the issuing of the new patent, the defendants had erected and used and continued to use the plaintiff's machinery in the manufacture of flour, contending that they were protected by the proviso of the act of January 21, 1808.

We contend that the proviso does not authorize them to continue the use of the machinery after the issuing of the new patent, but merely protects them from damages for *having* used and for *having* erected for use the machinery in question *prior* to the issuing of the new patent.

The second patent was intended to place Evans in the situation in which he would have been if the first patent had continued in force, except as to his right to damages for acts done in the intermediate time between the first and second patent. If the defendants chose to continue to use the machinery after the new patent, they were bound to pay for the right to use it.

*E. J. Lee and P. B. Key, contra.*

If the construction contended for on the other side be correct, the proviso was wholly useless, because the defendants needed no such protection. Evans could have no claim against them for acts done

## Opinion of the court.

after his patent had expired and before the issuing of the new patent. The defendants had a full and perfect right to erect and use the machinery. A law to oblige them now to abandon their property, or to pay what Mr. Evans may choose to exact, is in the nature of an *ex post facto* law; and although it may not be absolutely unconstitutional, yet is so far within the spirit of the Constitution that this court will not give such a construction to the proviso, if it can possibly be avoided. The proviso says that no person *who shall have erected the machinery for use* shall be liable to damages therefor. The defendants *had* erected the machinery for use, and are consequently not liable therefor. What can the proviso mean, unless to give those who are in the situation of the defendants the right to use their own machines, lawfully erected? The inventions had become public property; every one had a right to use them. Congress did not mean to take away that vested right from those who had availed themselves of it. To deprive a person of the *use* of his property is equivalent to depriving him of the property itself. Congress could not mean to do this. This court will give the act such an equitable construction as will give effect to the proviso.

*Harper, in reply.*

The words of the proviso are clear and explicit, and admit not of construction. The legislature may have supposed that the new patent, which was intended to be a continuation of the old one, might have subjected those who had already erected the machinery to damages, and intended to guard against them. It is not certain that under the law under which the patent issued this would not have been the effect; but it is sufficient if the legislature supposed it would have been. We are not bound to show the motives of the legislature; if their words are clear and explicit, there is no room for construction. The acts which are protected by the proviso are acts done *before* the issuing of the patent; the opposite counsel contend that the legislature, when they said "*before*," meant *after*. The proviso is too plain to bear an argument.

[TODD, J.—Absent. March 4th.]

WASHINGTON, J., delivered the opinion of the court.

The question certified to this court by the Circuit Court for the District of Virginia, and upon which the opinion of this court is required, is, whether, after the expiration of the original patent granted to Oliver Evans, a general right to use his discovery was not so vested in the public as to require and justify such a construc-

## Opinion of the court.

tion of the act, passed in January, 1808, entitled "An act for the relief of Oliver Evans," as to exempt from either treble or single damages the use, subsequent to the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent, and previous to the passage of the said act.

The act—upon the construction of which the judges of the Circuit Court were opposed in opinion—directs a patent to be granted, in the form prescribed by law, to Oliver Evans for fourteen years, for the full and exclusive right of making, constructing, using, and vending to be used his invention, discovery, and improvements in the art of manufacturing flour and meal, and in the several machines which he has discovered, invented, improved, and applied to that purpose.

The *proviso* upon which the question arises is in the following words: "Provided, that no person who may have heretofore paid the said Oliver Evans for license to use the said improvements shall be obliged to renew said license, or be subject to damages for not renewing the same; and provided also, that no person who shall have used the said improvements, or have erected the same for use, before the issuing of the said patent, shall be liable to damages therefor."

The language of this last proviso is so precise, and so entirely free from all ambiguity, that it is difficult for any course of reasoning to shed light upon its meaning. It protects against any claim for damages which Evans might make, those who may have used his improvements, or who may have erected them for use, *prior to the issuing of his patent* under this law. The protection is limited to acts done prior to another act thereafter to be performed, to wit, the issuing of the patent. To extend it, by construction, to acts which might be done subsequent to the issuing of the patent, would be to make, not to interpret, the law.

The injustice of denying to the defendants the use of machinery which they had erected after the expiration of Evans's first patent, and prior to the passage of this law, has been strongly urged as a reason why the words of this proviso should be so construed as to have a prospective operation. But it should be recollected that the right of the plaintiff to recover damages for using his improvement after the issuing of the patent under this law, although it had been erected prior thereto, arises, not under this law, but under the general law of the 21st of February, 1793.\* The provisos in this law

\*The fifth section of the act of 21st of February, 1793, which is the only section of that act which gives damages for violation of the patent-right, is repealed by

profess to protect, against the operation of the general law, three classes of persons: those who had paid Evans for a license prior to the passage of the law, those who *may have used* his improvements, and those who *may have erected* them for use, before the issuing of the patent.

The legislature might have proceeded still further, by providing a shield for persons standing in the situation of these defendants. It is believed that the reasonableness of such a provision could have been questioned by no one. But the legislature have not thought proper to extend the protection of these provisos beyond the issuing of the patent under that law, and this court would transgress the limits of judicial power by an attempt to supply, by construction, this supposed omission of the legislature. The argument, founded upon the hardship of this and similar cases, would be entitled to great weight, if the words of this proviso were obscure and open to construction. But considerations of this nature can never sanction a construction at variance with the manifest meaning of the legislature, expressed in plain and unambiguous language.

The argument of the defendants' counsel—that, unless the construction they contend for be adopted, the proviso is senseless and inoperative—is susceptible of the same answer.

Whether the proviso was introduced from abundant caution, or from an opinion really entertained by the legislature that those who might have erected these improvements, or might have used them prior to the issuing of the patent, would be liable to damages for having done so, it is impossible for this court to say. It is not difficult, however, to imagine a state of things which might have afforded some ground for such an opinion.

Although this court has been informed that the judge who delivers this opinion knows that the former patent given to Evans had been adjudged to be void by the Circuit Court of Pennsylvania prior to the passage of this law, yet that fact is not recited in the law, nor does it appear that it was within the view of the legislature; and if that patent-right had expired by its own limitation, the legislature might well make it a condition of the new grant that the patentee should not disturb those who had violated the former patent. This idea was certainly in the mind of the legislature which passed the act of the 21st of February, 1793, which, after repealing the act of the 10th of April, 1790, preserves the rights of patentees under the

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the fourth section of the act of the 17th of April, 1800, vol. 5, p. 90, the third section of which act gives treble damages for the violation of any patent granted pursuant to that act, or the act of 1793.

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Syllabus.

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repealed law only in relation to violations committed after the passage of the repealing law.

If the decision above mentioned was made known to the legislature, it is not impossible but that a doubt might have existed whether the patent was thereby rendered void *ab initio*, or from the time of rendering the judgment; and if the latter, then the proviso would afford a protection against all preceding violations. But, whatever might be the inducements with the legislature to limit the proviso under consideration, as we find it, this court cannot introduce a different proviso, totally at variance with it in language and intention.

It is the unanimous opinion of this court, that the act passed in January, 1808, entitled "An act for the relief of Oliver Evans," ought not to be construed as to exempt from either treble or single damages the use, subsequent to the passage of the said act, of the machinery therein mentioned, which was erected subsequent to the expiration of the original patent and previous to the passage of the said act. Which opinion is ordered to be certified to the Circuit Court for the District of Virginia.

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EVANS v. EATON.

(3 Wheaton, 454.)

1. Under the 6th section of the Patent Law of 1793, ch. 156, the defendant pleaded the general issue, and gave notice that he would prove at the trial that the machine, for the use of which, without license, the suit was brought, had been used previous to the alleged invention of the plaintiff, in several places which were specified in the notice, or in some of them, "and also at sundry other places in Pennsylvania, Maryland, and elsewhere in the United States." The defendant having given evidence as to some of the places specified, offered evidence as to others not specified: *Held*, That this evidence was admissible. But the powers of the court, in such a case, are sufficient to prevent, and will be exercised to prevent, the patentee from being injured by surprise.
2. Testimony, on the part of the plaintiff, that the persons, of whose prior use of the machine the defendant had given evidence, had paid the plaintiff for licenses to use the machine since his patent, ought not to be absolutely rejected, though entitled to very little weight.
3. *Quære*. Whether, under the general Patent Law, improvements on different machines can be comprehended in the same patent, so as to give a right to the exclusive use of several machines separately, as well as a right to the exclusive use of those machines in combination?
4. However this may be, the act of the 21st of January, 1808, ch. 117, "for the relief of Oliver Evans," authorizes the issuing to him of a patent for his invention, discovery, and improvements in the art of manufacturing flour, and in the several machines applicable to that purpose.

## Statement of the case.

5. *Quære*. Whether Congress can constitutionally decide the fact that a particular individual is an author or inventor of a certain writing or invention, so as to preclude judicial inquiry into the originality of the authorship or invention?
6. Be this as it may, the act for the relief of Oliver Evans does not decide that fact, but leaves the question of invention and improvement open to investigation under the general Patent Law.
7. Under the sixth section of the Patent Law, ch. 156, if the thing secured by patent had been in use, or had been described in a public work, anterior to the supposed discovery, the patent is void, whether the patentee had a knowledge of this previous use or description or not.
8. Oliver Evans may claim, under his patent, the exclusive use of his inventions and improvement in the art of manufacturing flour and meal, *and* in the several machines which he has invented, *and* in his improvement on machines previously discovered. But where his claim is for an improvement on a machine, he must show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists.
9. The act for the relief of O. E. is grafted on the general Patent Law, so as to give him a right to sue in the Circuit Court for an infringement of his patent-rights, although the defendant may be a citizen of the same State with himself.

## ERROR to the Circuit Court for the District of Pennsylvania.

This was an action brought by the plaintiff in error against the defendant in error, for an alleged infringement of the plaintiff's patent-right to the use of his improved *hopper-boy*, one of the several machines discovered, invented, improved, and applied by him to the art of manufacturing flour and meal, which patent was granted on the 22d January, 1808. The defendant pleaded the general issue, and gave the notice hereafter stated. The verdict was rendered, and judgment given thereupon for the defendant in the court below; on which the cause was brought, by writ of error, to this court.

At the trial in the court below, the plaintiff gave in evidence the several acts of Congress entitled, respectively, "An act to promote the progress of useful arts, and to repeal the acts heretofore made for that purpose;" "An act to extend the privilege of obtaining patents, for useful discoveries and inventions, to certain persons therein mentioned, and to enlarge and define penalties for violating the rights of patentees;" and "An act for the relief of Oliver Evans;" the said Oliver's petition to the Secretary of State for a patent, and the patent thereupon granted to the said Oliver, dated the twenty-second day of January, in the year 1808; and further gave in evidence, that an agent for the plaintiff wrote a note to the defendant, in answer to which he called on the agent at Chambersburg, at the house of Jacob Snyder, on the ninth of August, 1813; there were a number of millers present; the defendant then told the agent that

## Statement of the case.

he had got Mr. Evans's book, a plate in the *Millwright's Guide*, and if the agent would take forty dollars the defendant would give it him; the defendant said that his hopper-boy was taken from a plate in Mr. Evans's book; he said he would give no more, alleging that the hundred dollars the agent asked was too much; that the stream on which his mill was, was a small head of Conogochagee. The agent then declared that, if the defendant would not pay him by Monday morning, he would commence a suit in the Circuit Court.

The plaintiff further gave in evidence, that another agent for the plaintiff was in the defendant's mill on the second of November, 1814, and saw a hopper-boy there, on the principles and construction of the plaintiff's hopper-boy. This witness had heard that a right was obtained under Pennsylvania, but did not know of any rights under Pennsylvania sold by the plaintiff, and did not know that it was erected in any mill after the patent under Pennsylvania. The defendant's hopper-boy had an upright shaft, with a leading arm, in the first place, and a large arm inserted with flights, and leading lines, and sweepers; a little board for the purpose of sweeping the meal in the bolting hoppers, and spreading it over the floor; a balance weight, to cause the arms to play up and down lightly over the meal. The leading arms are about five feet long, and seem to be in proportion, the arm about fourteen, and the length of the sweep about nine inches. And the defendant, having previously given the plaintiff written notice that upon the trial of the cause the defendant would give in evidence, under the general issue, the following special matter,—to wit: “1st. That the improved hopper-boy, for which, *inter alia*, the plaintiff in his declaration alleges he has obtained a patent, was not originally discovered by the patentee, but had been in use anterior to the supposed discovery of the patentee, in sundry places, to wit, at the mill of George Fry and Jehu Hollingsworth, in Dauphin county, Pennsylvania; at Christian Stauffer's mill, in Warwick township, Lancaster county, State of Pennsylvania; at Jacob Stauffer's mill, in the same county; at Richard Downing's mill, in Chester county, Pennsylvania; at Buffington's mill, on the Brandywine; at Daniel Houston's mill, in Lancaster county, Pennsylvania; at Henry Stauffer's mill, in York county, Pennsylvania; and at Dihl's mill, in the same county, or at some of the said places, and also at sundry other places in the said State of Pennsylvania, the State of Maryland, and elsewhere in the United States. 2d. That the patent given to the plaintiff, as he alleges in his declaration, is more extensive than his discovery or invention: for that certain parts of the machine in said patent, called an improved *hopper-boy*, and which the plain-

tiff claims as his invention and discovery, to wit, the upright shaft, arms, and flights, and sweeps, or some of them, and those parts by which the meal is spread, turned, and gathered at one operation, and also several other parts, were not originally invented and discovered by him, but were in use prior to his said supposed invention or discovery, to wit, at the places above mentioned, or some of them. 3d. That the said patent is also more extensive than the plaintiff's invention or discovery: for that the application of the power that moves the mill or other principal machine to the hopper-boy is not an original invention or discovery of the plaintiff, but was in use anterior to his supposed invention or discovery, to wit, at the places above mentioned, or some of them. 4th. That the said patent is void, because it purports to give him an exclusive property in an improvement in the art of manufacturing meal by means of a certain machine termed an improved hopper-boy, of which the said plaintiff is not the original inventor or discoverer, parts of the machine in the description thereof referred to by the patent having been in use anterior to the plaintiff's said supposed discovery, to wit, at the places above mentioned, or some of them; and the said patent and description therein referred to contains no statement, specification, or description by which those parts, so used as aforesaid, may be distinguished from those of which the said plaintiff may have been the inventor or discoverer, protesting at the same time that he has not been the inventor or discoverer of any of the parts of the said machine. 5th. That the improved elevator described in the declaration, or referred to therein, was not originally discovered by the plaintiff, but was, anterior to his said supposed discovery or invention, described in certain public works, or books, to wit, in *Shaw's Travels*; in the first volume of the *Universal History*; in the first volume of *Mormer's Husbandry*; in *Ferguson's Mechanics*; in *Bossuet's Historie des Mathematiques*; in *Wolf's Cours des Mathematiques*; in *Desagulier's Experimental Philosophy*, and in *Proney's Architecture Hydraulique*, or some of them. 6th. That the said patent is more extensive than the invention or discovery of the plaintiff, because certain parts of the machine called an improved elevator were, anterior to the plaintiff's said supposed invention or discovery, described in certain public works or books, to wit, the works or books above mentioned, or some of them; and that the said patent is void, because it neither contains nor refers to any specification or description by which the parts so before described in the said public works may be distinguished from those parts of which the plaintiff may be the inventor or discoverer, protesting, at the same time, that he has not been the inventor or



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discoverer of any of the parts of the said machine,"—gave in evidence the existence of hopper-boys, prior to the plaintiff's alleged discovery, at sundry mills in the State of Pennsylvania mentioned in the said notice; and further offered to give in evidence the existence of hopper-boys, prior to the plaintiff's alleged discovery, at sundry other mills in the State of Pennsylvania not mentioned in the said notice; and the counsel for the plaintiff objected to the admission of any evidence of the existence of hopper-boys in the said mills not mentioned in the said notice. But the court decided that such evidence was competent and legal. To which decision the counsel for the plaintiff excepted. The plaintiff, after the above evidence had been laid before the jury, offered further to give in evidence, that certain of the persons mentioned in the defendant's notice as having hopper-boys in their mills, and also certain of the persons not mentioned in the said notice, but of whom it has been shown by the defendant that they had hopper-boys in their mills, had, since the plaintiff's patent, paid the plaintiff for license to use his improved hopper-boy in the said mills respectively. But the counsel for the defendant objected to such evidence as incompetent and illegal, and the court refused to permit the same to be laid before the jury. To which decision the plaintiff's counsel excepted.

The court below charged the jury that the patent contained no grant of a right to the several machines, but was confined to the improvement in the art of manufacturing flour by means of those machines; and that the plaintiff's claim must, therefore, be confined to the right granted, such as it was. That it had been contended that the schedule was part of the patent, and contained a claim to the invention of the peculiar properties and principles of the hopper-boy as well as the other machines. But the court was of opinion that the schedule is to be considered as part of the patent, so far as it is descriptive of the machines, but no farther; and even if this claim had been contained in the body of the patent, it would have conferred no right which was not granted by that instrument.

The court further proceeded to instruct the jury that the law authorized the President to grant a patent for the exclusive right to make, construct, use, and vend to be used any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement in any art, machine, &c., not known or used before the application. As to what constitutes an improvement, it is declared that it must be in the principle of the machine, and that a mere change in the form or proportions of any machine shall not be deemed a discovery. Previously to obtaining the patent, the appli-

cant is required to swear or affirm that he verily believes that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent; and he must also deliver a written description of his invention, and of the manner of using it, so clearly and exactly as to distinguish the same from all other things before known, and to enable others skilled in art to construct and use the same. That from this short analysis of the law, the following rules might be deduced: 1st. That a patent may be for a new and useful art; but it must be practical; it must be applicable and referable to something by which it may be proved to be useful; a mere abstract principle cannot be appropriated by patent. 2d. The discovery must not only be useful, but *new*; it must not have been known or used before in any part of the world. It was contended, by the plaintiff's counsel, that the title of the patentee cannot be impeached, unless it be shown that he *knew* of a prior discovery of the same art, machine, &c.; and that *true* and *original* are synonymous terms in the intention of the legislature. But, as it was not pretended that those terms meant the same thing in common parlance, neither was it the intention of the legislature to use them as such. The first section of the law, referring to the allegations of the application for a patent, speaks of the discovery as something "not known or used before the application"; and in the sixth section it is declared that the defendant may give in evidence that the thing secured by patent was not *originally* discovered by the patentee, but had been in use, or had been described in some public work, *anterior* to the *supposed* discovery. 3d. If the discovery be of an improvement only, it must be an improvement in the principle of a machine, art, or manufacture before known or used; if only in the form or proportion, it has not the merit of a discovery which can entitle the party to a patent. 4th. The grant can only be for the discovery as recited and described in the patent and specification. If the grantee is not the original discoverer of the art, machine, &c., for which the grant is made, the whole is void. Consequently, if the patent be for the whole of the machine, and the discovery were of an improvement, the patent is void. 5th. A machine or an improvement may be new, and the proper subject of a patent, though the parts of it were before known and in use. The combination, therefore, of old machines, to produce a new and useful result, is a discovery for which a patent may be granted.

The above principles would apply to most of the questions that had been discussed. It was strongly insisted upon, by the defendant's counsel, that this patent is broader than the discovery; the evidence

proving that, in relation to the hopper-boy, for the using of which this suit is brought, the plaintiff can pretend to no discovery beyond that of an improvement in a machine known and used before the alleged discovery of the plaintiff. This argument proceeded upon the supposition that the plaintiff had obtained a patent for the hopper-boy, which was entirely a mistake. The patent was "for an improvement in the art of manufacturing flour," by means of a hopper-boy and four other machines described in the specification, and not for either of the machines so combined and used. That the plaintiff is the original discoverer of this improvement, was contested by no person, and, therefore, it could not, with truth, be alleged that the patent is broader than the discovery, or that the plaintiff could not support an action on this patent against any person who should use the whole discovery.

But could he recover against a person who had made or used one of the machines which in part constitutes the discovery? The plaintiff insisted that he could, because, having a right to the whole, he is necessarily entitled to the parts of which that whole is composed. Would it be seriously contended that a person might acquire a right to the exclusive use of a machine, because when used in combination with others a new and useful result is produced, which he could not have acquired independent of that combination? If he could, then if A were proved to be the original inventor of the hopper-boy, B of the elevator, and so on as to the other machines, and either had obtained patents for their respective discoveries, or chose to abandon them to the public, the plaintiff, although it was obvious he could not have obtained separate patents for those machines, might nevertheless deprive the original inventors, in the first instance, and the public, in the latter, of their acknowledged right to use those discoveries, by obtaining a patent for an improvement consisting in a combination of those machines to produce a new result.

The court further charged the jury that it was not quite clear that this action could be maintained, although it was proved beyond all controversy that the plaintiff was the original inventor of this machine. The patent was the foundation of the action, and the gist of the action was the violation of a right which that instrument had conferred. But the exclusive right of the hopper-boy was not granted by this patent, although this particular machine constitutes a part of the improvement of which the plaintiff is the original inventor, and it is for this improvement, and this only, that the grant is made. If the grant, then, was not in this particular machine, could it be

sufficient for the plaintiff to prove, in this action, that he was the original inventor of it?

Again, could the plaintiff have obtained a separate patent for the hopper-boy, in case he were the original inventor of it, without first swearing or affirming that he was the true inventor of that machine? Certainly not. Has the plaintiff then taken, or could he have taken, such an oath in this case? Most assuredly he could not; because the prescribed form of the oath is, that he is the inventor of the art, machine, or manufacture for which he solicits a patent. But since the patent which he solicited was not for the hopper-boy, but for an improvement in the manufacture of flour, he might, with safety, have taken the oath prescribed by law, although he knew at the time that he was not the true inventor of the hopper-boy; and thus it would happen that he could indirectly obtain the benefit of a patent-right to the particular machine, which he could not directly have obtained without doing what, it must be admitted, in this case he had not done.

But this was not all. If the law had provided for fair and original discoverers a remedy when their rights are invaded by others, it had likewise provided corresponding protection to others, where he has not the merit. What judgment could the District Court have rendered upon a *scire facias* to repeal this patent, if it had appeared that the plaintiff was not the true and original inventor of the hopper-boy? Certainly not that which the law has prescribed, namely, the repeal of the patent; because it would be monstrous to vacate the whole patent, for an invention of which the patentee was the acknowledged inventor, because he was not the inventor of one of the constituent parts of the invention, for which no grant is made. But the court would have no alternative but to give such a judgment, or, in effect, to dismiss the *scire facias*; and if the latter, then the plaintiff would have beneficially the exclusive right to a machine which could not be impeached in the way prescribed by law, although it should be demonstrated that he was not either the true or the original inventor of it. And supposing the jury should be of opinion, and so find, that the plaintiff was not the original inventor of this machine, would not the court be prevented from declaring the patent void, under the provisions of the sixth section of the law, for the reason assigned why the District Court could not render judgment upon a *scire facias*? Indeed, it might well be doubted whether the defense now made by the defendant could be supported at all in this action, (if this action could be maintained,) inasmuch as the defendant cannot allege, in the words of the sixth section, *that the thing secured by*

## Statement of the case.

*patent* was not originally discovered by the patentee, since, in point of fact, the thing patented was originally discovered by the patentee, although the hopper-boy may not have been so discovered. But if this defense could not be made, did not that circumstance afford a strong argument against this action? If the plaintiff was not the inventor of the parts, he had no right to complain that they were used by others, if not in a way to infringe his right to their combined effect. If he was the original inventor of the parts which constitute the whole discovery, or any of them, he might have obtained a separate patent for each machine of which he was the original inventor.

Upon the whole, although the court gave no positive opinion upon this question, they stated that it was not to be concluded that this action could be supported, even if it were proved that the plaintiff was the original inventor of the hopper-boy. But if an action would lie upon this patent for violation of the plaintiff's right to the hopper-boy, still the plaintiff could not recover, if it had been shown to the satisfaction of the jury that he was not the original discoverer of that machine.

It appeared, by the testimony of the defendant's witnesses, that Stauffer's hopper-boy was in use many years before the alleged discovery of the plaintiff; that the two machines differed from each other very little in form, in principle, or in effect. They were both worked by the same power which works the mill; and they both stir, mix, cool, dry, and conduct the flour to the bolting-chest. Whether the flights and sweepers in the plaintiff's hopper-boy were preferable to the slips attached to the under part of the arm in Stauffer's, or whether, upon the whole, the former is a more perfect agent in the manufacture of flour than the latter, were questions which the court would not undertake to decide; because, unless the plaintiff was the original inventor of the hopper-boy, although he had obtained a separate patent for it, he could not recover in this action, however useful the improvement might be which he had made in that machine. If the plaintiff had obtained a patent for his hopper-boy, it would have been void, provided the jury should be of opinion, upon the evidence, that this discovery did not extend to the whole machine, but merely to an improvement on the principle of an old one, and if this should be their opinion in the present case, the plaintiff could not recover.

It had been contended, by the plaintiff's counsel, that the defendant, having offered to take a license from the plaintiff, if he would consent to reduce the price of it to forty dollars, he was not at liberty to deny that the plaintiff is the original inventor of this machine. This argument had no weight in it, not merely because the offer was

## Argument for the plaintiff.

rejected by the plaintiff's agent, and was, therefore, as if it had not been made, but because the law prevents the plaintiff from recovering, if it appear on the trial that he was not the original inventor. If the offer amounted to an acknowledgment that the plaintiff was the original inventor, (and further it could not go,) this might be used as evidence of that fact, but it would not entitle the plaintiff to a verdict if the fact proved to be otherwise.

The plaintiff's counsel had also strongly insisted that, under the equity of the tenth section of the law, the defense set up in this case ought not to be allowed after three years from the date of the patent. This argument might, perhaps, with some propriety, be addressed to the legislature, but was improperly urged to the court. The law had declared that in an action of this kind the defendant may plead the general issue, and give in evidence that the plaintiff was not the original inventor of the machine for which the patent was granted. The legislature has not thought proper to limit this defense in any manner; and the court could not do it.

But what seemed to be conclusive of this point was, that the argument would tend to defeat altogether the provision of the sixth section, which authorizes this defense to be made; for, if it could not be set up after three years from the date of the patent, it would be in the power of the patentee to avoid it altogether, by forbearing to bring suits until after the expiration of that period. And thus, although the law has carefully provided two modes of vacating a patent improvidently granted, the patentee, though not the original inventor, and however surreptitiously he may have obtained his patent, may secure his title to the exclusive use of another's invention, if he can for three years avoid an inquiry into the validity of his title.

The last point was, that Stauffer's invention was abandoned, and, consequently, might be appropriated by the plaintiff. But if Stauffer was the original inventor of the hopper-boy, and chose not to take a patent for it, it became public property by his abandonment; nor could any person obtain a patent for it, because no other person would be the original inventor.

To this charge the plaintiff's counsel excepted.

February 26. *Mr. C. J. Ingersoll, for the plaintiff*, premised, that this patent granted an exclusive right for fourteen years in the improvement in the art, by means of the five machines, and for the several machines; the peculiar properties of each in its practical results, and the improvement of the art by the combination of the

## Argument for the plaintiff.

whole. The proof of this position is, that the defendant uses the precise machine, copied by the plaintiff's application, and offered to pay for it; but they differed in price, which led to the contesting the originality of the plaintiff's invention.

1. It is said, in the charge of the court below, that the action is founded on the patent, which contains no grant of a right to the several machines, but is confined to the improvement in the art by means of those machines. The patent is to be made out in the manner and form prescribed by the general act. What are the manner and form? By reciting the allegations and suggestions of the petition, giving a short description of the invention or discovery, and *thereupon* granting an exclusive right in the *said invention or discovery*. The manner and form of *these* letters patent are a recital of: 1st. The citizenship of the patentee. 2d. The allegations and suggestions of the petition, as to both the improvement and the machines in a short description, referring to the annexed schedule for one more full and particular, in the inventor's own words. 3d. That he has petitioned *agreeably to the special act*. 4th. A grant of the *said* improvement. The description must be short and *referential*. It must be a *description*. By the first section of the act of the 10th of April, 1790, ch. 34, it was to be described clearly, truly, and fully; perhaps, because the board, constituted by that law, were to decide whether they deemed the discovery or invention sufficiently useful or important for letters patent. The patent, by express reference, adopts the special act *in extenso*. The connecting terms *which* and *said*, bind the whole to the granting clause; the allegations and suggestions *recited* are part of the grant; the machines are the means of *every* end, particular as well as general; nor can there be any practical result without them. To confine such a patent to one general result from a combination of the *whole* machines, nullifies it. It is never so in practice, and would operate infinite injustice in other cases. 2. But the schedule is part of the patent in *all* cases; in this case it is especially so. By the act of 1790, ch. 34, § 6, the patent or specifications are *prima facie* proof of everything which it is incumbent on the plaintiff to establish; and by the existing law, the specification is considered as explanatory of the terms used in the patent, so as to limit or enlarge the grant. *Whittemore v. Cutter*, 1 Gallis., 429. But it is said, in the grant, that the schedule annexed is made part of the patent. It is made so by the public agent, to avoid trouble, litigation, and unnecessary recitals. The petition, schedule, and description are all referred to, and incorporated with the patent. What does the law mean by a recital of allegations and suggestions? What

more can a petitioner do than allege and suggest? He cannot shape or prescribe the manner and form of the grant. The charge denies that the schedule, at any rate, is more than *descriptive* of the machines, or that it would confer any right, even if claimed in the patent. But if no right would be conferred by insertion in the grant itself, what becomes of the argument which ascribes such potency to the grant? The charge says the grant can only be for the discovery *as recited and described* in the patent and *specification*. The grant is not for the parts, because it is for the whole; not in their rudiments or elements; not for wheels, cogs, or weights, nor for wood, iron, or leather; but for the peculiar properties, the new and useful practical results from each machine, and the vast improvements from their combination in this art. The charge supposes it impossible to obtain a patent for a hopper-boy, unless the plaintiff could swear that he invented that machine. But the oath is not a material, or at least not an indispensable, prerequisite. *Whittemore v. Cutter*, 1 Gallis., 433. 3. The special act for the relief of the plaintiff decides him to be the inventor of the machines and improvements for which he has obtained a patent. By the Constitution, art. 1, § 8, Congress have power to promote the progress of science and the useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries. This has been done by Congress in the instance of the plaintiff. The special act is an absolute grant to him, binding on all the community, and precluding any inquiry into the originality of the invention. It includes a monopoly in his invention, discovery, and improvements in the art, *and* in the several machines discovered, invented, improved, and applied for that purpose. The patent is to issue on a simple application in writing by the plaintiff, without any prerequisites of citizenship, oath, fee, or petition, specification, and description to be filed. The act of 1793, ch. 156, requires all these, and then grants a patent for *invention or discovery*; whereas this grant is for that, and for *improvements* in the art, *and* in the several machines. It is a remedial act, and should receive a liberal construction to effectuate the intentions of the legislature. *Whittemore v. Cutter*, 1 Gallis., 430. The patent is as broad as the law, if the grant be governed by the recital. Its construction is to be against the grantor, and according to the intent; nor is it to be avoided by subtle distinctions;—if there are two interpretations, the sensible one is to be adopted. *Jenk. Cent.*, 138; *Eystor v. Studd*, *Plowd.*, 467; *The United States v. Fisher*, 2 Cranch, 386, 399. 4. The improved hopper-boy of the plaintiff is the only new and useful discovery which was in evidence in the case.



## Argument for the plaintiff.

The court misconstrued the law in their charge in this respect, inasmuch as the true construction of it is not that the patentee shall be the first and original discoverer of a patentable thing, but "the true inventor" of such a thing; that such a thing was truly discovered and patented without knowledge of its prior use, or public employment, or existence; more especially where, as in the present instance, the controversy is not between conflicting patents, but between the true patentee of a new and useful patentable thing, and a person defending himself against an infringement on the plea of its prior use by third persons who had no patent, and whose discovery, even if proved, was of a thing never in use or public existence, but in total disuse. The statute 21 Jac. 1, ch. 3, § 6, an. 1623, grants the monopoly "of the sole working or making of any manner of new manufactures, within this realm, to the *true* and first inventor and inventors of such manufactures, which others, at the time of making such grant, shall not use," &c. It is contended, under our law, that the *utility* is to be ascertained as well the *originality*; and that this, as well as that, is partly a question for the jury. The thing patentable must be *useful* as well as new. The *useful* thing *patented* prevails over one not useful nor patented, though in *previous* partial existence. This is not the case of conflicting patentees; and to destroy this patent, the previous *use* must appear, there being no pretense of description in a *public* work. The title of the act is "for the promotion of the *useful* arts." The first section speaks of "any new *and useful* arts," not *known or used*, &c. The sixth, of that which "had been in *use*, or described in some *public* work, anterior to the *supposed* discovery." What degree of use does the law exact?—a use *known* or described in a *public* work. Not merely an experimental, or essaying; nor a clandestine, nor obscure use. It must be useful, and in use—perhaps in *known*, if not *public* use; something equivalent to filing a specification on record. Now, here utility was lost sight of in search of novelty. It seemed to be taken for granted that proving the preëxistence of an unpatented hopper-boy defeated the plaintiff's patent. The desuetude of the rival hopper-boy from inutility was established. The question was between a new and useful patented machine, and an useless and obsolete one never patented; and which, not being *useful*, never could be patented. But that the patentee's is useful, nobody questions. At all events, the question of fact, whether in use, should have been left to the jury. The jury are substituted for the *board* which, under the first law, was to decide whether the supposed invention was "sufficiently useful and important" for a patent. The court below suppose Stauffer to have

## Argument for the defendant.

given his discovery to the public. But it fell into disuse; there was nothing to give. Stauffer did not know its value; if he had abandoned a field with unknown treasure in the ground, could he afterward claim the treasure? Grotius de J. B., ac. Pl. 3, ch. 20, § 28. 5. The defendant's testimony of the use of hopper-boys in mills not specified in his notice was erroneously admitted. The object of the provision in the sixth section of the Patent Law of 1793, ch. 156, was to simplify the proceedings, and to enable the defendant to give in evidence under his notice what he would otherwise be obliged to plead specially. The sufficiency of the notice is, therefore, to be tested by the rules of special pleading, which, though technical, are founded in good sense and natural justice, and are intended to put the adverse party on his guard as to what the other intends to rely upon in his defense. But such a notice as this could not answer that purpose. 6. The plaintiff's testimony of the payment for licenses to use his improved hopper-boy ought not to have been rejected. It ought to have been admitted as circumstantial evidence entitled to some weight.

*Mr. Hopkinson and Mr. Sergeant, contra.*

1. The admissibility of evidence of the use of the hopper-boys anterior to the plaintiff's alleged invention, in mills not specifically mentioned in the notice, depends upon the construction that may be given to the sixth section of the act of the 21st of February, 1793, ch. 156, taken in connection with the notice. This section is substituted for the sixth section of the act of the 10th of April, 1790, ch. 34. The office of the section, in each of these acts, is twofold: 1st. To state what shall constitute a defense. 2d. To state the manner in which the defendant may avail himself of it. And whatever difficulties may exist, if any there be, in the construction of the section, arise from the combination of this twofold object. That this was the object of the section, is perfectly obvious. The general issue would be a denial of the allegation contemplated by the fifth section of the act of 1793 and the fourth of the act of 1790. If the acts had stopped there, it is manifest that the defendant could have had no defense but what was legally within the scope of the general issue. The tenth section would not have availed him, because the limitation of time and the grounds for repealing a patent upon a *scire facias* are totally different from those which ought to constitute a defense to the action. The patent may be opposed in an action upon the ground that the patentee is not the *original* inventor; but it can be repealed only upon the ground that he is not the true in-

## Argument for the defendant.

ventor. Fraud (proof that it was surreptitiously obtained) is the necessary basis in the one case; but error and mistake are equally available in the other. Neither could the defendant avail himself of the provisions in the prior part of the act; for these are merely *directory*, and they terminate in the provision made by the fifth section, which would have been conclusive. The sixth section is, therefore, a proviso to the fifth. The sixth section of 1790, made the patent *prima facie* evidence only, which would have opened the inquiry as to the *truth* of the invention. It appears, then, that the object of the proviso was, in the first place, to settle what should constitute a defense. These matters would not have been within the scope of the general issue, by the rules of pleading. They would have presented the subject of a special plea in bar. The act, therefore, at the same time provides that they may be given in evidence under the general issue. The design, in this respect, was to save the necessity of special pleading on the one hand, and, on the other, to give a reasonable notice. Does the law require the *evidence* to be set out? No; and yet, if surprise is to be fully guarded against, this ought certainly to be stated, in order that the plaintiff may prove that it is false, or proceeds from corrupt witnesses, &c. Is it, then, necessary that *all the particulars* should be given—the State, county, township, town, street, square, number of the house? The law does not require it. What certainty, then, is required in the notice? The answer is obtained by ascertaining the use and intention of the section, which were to save the necessity of special pleading. What, then, must be alleged in a special plea? Not the evidence or facts, but the matter of defense, which may be that the plaintiff was not the true inventor, but that the invention was before his supposed discovery. You must state what is the ground and essence of the defense, and nothing more,—all else is surplusage: *e. g.*, that the plaintiff was not the true inventor of the hopper-boy, but the same was in use, prior to his supposed discovery, *at the mill of A*. Now, its being in use *at the mill of A* is not of the essence of the defense, for it is as good if used *at the mill of B*; the essence is, that it was used before. The defendant then would be entitled to lay the place under a *videlicet*, and of course would not be obliged to prove it, but might prove any other. If, then, the law did not mean to increase the difficulty of the defendant, the same may not be done in a notice. Consider the inconveniences of a contrary practice. A machine has been used in a foreign country; the country, town, and place may be *unknown*. Shall I, therefore, be deprived of the benefit of my invention? Again, *it is known*. I am bound to give thirty days' notice

## Argument for the defendant.

before trial, and no more. *Cui bono* that I should mention a town or place in England? The intention is, that the plaintiff shall come prepared to prove where his invention was made, and not to disprove the defendant's evidence; that he shall have notice of the *kind* of defense intended, in order that he may shape his case accordingly. If notice is given that the defendant will give in evidence that the plaintiff's machine was used before his supposed discovery, this is notice of special matter tending to prove that it was not invented by him. The law does not require a *statement* or *description* of the special matter, but notice that special matter will be given in evidence tending to prove certain facts. There is no reciprocity in the contrary rule. The declaration is general; it does not specify the *date* of the invention, the *place* of the invention, nor the *evidence* or *facts* by which the originality and truth of the invention are to be proved. Yet these are all extremely important to the defendant, to enable him to prepare this defense. As to the breach, it is equally general. It does not state the *time*, except as a mere matter of form, by which the plaintiff is not bound. It does not state the *place*, except by the very liberal description necessary for the venue, but which is not at all binding. And, finally, the rule contended for is impracticable, consistently with the purposes of justice; for it may, without any fault of the defendant, deprive him of the benefit of a perfectly good defense, upon a mere requisition of form which he cannot possibly comply with. The notice states the use of the hopper-boy at a number of mills, specially described by the State, county, and the name of the proprietor, "and at sundry other places in the said State of Pennsylvania, the State of Maryland, and elsewhere in the United States." It is not alleged, nor could it be, that the defendant had the knowledge that would have enabled him to extend the specification. Nor is it alleged that he could have acquired the knowledge, by any exertion he might have made; on the contrary, the course he has taken is indicative of perfectly fair intention. The exception is, that the defendant was permitted to give evidence that the hopper-boy "had been used at sundry other mills in Pennsylvania," precisely in the words of the notice. To sustain this exception, then, the court must decide that this cannot, in *any case*, be done. But if it cannot be shown that in a single supposable case this would work injustice, and defeat the law, it is sufficient. Now, it is very clear that in many cases this may be precisely the state of the party's knowledge, and all he can obtain, and it may be precisely the state of the *evidence*. Suppose a witness should know that hopper-boys were used in sundry mills, but not their precise local situation, name of owner, &c. Or,

## Argument for the defendant.

suppose he should have seen a hopper-boy that bore the most evident marks of having been *used* in a mill, or mills. The *effect* of such evidence is quite another question. Its competency and relevancy are for the court; its credibility and the inferences of fact that are to be made from it are for the jury. The same supposition would apply to its having been described in a public work. Is it necessary to give the title of the book, name of the author, and number of the edition? This may be impracticable. The defendant may have a witness who has seen the thing in use in a *foreign* country, and not be able to give a single particular; or who has seen it described in a foreign work, of which he can give no further account. Such evidence, if *credited*, would be entirely conclusive; and yet he could have no benefit of it, because he had not done what was impossible. But even if the witness knows all these particulars, the defendant has no means of compelling him to disclose them before the trial. The rules of pleading aim to establish a convenient certainty on the record, by giving the party notice of what is alleged, and furnishing evidence of what has been decided. In many instances, they fall short of this, their avowed design; in none do they go beyond it. For the purpose of preventing surprise, they are wholly ineffectual; they give no notice of particular facts, of evidence, of witnesses. The corrective of the evil, if evil there be, is to be found in the exercise of the general superintending authority of the court, applied to cases where there may really be surprise or fraud. So in this case; if there really had been surprise, (fraud is out of the question,) the court had the power to grant a new trial. This power is an amply sufficient corrective, and its existence affords a decisive answer to the argument drawn from the possible injustice that may be done. 2. The exception to the refusal to admit evidence of the payment for the use of licenses will be easily disposed of. The *fact* to be established on the one side, and disapproved on the other, was, that the hopper-boy was in use before the alleged invention or discovery of Evans. The evidence offered had no bearing whatever upon the question of fact. If believed, it went no farther than to show that those who had paid thought it best to pay,—a decision that might be equally prudent, whether the fact was or was not as alleged. Such testimony would be more objectionable than the opinion of the witness; for it would be only presumptive proof of opinion, without the possibility of examining its grounds. As *opinion*, it would be inadmissible; as evidence of opinion, it would still be more objectionable. 3. The plaintiff's patent can only be considered in one of three points of view: 1st. As a patent for the improvement

in the art of manufacturing flour; that is, for the combination. 2d. As a patent for the combination, and also for the several machines; that is, a joint and several patent. 3d. As a patent simply for the several machines. It is very clear that the patent itself is for the combination only; though it is equally clear that, by the terms of the law, he might have obtained a patent for the *whole*, and also for the *several parts*. That this is the necessary construction of the patent, is plain from the patent itself, taken in connection with the act of 21st of January, 1808, ch. 117. The act authorizes a patent to be issued for his *improvements* in the art of manufacturing flour, *and* in the several machines, &c. The matters are plainly different. They are the subject of distinct patents, to be obtained in the "*manner and form*" prescribed by the act of 1793, ch. 156. The object of the special act was to put Evans upon the same footing as if his former patent had not been issued; but it did not mean to dispense with any of the requisites of the general law. With the general requisite, that he was the inventor, it could not dispense; the Constitution did not permit it. By the general law, *improvement in an art* and *improvement in a machine* are distinct patentable objects. This patent is only for the improvement in the art of manufacturing flour, and the recital of the special act and the words "which" and "said" do not at all help it. It is true, it is an improvement operated by means of the machines, but not exclusively. The result may be secured without securing the means. This patent was granted to the plaintiff, was received by him, and must be presumed to be according to his application and his oath. The oath is, that he is the true inventor of the "*improvements above specified*," which *term* is applied in the specification, as in the patent, only to the *art*. But it is said the specification is a part of the patent, and limits or enlarges it, as the case may be. Mr. Justice STORY, in the case which has been cited, only says that the specification may control the generality of the patent. *Whittemore v. Cutter*, 1 Gallis., 437. But the specification in the case now before the court does not claim the machines. If the patent was for a combination, the plaintiff's action was gone; he could not maintain it against a person using one of the machines. If the patent was for the combination and also for the several machines, that is, a joint and several patent, then the patentee might proceed upon it as the one or the other, according to the nature of the alleged invasion. If he proceed upon it for a breach of the right to the combination, he must show the originality of invention, and might be defeated by opposite proof. If for a breach of the right to any one of the machines, he might be defeated by showing that he was not the origi-

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Argument for the defendant.

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nal inventor of the machine. So if it be considered a several patent—that is, as if he had five distinct patents. But in no conceivable case can he stand upon any but one of these three grounds, nor claim to have the benefit of a larger, or even of a different, patent. 4. From this analysis, which is necessary to prevent confusion, we come to inquire into the nature of the case presented to the court for decision, and to which the charge was to be applied, premising: 1st. That no exception can be taken to what the court did not give in charge to the jury; and, 2d. That no exception can be taken to an opinion, however erroneous, that had no bearing upon the issue to be decided by the jury. It is apparent from the record that the action of the plaintiff was founded upon the alleged use, by the defendant, of a machine called a hopper-boy, of which the plaintiff claimed to be the inventor; that the evidence on both sides applied to this allegation, and to this alone,—the plaintiff claiming to be the inventor, and the defendant denying it. The charge of the court noticed the several arguments that had been used at the bar, and examined the general question as to the character of the patent; upon which, however, as it had not been discussed, no opinion was given. This is clear; for if an *opinion* had been expressed, it must have been that the action was not maintainable. Nothing short of *that* would have been material. But the court left the case to the jury, as of an action that this was maintainable, and instructed them as to the principles by which it was to be decided, which negatives the conclusion of any opinion having been given that the action was not maintainable. If the defendant had required the court to charge that the action was not maintainable, and they had charged that it was, or declined to charge at all, he would have had ground of exception. But the plaintiff cannot complain, because he has what is equivalent to a decision in his favor. 5. The statute of James, (21 Jac. I., c. 3,) A. D. 1623, confined monopolies to the first and true inventors of manufactures not known or used before. One hundred and seventy years had elapsed when our act passed; commerce and the arts had made such advances, such facilities had been created for the diffusion of knowledge, that every thing known by use, or described in books, might be considered as common property. It would have been strange to adopt a different principle. The act of Congress does not. It is a mistake to suppose there is in this respect any difference between the act of Congress and the act of Parliament. One says “useful” inventions, the other “new and useful”; but both have the expression “not used or known before.” A patent can only be upon an allegation that the applicant has invented some-

## Argument for the plaintiff.

thing *new* and *useful*. Its *novelty* may certainly be questioned; perhaps its *usefulness*. But where the defense is that the thing was known or used before, is it necessary to prove the usefulness of the thing so known or used? The act does not require it; nor is there any good reason why the patentee should be permitted to controvert it.

*Mr. Harper, in reply*, insisted: 1. That the court below had erred in admitting testimony of the use of the plaintiff's machine in mills not specified in the notice. The statute was not framed with a view to the benefit of the defendant alone. The notice to be given is not that vague, indistinct, general notice which is set up on the other side. It must be an effectual, useful notice,—such a notice as may put the patentee on his guard, and enable him to see what are the precise grounds of defense. It must be more specific than a mere transcript of the particular class of grounds of defense, such as suppression of parts, redundancy, &c. The circumstances of the *time*, the *place* when and where used, and by what *persons*, are essentially necessary, in order to enable the patentee to meet the defense. The burden of proof is, in effect, thrown upon the patentee; and the law intended that he should meet it fairly. Such a notice as that given in this case would not be good, if put into the form of a special plea. The degree of certainty required in a plea, in a statement of the *time* and *place*, when and where material facts have happened, is one of the most difficult questions of the law; but these circumstances must always be laid, and must be proved as laid, whenever it is essential to enable the other party to maintain his case. There is a distinction between the *matter of defense* and the *evidence* by which it is to be maintained. A notice of the particulars of the evidence is not required, but of the time and place where the former use of the machine in question occurred. Nor is this unreasonable; for it is highly improbable that anybody would be able to testify as to the minute particulars of an invention, without being able to remember in what work he had seen it described, or to state in what place and at what time he had seen it used. 2. The special act for the plaintiff's relief is a distinct, substantive, independent grant, declaring the plaintiff to be the original inventor, and as such entitled to a patent. It contains no reference to the general Patent Law, nor does it reserve any right in others to contest the originality of his invention. The defendant, therefore, cannot say that the plaintiff is not the inventor, though he may deny that he has violated the plaintiff's rights as inventor. Congress is not confined by the Constitu-



## Argument for the plaintiff.

tion to any particular mode of determining the fact who are inventors or authors. It is true, a patent or copyright can only be granted to an inventor or author; but the originality of the invention or authorship may be determined by Congress itself, upon such testimony as it deems sufficient; or by an administrative act, by the decision of some board or executive officer; or, lastly, by a judicial investigation,—according as the legislative will may prescribe either of these several modes. The act of Parliament, 15 Geo. 3, for the relief of Watt and Boulton, the inventors of the improved steam-engine, and extending the term of their patent for twenty-five years, contained an express provision that every objection in law competent against the patent should be competent against the act, “to all intents and purposes, *except so far as relates to the term thereby granted.*” *Hornblower v. Boulton*, 8 T. R., 95–97. The act of Congress for the relief of Oliver Evans contains no such provision. The conclusion, therefore, is, that the legislature meant to *quiet* him in his claim, after he had so long enjoyed it, and in consideration of his peculiar merits, and of his former patent having been vacated for informality. 3. The court below instructed the jury that the patent was not for any one machine, but for the combined effect of the whole; though they concluded by leaving it upon the prior use, still the intimation that the action could not be maintained, even though the prior use of it was not proved, did not leave the fact to the jury free from bias. Though not a positive direction to the jury to find for the defendant, it had the effect of a nonsuit. The *wishes* of the grantee and the *intention* of the grantor, both extended as well to a patent for the several machines as to a patent for the combined effect of the whole. The word “improvement,” though in the singular number, extends not only to the plaintiff’s improvement in the art of manufacturing flour, but to his improvement in the several machines by means of which the operations of the art are conducted. This was a patent for an *improvement* on the particular machine in question, and not for its original invention. In this respect it is like that of Watt and Boulton for their improvement on the steam-engine. 4. The prior use, which is to defeat a patent, ought to be a *public* use. The defense here set up under the sixth section of the Patent Law of 1793, ch. 156, was, that the patentee was not the original discoverer, and that the thing had been in use, &c. But how else could it be shown that he was not the discoverer, but by showing that it had before been in *public* use? A mere secret, furtive use would not disprove the fact of his being the original discoverer. If this were so, then the art of printing and gunpowder were not invented in

Europe, because they had been before used in a sequestered corner of the globe like China. But there is a distinction between a *first* discovery and an *original* discovery. The art of printing was *originally* discovered in Germany, though it was *first* invented in China. So the plaintiff would not cease to be the original inventor of the hopper-boy, even if it had been proved that another similar machine had been before privately used in a single mill. It ought, therefore, to have been left to the jury to find for the plaintiff, if they believed that the use was a secret use.

MARSHALL, C. J., delivered the opinion of the court.

In this case exceptions were taken in the Circuit Court by the counsel for the plaintiff in error.

1st. To the opinion of the court in admitting testimony offered by the defendant in that court.

2d. To its opinion in rejecting testimony offered by the plaintiff in that court.

3d. To the charge delivered by the judge to the jury.

Under the sixth section of the act for the promotion of useful arts, and to repeal the act heretofore made for that purpose, the defendant pleaded the general issue, and gave notice that he would prove at the trial that the improved hopper-boy, for the use of which, without license, this suit was instituted, had been used previous to the alleged invention of the said Evans, in several places, (which were specified in the notice,) or in some of them, "and also at sundry other places in Pennsylvania, Maryland, and elsewhere in the United States." Having given evidence as to some of the places specified in the notice, the defendant offered evidence as to some other places not specified. This evidence was objected to by the plaintiff, but admitted by the court; to which admission the plaintiff's counsel excepted.

The sixth section of the act appears to be drawn on the idea that the defendant would not be at liberty to contest the validity of the patent on the general issue. It therefore intends to relieve the defendant from the difficulties of pleading, when it allows him to give in evidence matter which does affect the patent. But the notice is directed for the security of the plaintiff, and to protect him against that surprise to which he might be exposed from an unfair use of this privilege.<sup>1</sup> Reasoning merely on the words directing this notice, it might be difficult to define, with absolute precision, what it ought to include, and what it might omit. There are, however, circumstances in the act which may have some influence on this point. It has been already observed, that the notice is submitted for a special

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Opinion of the court.

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plea; it is farther to be observed, that it is a substitute to which the defendant is not obliged to resort. The notice is to be given only when it is intended to offer the special matter in evidence on the general issue. The defendant is not obliged to pursue this course. He may still plead specially, and then the plea is the only notice which the plaintiff can claim. If, then, the defendant may give in evidence on a special plea the prior use of the machine at places not specified in his plea, it would seem to follow that he may give in evidence its use at places not specified in his notice. It is not believed that a plea would be defective, which did not state the mills in which the machinery alleged to be previously used was placed.

But there is still another view of this subject which deserves to be considered. The section which directs this notice, also directs that if the special matter stated in the section be proved, "judgment shall be rendered for the defendant with costs, and the patent shall be declared void." The notice might be intended not only for the information of the plaintiff, but for the purpose of spreading on the record the cause for which the patent was avoided. This object is accomplished by a notice which specifies the particular matter to be proved. The ordinary powers of the court are sufficient to prevent, and will, undoubtedly, be so exercised as to prevent, the patentee from being injured by the surprise.

This testimony having been admitted, the plaintiff offered to prove that the persons of whose prior use of the improved hopper-boy the defendant had given testimony, had paid the plaintiff for license to use his improved hopper-boy in their mills since his patent. This testimony was rejected by the court, on the motion of the defendant, and to this opinion of the court, also, the plaintiff excepted.

The testimony offered by the plaintiff was entitled to very little weight, but ought not to have been absolutely rejected. Connected with other testimony, and under some circumstances, even the opinion of a party may be worth something. It is, therefore, in such a case as this, deemed more safe to permit it to go to the jury, subject as all testimony is to the animadversion of the court, than entirely to exclude it.

We come next to consider the charge delivered to the jury.

The errors alleged in this charge may be considered under two heads:

1st. In construing the patent to be solely for the general result produced by the combination of all the machinery, and not for the several improved machines, as well as for the general result.

2d. That the jury must find for the defendant, if they should be

of opinion that the hopper-boy was in use prior to the invention of the improvement thereon by Oliver Evans.

The construction of the patent must certainly depend on the words of the instrument. But where, as in this case, the words are ambiguous, there may be circumstances which ought to have great influence in expounding them. The intention of the parties, if that intention can be collected from sources which the principles of law permit us to explore, are entitled to great consideration. But before we proceed to this investigation, it may not be improper to notice the extent of the authority under which this grant was issued.

The authority of the executive to make this grant is derived from the general Patent Law, and from the act for the relief of Oliver Evans. On the general Patent Law alone, a doubt might well arise, whether improvements on different machines could regularly be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of those machines in combination. And if such a patent would be irregular, it would certainly furnish an argument of no inconsiderable weight against the construction. But the "act for the relief of Oliver Evans" entirely removes this doubt. That act authorizes the Secretary of State to issue a patent, granting to the said Oliver Evans the full and exclusive right in his invention, discovery, and improvements in the art of manufacturing flour, and in the several machines which he has invented, discovered, improved, and applied to that purpose.

Of the authority, then, to make this patent coëxtensive with the construction for which the plaintiff's counsel contends, there can be no doubt.

The next object of inquiry is the intention of the parties, so far as it may be collected from sources to which it is allowable to resort.

The parties are the government, acting by its agents, and Oliver Evans.

The intention of the government may be collected from the "act for the relief of Oliver Evans." That act not only confers the authority to issue the grant, but expresses the intention of the legislature respecting its extent. It may fairly be inferred from it, that the legislature intended the patent to include both the general result and the particular improved machines, if such should be the wish of the applicant. That the executive officer intended to make the patent coëxtensive with the application of Oliver Evans and with the special act, is to be inferred from the reference to both in the patent itself. If, therefore, it shall be satisfactorily shown, from his application, to

have been the intention of Oliver Evans to obtain a patent including both objects, that must be presumed to have been also the intention of the grantor.

The first evidence of the intention of Oliver Evans is furnished by the act for his relief. The fair presumption is, that it conforms to his wishes; at least, that it does not transcend them.

The second, in his petition to the Secretary of State, which speaks of his having discovered certain useful improvements, and prays a patent for them, "agreeably to the act of Congress entitled 'An act for the relief of Oliver Evans.'" This application is for a patent coëxtensive with the act.

This intention is further manifested by his specification. It is not to be denied that a part of this specification would indicate an intention to consider the combined operation of all his machinery as a single improvement, for which he solicited a patent. But the whole taken together will not admit of this exposition. The several machines are described with that distinctness which would be used by a person intending to obtain a patent for each. In his number 4; which contains the specification of the drill, he asserts his claim, in terms, to the principles and to all the machines he had specified, and adds, "They may all be united and combined in one flour-mill, to produce my improvement in the art of manufacturing flour complete, or they may be used separately for any of the purposes specified and allotted to them, or to produce my improvement in part, according to the circumstances of the case."

Being entitled by law to a patent for all and each of his discoveries; considering himself, as he avers in his specification and affirmation, as the inventor of each of these improvements; understanding, as he declares he did, that they might be used together, so as to produce his improvement complete, or separately, so as to produce it in part—nothing can be more improbable than that Oliver Evans intended to obtain a patent solely for their combined operation. His affirmation, which is annexed to his specification, confirms this reasoning. To the declaration that he is the inventor of these improvements, he adds, "for which he solicits a patent."

With this conviction of the intention with which it was framed, the instrument is to be examined.

The patent begins with a recital that Oliver Evans had alleged himself to be the inventor of a new and useful improvement in the art of manufacturing flour, &c., by the means of several machines, for a description of which reference is made to his specification.

It will not be denied that, if the allegation of Oliver Evans was

necessarily to be understood as conforming to this recital, if our knowledge of it was to be derived entirely from this source, the fair construction would be, that his application was singly for the exclusive right to that improvement which was produced by the combined operation of his machinery. But in construing these terms, the court is not confined to their most obvious import. The allegation made by Oliver Evans, and here intended to be recited, is in his petition to the Secretary of State. That petition is embodied in, and becomes a part of, the patent. It explains itself, and controls the words of reference to it. His allegation is not "that he has invented a new and useful improvement," but that he has discovered certain useful improvements. The words used by the Department of State in reciting this allegation must, then, be expounded by the allegation itself, which is made a part of the patent.

The recital proceeds, "which has not been known," &c. These words refer clearly to the improvement first mentioned and alleged in the petition of Oliver Evans, and are of course to be controlled in like manner, with the antecedent words, by that petition. This part of the recital is concluded by adding that Oliver Evans has affirmed that he does verily believe himself to be the true inventor or discoverer of the said improvement.

But the affirmation of Oliver Evans, like his petition, is embodied in the grant, and must, of course, expound the recital of it. That affirmation is, that he does verily believe himself to be the true and original inventor of the *improvements* contained in his specification.

In every instance, then, in which the word improvement is used in the singular number throughout the part of the recital of this patent, it is used in reference to a paper contained in the body of the patent, which corrects the term and shows it to be inaccurate.

The patent, still by way of recital, proceeds to add, "and agreeably to the act of Congress entitled 'An act for the relief of Oliver Evans,' which authorizes the Secretary of State to secure to him, by patent, the exclusive right to the use of such *improvement* in the art of manufacturing flour and meal, and in the several machines which he has discovered, improved, and applied to that purpose; he has paid into the treasury, &c., and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said *improvement*, and praying that a patent may be granted for that purpose."

To what do the words "said improvement" relate? The answer which has been given at the bar is entirely correct: to the improvement mentioned in the statute and in the petition,—to both of which direct reference is made. But in the statute, and in the petition, the

word used is "*improvements*," in the plural. The patent, therefore, obviously affixed to the word improvement, in the singular, the same sense in which the plural is employed, both in the statute and in the petition. We are compelled, from the whole context, so to construe the word in every place in which it is used in the recital, because it is constantly employed with express reference to the act of Congress, or to some document embodied in the patent, in each of which the plural is used.

When, then, the words "said improvement" are used as a term of grant, they refer to the words of the recital, which have been already noticed, and must be construed in the same sense. This construction is rendered the more necessary by the subsequent words, which refer for a description of the improvement to the schedule. It also derives some weight from the words "according to law," which are annexed to the words of grant. These words can refer only to the general Patent Law, and to the "act for the relief of Oliver Evans." These acts, taken together, seem to require that the patent should conform to the specification, affirmation, and petition of the applicant.

It would seem as if the claim of Oliver Evans was rested at the Circuit Court, on the principle that a grant for an improvement, by the combined operation of all the machinery, necessarily included a right to the distinct operation of each part, inasmuch as the whole comprehends all its parts. After very properly rejecting this idea, the judge appears to have considered the Department of State and the patentee as having proceeded upon it in making out this patent. He supposed the intention to be to convey the exclusive right in the parts, as well as in the whole, by a grant of the whole; but as the means used are in law incompetent to produce the effect, he construed the grant according to his opinion of its legal operation.

There is great reason in this view of the case, and this court has not discarded it without hesitation. But as the grant, with the various documents which form a part of it, would be contradictory to itself; as these apparent contradictions are all reconciled by considering the word "improvement" to be in the plural instead of the singular number; as it is apparent that this construction gives to the grant its full effect, and that the opposite construction would essentially defeat it, this court has, after much consideration and doubt, determined to adopt it as the sound exposition of the instrument.

The second error alleged in the charge, is in directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to be made thereon by Oliver Evans.

This part of the charge seems to be founded on the opinion that if the patent is to be considered as a grant of the exclusive use of distinct improvements, it is a grant for the hopper-boy itself, and not for an improvement on the hopper-boy.

The counsel for the plaintiff contends that this part of the charge is erroneous, because, by the "act for the relief of Oliver Evans," Congress has itself decided that he is the inventor of the machines for which he solicited a patent, and has not left that point open to judicial inquiry.

This court is not of that opinion. Without inquiring whether Congress, in the exercise of its powers "to secure for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries," may decide the fact that an individual is an author or inventor, the court can never presume Congress to have decided that question in a general act, the words of which do not render such a construction unavoidable. The words of this act do not require this construction. They do not grant to Oliver Evans the exclusive right to use certain specified machines, but the exclusive right to use his invention, discovery, and improvements, leaving the question of invention or improvement open to investigation under the general Patent Law.

The plaintiff has also contended that it is not necessary for the patentee to show himself to be the first inventor or discoverer;—that the law is satisfied by his having invented a machine, although it may have been previously discovered by some other person.

Without a critical inquiry into the accuracy with which the term invention or discovery may be applied to any other than the first inventor, the court considers this question as completely decided by the sixth section of the general Patent Act. That declares that if the thing was not *originally* discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee, judgment shall be rendered for the defendant, and the patent declared void.

Admitting the words "*originally* discovered" to be explained or limited by the subsequent words, still if the thing had been in use, or had been described in a public work, anterior to the supposed discovery, the patent is void. It may be that the patentee had no knowledge of this previous use or previous description; still his patent is void; the law supposes he may have known it; and the charge of the judge, which must be taken as applicable to the testimony, goes no farther than the law.



The real inquiry is, does the patent of Oliver Evans comprehend more than he has discovered? If it is for the whole hopper-boy, the jury has found that this machine was in previous use. If it embraces only his improvement, then the verdict must be set aside.

The difficulties which embarrass this inquiry are not less than those which were involved in the first point. Ambiguities are still to be explained, and contradictions to be reconciled.

The patent itself, construed without reference to the schedule and other documents to which it refers, and which are incorporated in it, would be a grant of a single improvement; but construed with those documents, it has been determined to be a grant of the several improvements which he has made in the machines enumerated in his specification. But the grant is confined to improvements. There is no expression in it which extends to the whole of any one of the machines which are enumerated in his specification or petition. The difficulty grows out of the complexity and ambiguity of the specification and petition. His schedule states his first principle to be the operation of his machinery on the meal from its being ground until it is bolted. He adds, "this principle I apply by various machines, which I have invented, constructed, and adapted to the purposes hereafter specified."

His second principle is the application of the power that moves the mill to his machinery.

The application of these principles, he says, to manufacturing flour, is what he claims as his invention or improvement in the art.

He asserts himself to be the inventor of the machines, and claims the application of these principles to the improvement of the process of manufacturing flour, and other purposes, as his invention and improvement in the art.

The schedule next proceeds to describe the different machines as improved, so as to include in the description the whole machine, without distinguishing his improvement from the machine as it existed previous thereto; and in his fourth number he says, "I claim the exclusive right to the principles, and to all the machines above specified, and for all the uses and purposes specified, as not having been heretofore known or used before I discovered them."

If the opinion of the court were to be formed on the schedule alone, it would be difficult to deny that the application of Oliver Evans extended to all the machines it describes. But the schedule is to be considered in connection with the other documents incorporated in the patent.

The affirmation which is annexed to it avers that he is the inven-

tor, not of the machines, but of the improvements herein above specified.

In his petition, he states himself to have discovered certain useful improvements applicable to the art of manufacturing flour, and prays a patent for the same, that is, for his improvements, agreeably to the act of Congress entitled "An act for the relief of Oliver Evans." After stating the principles as in his schedule, he adds, "the machinery consists of an improved elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-drier."

Although, in his specification, he claims a right to the whole machine, in his petition he only asks a patent for the improvements in the machine. The distinction between a machine and an improvement on a machine, or an improved machine, is too clear for them to be confounded with each other.

The act of Congress, agreeably to which Evans petitions for a patent, authorizes the Secretary of State to issue one for his improvements in the art of manufacturing flour, "and in the several machines which he has invented, discovered, improved, and applied to that purpose."

In conformity with this act, this schedule, and this petition, the Secretary of State issues his patent, which, in its terms, embraces only improvements. Taking the whole together, the court is of opinion that the patent is to be construed as a grant of the general result of the whole machinery, and of the improvement in each machine. Great doubt existed whether the words of the grant, which are expressed to be for an *improvement* or *improvements* only, should be understood as purporting to be a patent only for the improvements, or should be so far controlled by the specification and petition as to be considered as a grant for the machine as improved, or, in the words of the schedule and petition, for "an improved elevator, an improved conveyor, an improved hopper-boy, an improved drill, and an improved kiln-drier." The majority of the court came at length to the opinion that there is no substantial difference, as they are used in this grant, whether the words grant a patent for an improvement on a machine or a patent for an improved machine, since the machine itself, without the improvement, would not be an improved machine. Although I did not concur in this opinion, I can perceive no inconvenience from the construction.

It is, then, the opinion of this court that Oliver Evans may claim, under his patent, the exclusive use of his inventions and improvements in the art of manufacturing flour and meal, and in the several

## Judgment.

machines which he has invented, and in his improvements on machines previously discovered.

In all cases where the claim is for an improvement on a machine, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists.

Some doubts have been entertained respecting the jurisdiction of the courts of the United States, as both the plaintiff and defendant are citizens of the same State. The fifth section of the act to promote the progress of useful arts, which gives to every patentee a right to sue in a Circuit Court of the United States, in case his right be violated, is repealed by the third section of the act of 1800, ch. 179, (xxv,) which gives the action in the Circuit Court of the United States, where a patent is granted "pursuant" to that act or to the act for the promotion of useful arts. This patent, it has been said, is granted not in pursuance of either of those acts, but in pursuance of the act "for the relief of Oliver Evans." But this court is of opinion that the act for the relief of Oliver Evans is ingrafted on the general act for the promotion of useful arts, and that the patent is issued in pursuance of both. The jurisdiction of the court is, therefore, sustained.

As the charge delivered in the Circuit Court to the jury differs in some respects from this opinion, the judgment rendered in that court is reversed and annulled, and the cause remanded to the Circuit Court, with directions to award a *venire facias de novo*, and to proceed therein according to law.

## JUDGMENT REVERSED.

JUDGMENT. This cause came on to be heard on the transcript of the record of the Circuit Court for the District of Pennsylvania, and was argued by counsel. On consideration whereof, this court is of opinion that there is error in the proceedings of the said Circuit Court, in this: that the said court rejected testimony which ought to have been admitted; and, also, in this: that, in the charge delivered to the jury, the opinion is expressed that the patent on which this suit was instituted conveyed to Oliver Evans only an exclusive right to his improvement in manufacturing flour and meal, produced by the general combination of all his machinery, and not to his improvement in the several machines applied to that purpose; and, also, that the said Oliver Evans was not entitled to recover, if the hopper-boy, in his declaration mentioned, had been in use previous to his alleged discovery. Therefore, it is considered by this court that the judgment of the Circuit Court be reversed and annulled, and that the

cause be remanded to the said Circuit Court, with directions to award *a venire facias de novo*.

## NOTE ON THE PATENT LAWS.

(Appendix. 3 Wheaton, 655.)

The Patent Acts of the United States are, in a great degree, founded on the principles and usages which have grown out of the English statute on the same subject. It may be useful, therefore, to collect together the cases which have been adjudged in England, with a view to illustrate the corresponding provisions of our own laws; and then bring in review the adjudications of the courts of the United States.

By the statute of 21 Jac. I., ch. 3, commonly called the Statute of Monopolies, it is enacted, (§ 1,) "That all monopolies, and all commissions, grants, licenses, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm, or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give license or toleration to do, use, or exercise any thing against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation, license, or toleration, to be had or made, or to agree or compound with any others for any penalty or forfeiture, limited by any statute, or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money that is or shall be due by any statute, before judgment thereupon had; and all proclamations, inhibitions, straits, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing the same, or any of them, are altogether contrary to the laws of the realm, and so are and shall be utterly void and of none effect, and in nowise to be put in use or execution." The sixth section, however, provides, "That any declaration before mentioned shall not extend to any letters patent, and grants of privilege, for the term of fourteen years, or under, hereafter to be made, *of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others, at the time of making such letters patent and grants, shall not use*, so as also they be not contrary to the law, nor mischievous to the State, by raising prices of commodities at home, or hurt of trade, or generally inconvenient; the said fourteen years to be accounted from the date of the first letters patent, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be if this act had never been made, and none other."

It is under this last section that patents for new and useful inventions are now granted in England; and by a proviso, or condition, always inserted in every patent, the patentee is bound particularly to describe and ascertain the nature of his invention, and in what manner the same is to be constructed or made, by an instrument in writing, under his hand and seal, and to cause the same to be enrolled in the Court of Chancery within a specified time. *Harmer v. Playne*, 11 East, 101; *Boulton v. Bull*, 2 H. Bl., 463; *Hornblower v. Boulton*, 8 T. R., 95; 2 Bl. Com., 407, note by Christian (7). This instrument is usually termed the speci-

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fication of the invention, and all such instruments are preserved in an office for public inspection.

Upon the construction of the British Patent Act, taken in connection with the conditions inserted in the letters patent, a great variety of decisions have been made. 1. As the statute contains no restriction confining the grants to British subjects, it is every-day practice to grant patents to foreigners, and no such patent has ever been brought into judicial doubt. 2. A patent can be granted only for a thing *new*; but it may be granted to the first inventor, if the invention be *new in England*, though the thing was practiced beyond sea before; for the statute speaks of *new manufactures within this realm*; so that if it be new here, it is within the statute, and whether learned by travel or study is the same thing. *Edgeberry v. Stevens*, 2 Salk., 447; Hawk. P. C., b. 1, ch. 79, and see Noy, 182, 183. 3. The language of the statute is *new manufacture*; but the terms are used in an enlarged sense, as equivalent to new device or contrivance, and apply not only to *things made*, but to the *practice of making*. Under *things made*, we may class, in the first place, new compositions of things, such as manufactures in the ordinary sense of the word; secondly, all mechanical inventions, whether made to produce old or new effects; for a new piece of mechanism is certainly a thing made. Under *the practice of making*, we may class all new artificial manners of operating with the hand, or with instruments in common use, new processes in any art, producing effects useful to the public. When the effect produced is some new substance or composition, it would seem that the privilege of the sole working or making ought to be for such new substance or composition, without regard to the mechanism or process by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance. When the effect produced is no new substance or composition of things, the patent can only be for the mechanism, if new mechanism is used; or for the process, if it be a new method of operating with or without old mechanism, by which the effect is produced. Per EYRE, Ch. J., in *Boulton v. Bull*, 2 H. Bl., 463, 492, and LAWRENCE, J., in *Hornblower v. Boulton*, 8 T. R., 95, 106. A patent, therefore, under certain circumstances, may be good for a *method* as well as for an *engine* or *machine*. *Ibid.*, and 8 T. R., 95, 106; *Rex v. Cutler*, 1 Starkie's N. P. R., 354. 4. A patent cannot be for a mere principle, properly so called; that is, for an elementary truth. But the word principle is often used in a more lax sense, to signify constituent parts, peculiar structure, or process; and in specifications it is generally used in this latter sense; and in this view, it may well be the subject of a patent. *Ibid.* 5. It was formerly considered that a patent could not be for an improvement; (3 Inst., 184;) but that opinion has been long since exploded, and it is now held that a patent may well be for a new improvement. *Harmer v. Playne*, 14 Ves., 130; *Ex parte Fox*, 1 Ves. & Beames, 67; *Boulton v. Bull*, 2 H. Bl., 463, 488; 8 T. R., 95; Bull. N. P., 77. 6. A patent must be of such manufacture or process as no other did, at the time of making the letters patent, use; for though it were newly invented, yet if any other did use it at the time of making the letters patent, or grant of the privilege, it is declared void by the act. 3 Inst., 184. And in a very recent case of a patent for a new mode of making verdigris, one of the objections was that the invention was in public sale by the patentee, before the grant of the patent; and GIBBS, Ch. J., on that occasion said: "With respect to this objection, the question is somewhat new. Some things are obvious as soon as they are made public; of others, the scientific world may possess itself by analysis; some inventions almost baffle discovery. But to entitle a man to a patent, the invention must be *new to the world*. The public sale of that which is afterwards made the subject of a

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patent, *though sold by the inventor only*, makes the *patent void*. It is in evidence that a great quantity was sold in the course of four months, before the patent was obtained." And if the jury were satisfied of that fact, his lordship added "that he thought the patent void." *Wood v. Zimmer*, 1 Holt's N. P. Rep., 58.

7. The invention must not only be new, but useful; for if it be contrary to law, or mischievous, or hurtful to trade, or generally inconvenient, it is, by the terms of the statute, void. 8 Inst., 184. 8. A patent can legally be granted only to the first and true inventor; for such are the descriptive terms of the statute. 3 Inst., 184. But if the original inventor has confined the invention to his closet, and the public be not acquainted with it, a second inventor, who makes it public, is entitled to a patent. *Boulton v. Bull*, 2 H. Bl., 463, and Dolland's patent, cited 2 H. Bl., 470, 487. 9. The patent must not be more extensive than the invention; therefore, if the invention consist in an addition or improvement only, and the patent is for the whole machine or manufacture, it is void. Buller's N. P., 76; *Boulton v. Bull*, 2 H. Bl., 463, and cases there cited; *The King v. Else*, 11 East, 109, note; *Harmer v. Playne*, 11 East, 101; S. C., 14 Ves., 180. Therefore, where a patent was for the exclusive liberty of making lace composed of silk and cotton thread mixed, not of any particular mode of making it, and it was proved that silk and cotton thread were before mixed on the same frame for lace, in some mode or other, though not like the plaintiff's, the patent was held void, as being more extensive than the invention. *The King v. Else*, 11 East, 109, note. A person may obtain a patent for a machine, consisting of an entirely *new combination of parts*, although the parts may have been separately used in former machines; and the patent may correctly set out the whole as the invention of the patentee. But if a combination of a certain number of those parts have previously existed, up to a certain point, in former machines, the patentee merely adding other combinations, the patent should comprehend such improvements only. *Bovill v. Moore*, 2 Marshall's R., 211. 10. If a person has invented an improvement upon an existing patented machine, he is entitled to a patent for his improvement; but he cannot use the original machine until the patent for it has expired. *Ex parte Fox*, 1 Ves. & Beames R., 67. 11. Although the specification is not annexed to a patent in England, and the patent contains a concise description only of the invention, yet as there is a proviso in the patent requiring the enrollment of a specification in chancery, within a specified time, and in default making the patent void, the patent is always construed in connection with the specification, and the latter is deemed a part of the patent, at least for the purpose of ascertaining the nature and extent of the invention claimed by the patentee. *Boulton v. Bull*, 2 H. Bl., 463; *Hornblower v. Boulton*, 8 T. R., 95. 12. Care should be taken that the specification comports with the patent; for otherwise it will not sustain the grant. For where a patent was obtained for an improved mode of lighting cities, it was held by L<sup>ORD</sup> BLANC, J., that it was not supported by a specification, describing an improved lamp. The patent ought to have been for an improved street lamp. *Lord Cochrane v. Smethurst*, 1 Starkie's N. P. R., 205. No technical words, however, are necessary to explain the subject of a patent; but the court will construe the terms of the patent, and of the specification, in a liberal manner, and give them such a meaning as best comports with the apparent intention of the patentee. *Hornblower v. Boulton*, 8 T. R., 95; *Boulton v. Bull*, 2 H. Bl., 463. Therefore, where the patent was "for a method of lessening the consumption of steam and fuel in fire-engines," one objection was, that the patent was for a philosophical principle only, neither organized nor capable of being organized, whereas it ought to have been for a formed machine; a second objection was, that if it was a patent for a formed machine, it was for

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the whole machine, when the invention was only an improvement or addition to an existing machine. But the Court of King's Bench, on examining the specification, were of opinion that both of the objections were unfounded, although the terms of the specification were so doubtful and obscure as to have produced a division of opinion in the Court of Common Pleas. *Hornblower v. Boulton*, 8 T. R., 95; *Boulton v. Bull*, 2 H. Bl., 463. Both of these cases were very elaborately discussed, and contain more learning on the subject of patents than can be found in any other adjudication, and are, therefore, deserving of the most accurate attention of every lawyer. In both of them, all the judges agreed that a mere mistake in terms, or in the correct sense of words, would not vitiate a patent, if the court could give a reasonable construction to the whole specification. Mr. Justice HEATH said: "When a mode of doing a thing is referred to something permanent, it is properly termed an *engine*; when to something fugitive, a *method*." "If *method* and *machinery* had been used by the patentee as convertible terms, and the same consequences would result from both, it might be too strong to say that the inventor should lose the benefit of his patent by the misapplication of this term." "Method is a principle reduced to practice; it is, in the present instance, the general application of a principle to an old machine." "*A patent for an improvement of a machine, and a patent for an improved machine, are in substance the same.* The specification would serve for both patents; the new organization of parts is the same in both." Mr. Justice ROOKE said: "*A newly-invented method* conveys to my understanding the idea of a new mode of construction. I think those words are tantamount to fire-engines of a newly-invented construction; at least, I think they will bear this meaning, if they do not necessarily exclude every other. The specification shows that this was the meaning of the words as used by the patentee, for he has specified a new and particular mode of constructing fire-engines. It seems, therefore, but reasonable, that if he sets forth his improvement intelligibly, his specification should be supported, though he professes only to set forth the principle." Mr. Justice BULLER said: "The method and mode of doing a thing are the same; and I think it is impossible to support a patent for a method only, without having carried it into effect and produced some new substance." "When the thing is done or produced, then it becomes the manufacture which is the proper subject of a patent." The remarks of Lord Chief Justice AYRE have been already stated. He, however, considered the patent not to be for a fire-engine, but in effect for *a manner of working a fire-engine so as to lessen the consumption of steam*; and he added: "The specification calls a method of lessening the consumption of steam in fire-engines a *principle*, which it is not; the act [of Parliament] calls it an *engine*, which, perhaps, also, it is not; but both the specification and statute are referable to the same thing, and when they are taken with their correlative are perfectly intelligible." "A narrower ground was taken in the argument, which was to expound the word *engine* in the body of this act, [meaning the special act of Parliament for this patent,] in opposition to the title of it, to mean a *method*; and I am ready to say I would resort to that ground, if necessary, in order to support the patent, *ut res magis valeat quam pereat*." In the King's Bench, Mr. Justice LAWRENCE observed: "*Engine* and *method* mean the same thing, and may be the subject of a patent. *Method*, properly speaking, is only placing several things, and performing several operations, in the most convenient order; but it may signify *contrivance*, or *device*; so may an *engine*; and, therefore, I think it may answer the word *method*. So, *principle* may mean an elementary truth; but it may also mean constituent parts." 13. The patent being granted upon condition that the invention is new (at least in England) and useful, and also that the patentee shall deliver and

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enrol in chancery a specification of his invention, it is *necessary* for the patentee to establish, by proof, when his invention is called in question in a suit, that he has complied with these conditions. If, therefore, the novelty or effect of the invention be disputed, the patentee must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this, on his part, is sufficient; and it is then incumbent on the defendant to falsify the specification. *Turner v. Winter*, 1 T. R., 602. 14. In respect to specifications, (objections to which form the most common, and, indeed, usually the most fatal, defense to suits for infringements of patents,) several rules have been laid down. In the first place, a man, to entitle himself to the benefit of a patent of monopoly, must disclose his secret, and specify his invention in such a way that others of the same trade who are artists may be taught to do the thing for which the patent is granted, by following the directions of the specification, without any new invention or addition of their own. *Rex v. Arkwright*, Bull. N. P., 77. In the second place, he must so describe it that the public may, after the expiration of the term, have the use of the invention in as cheap and beneficial a way as the patentee himself uses it; and, therefore, if the specification describe many parts of an instrument, or machine, and the patentee uses only a few of them, or does not state how they are to be put together or used, the patent is void. *Rex v. Arkwright*, Bull. N. P., 77; *Harmer v. Playne*, 11 East, 101. So, if the patentee could only make the article with two or three of the ingredients specified, and he has inserted others which will not answer the purpose, that will avoid the patent. So, if he makes the article with cheaper materials than those which he has enumerated, although the latter will answer the purpose, the patent is void. *Turner v. Winter*, 1 T. R., 602. In the third place, if the specification be, in any part of it, materially false or defective, or obscure and ambiguous, or give directions which tend to mislead the public, the patent is void. *Rex v. Arkwright*, Bull. N. P., 77; *Turner v. Winter*, 1 T. R., 602. Therefore, where, in a patent for trusses for ruptures, the patentee omitted what was very material for tempering the steel, which was rubbing it with tallow, Lord MANSFIELD held the patent, for want of it, void. *Liardet v. Johnson*, Bull. N. P., 76; S. C., cited 1 T. R., 602, 608, per BULLER, J. So, where a patent was for a new mode of making verdigris, and the specification omitted an ingredient (aqua fortis) which, though not necessary to the composition for which the patent was claimed, was a more expeditious and beneficial mode of producing the same effects, and was as such used by the patentee, Lord Chief Justice GIBBS held the patent void. *Wood v. Zimmer*, 1 Holt's N. P. R., 58. So, if the specification direct an ingredient to be used which will not answer the purpose, or is never used by the patentee, the patent is void. *Turner v. Winter*, 1 T. R., 602. So, if the patentee says, in his specification, he can produce three things by one process, and he fails in any one, the patent is void. *Turner v. Winter*, 1 T. R., 602. So, if the specification direct the same thing to be produced several ways, or by several different ingredients, and any of them fail, the patent is void. *Turner v. Winter*, 1 T. R., 602. In the fourth place, if the invention be of an improvement only, it is indispensable that the patent should not be more broad than the invention, and the specification should be drawn up in terms which do not include anything but the improvement. *Boulton v. Bull*, 2 H. Bl., 463; Bull. N. P., 76; *Bovill v. Moore*, 2 Marsh. R., 211. And in the specification for such improvement, it is essential to point out precisely what is new and what is old; and it is not sufficient to give a general description of the construction of the instrument, without such distinction, although a plate be annexed containing detached and separate representations of the parts in which the improvement con-



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sists. Therefore, where a patent was "for certain improvements in the making of umbrellas and parasols," and the specification contained a minute description of the construction of them, partly including the usual mode of stitching the silk, and also certain improvements in the insertion of the stretches, &c., and throughout the whole specification no distinction was made between what was new and what was old, Lord ELLENBOROUGH said: "The patentee ought, in his specification, to inform the person who consults it what is new and what is old. He should say, my improvement consists in this, describing it by words if he can, or, if not, by reference to figures. But here the improvement is neither described in words nor figures, and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was new and what was old. A person ought to be warned by the specification against the use of a particular invention." *M'Farlane v. Price*, 1 Starkie's N. P. R., 199. And it may be added, also, that the public have a right to purchase the improvement by itself, and not to be incumbered with other things, where the improvement is of the old machine. But where the patentee obtained a patent for a new machine, and afterwards another patent for improvements in the said machine, in which the grant of the former was recited, it was held, that a specification containing a full description of the whole machine so improved, but not distinguishing the new improved parts, or referring to the former specification, otherwise than as the second recited the first, was sufficient. Lord ELLENBOROUGH on that occasion said: "It may not be necessary, indeed, in stating a specification of a patent for an improvement, to state precisely all the former known parts of the machine; and then to apply to those the improvement; but on many occasions it may be sufficient to refer generally to them. As, in the instance of a common watch, it may be sufficient for the patentee to say, take a common watch, and add or alter such and such parts, describing them." *Harmer v. Playne*, 11 East, 101; S. C., 14 Ves., 130. The case, also, of *Bovill v. Moore*, already cited, (2 Marsh. R., 211,) affords very important instruction on this point. In the fifth place, if a patentee in his specification sum up the principle in which his invention consists, if this principle be not new, the patent cannot be supported, although it appear that the application of the principle, as described in the specification, be new; for the patentee, by such summing up, confines himself to the benefit only of the principle so stated. *Rex v. Cutler*, 1 Starkie's N. P. R., 354. 15. If a patent is void, the patentee cannot enforce performance of a covenant for the observance of the exclusive right, entered into by the covenantor in contemplation of the patent being good. *Hayne v. Maltby*, 3 T. R., 438. 16. The right of a patentee is assignable at law; and upon such an assignment the assignee has the exclusive right to maintain an action for any infringement of the patent. See *Boulton v. Bull*, 2 H. Bl., 463. 17. Where the patentee has assigned his patent, in an action by the assignee against the patentee, for an infringement of the patent, the latter will not be permitted to aver against his deed that the invention is not new. *Oldham v. Langmead*, cited 3 T. R., 439. 18. Where the patent is void, from any of the causes before stated, the party sued for an infringement may, under the general issue, avail himself of any such matter in his defense. 19. Or the patent itself may be repealed by a *scire facias* by the King, upon the ground of fraud or false suggestion. The mode of proceeding on *scire facias* may be seen in 2 Saunders's Rep., 72, Williams's note, (4,) § 4.

These are the principal doctrines established in the English courts, upon the subject of patents for new inventions. In respect to the adjudications under the Patent Laws of the United States, it is matter of regret that so few of them have been published; but the following are the leading provisions of the act, and the

principles which have been recognized as applicable to it. It may be convenient to follow the order of the Patent Act itself, and to arrange the decisions under the corresponding heads to which they properly belong.

The first Patent Act of the United States was passed in the year 1790, (act of the 10th of April, 1790, ch. 34,) and was repealed by another act passed in the year 1793; (act of the 21st of February, 1793, ch. 11;) and this last act, as amended by the act of 1800, (act of the 17th of April, 1800, ch. 25,) constitutes the present general Patent Law of the United States. 1. By the first section of the act of 1793, any citizen who has invented any new and useful *art, machine, manufacture, or composition* of matter, or any *new and useful* improvements therein, *not known or used before* the application, may, on application and petition to the Secretary of State, obtain a patent for the exclusive right and liberty of *making, constructing, using, and vending* to others to be used the said invention or discovery, upon complying with the regulations of the act; and the patent is required to recite the allegations and suggestions of the petition, and give a short description of the invention or discovery. The letters patent, previous to their being issued, are to be examined by the Attorney-General, and are by him to be certified to be conformable to law, and are then to be recorded in the office of the Secretary of State. The act of 1800, ch. 25, secs. 1, 2, extends this provision to aliens who have resided two years in the United States, and also to the legal representatives and devisees of a person entitled to a patent, who dies before it is obtained. The original inventor of a machine, who has reduced his invention first into practice, is entitled to a *priority of the patent-right*; and a *subsequent* inventor, although an original inventor, cannot sustain his claim, although he has obtained the first patent; for *qui prior est in tempore, potior est in jure*. *Woodcock v. Parker*, 1 Gallis. R., 438; *Odiorne v. Winkley*, 2 Gallis. R., 51. And, therefore, every subsequent patentee, although an original inventor, may be defeated of his patent-right, upon proof of such prior invention put into actual use; (*Bedford v. Hunt*, 1 Mason's R.;) for then the invention cannot be considered as *new*. If an inventor make a gift of his invention to the public, and suffer it to go into general use, he cannot afterwards resume the invention and claim an exclusive right under a patent. *Whittemore v. Cutter*, 1 Gallis. R., 478. By *useful* invention, in the Patent Act, is meant an invention which may be applied to a beneficial use in society, in contradistinction to an invention injurious to the morals, health, or good order of society, or frivolous and insignificant. *Bedford v. Hunt*, 1 Mason's R.; *Lowell v. Lewis*, 1 Mason's R. It is not necessary to establish that it is in all cases superior to the modes now in use for the same purpose. *Ibid*. 2. By the second section, any person who shall have invented an improvement shall not be at liberty to use the original discovery, nor shall the original inventor be at liberty to use the improvement. And the simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery. See *Odiorne v. Winkley*, 2 Gallis. R., 51. If the inventor of an improvement obtain a patent for the whole machine, the patent, being more extensive than the invention, is void. *Woodcock v. Parker*, 1 Gallis. R., 439; *Whittemore v. Cutter*, 1 Gallis. R., 478; *Odiorne v. Winkley*, 2 Gallis. R., 51. 3. By the third section, every inventor, before he can obtain a patent, is required to swear that he is the *true inventor or discoverer* of the art, machine, or improvement for which he solicits a patent, and to deliver a *written description* of his invention, and of the manner of using or process of compounding it, in such *full, clear, and exact* terms as to *distinguish the same from all other things before known*, and to enable any person skilled in the art or science of which it is a branch, or with which it is most clearly connected, to make, compound, and use the same. And

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in the case of any machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character by which it may be distinguished from other inventions; and he is to accompany the whole with drawings and written references, where the nature of the case admits of drawings; or with specimens of the ingredients, and of the composition of matter, sufficient in quantity for the purpose of experiment, where the invention is a composition of matter; which description, signed by himself and attested by two witnesses, is to be filed in the office of State; and the inventor is, moreover, to deliver a model of his machine, if the Secretary shall deem it necessary. The patentee must describe in his specification, with reasonable certainty, in what his invention consists; otherwise it will be void for ambiguity. If it be for an improvement in an existing machine, he must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new; for if both are mixed up together, and a patent is taken for the whole, it is void. *Lowell v. Lewis*, 1 Mason's R. The taking of the oath is directory to the party; but if, by mistake, the oath is not taken before the issuing of the patent, the patent is not thereby rendered void. *Whittemore v. Cutter*, 1 Gallis. R., 429.

4. By the fourth section, patentees may assign their rights, and, upon the assignment being recorded in the office of State, the assignee shall stand in the place of the original inventor, both as to right and responsibility, and so the assignees of assignees in any degree. Where the patentee has assigned an undivided moiety of his patent-right, the action for an infringement of the right should be in the joint names of the patentee and the assignee. *Whittemore v. Cutter*, 1 Gallis. R., 429. But an assignee of the patent-right, by an assignment excepting certain places, is not an assignee entitled to sue within the act. *Tyler v. Tuel*, 6 Cranch, 324.

5. The third section of the act of 1800 (which is a substitute for the fifth section of the act of 1793) declares that any person who, without the written consent of the patentee, &c., shall "make, devise, use, OR sell" (the words of the fifth section of the act of 1793 were "make, devise, AND use or sell") the thing patented, shall forfeit three times the actual damages sustained by the patentee, &c., to be recovered by an action on the case in the Circuit Court of the United States having jurisdiction thereof. Upon this section, it has been held that the making of a patented machine, *fit for use, and with a design to use it for profit*, in violation of the patent-right, is, of itself, a breach of this section, for which an action lies; but where the making only, *without a user*, is proved, nominal damages only are to be given for the plaintiff. *Whittemore v. Cutter*, 1 Gallis. R., 429, 478. If a *user* is proved, the measure of damages is the value of the use during the time of the user. *Ibid*. But the act gives the plaintiff a right to his actual damages only, and not to a vindictive recompense, as in other cases of tort. *Ibid*. And neither the price of nor the expense of making a patented machine is a proper measure of damages in such case. *Ibid*. The sale of the materials of a patented machine by a sheriff, upon an execution against the owners, is not a sale which subjects the sheriff to an action under the third section of the act of 1800. *Sawin v. Guild*, 1 Gallis. R., 485. In an action on this section, the jury are to find the single damages, and the court are to treble them. *Whittemore v. Cutter*, 1 Gallis. R., 479.

6. The sixth section authorizes the defendant to plead the general issue, and give this act and any special matter in evidence, of which notice in writing may have been given to the plaintiff thirty days before trial, tending to prove (1) that the specification does not contain the whole truth relative to the discovery, or that it contains more than is necessary to produce the described effect, *which concealment or addition shall fully appear to have been for the purpose of deceiving the public*; (2) or that the patented thing was not origin-

ally discovered by the patentee, *but had been in use*, or had been described in some public work, anterior to the supposed discovery of the patentee; (3) or that he had surreptitiously obtained a patent for the discovery of another person,—in either of which cases, judgment shall be rendered for the defendant, with costs, *and the patent shall be declared void*. Besides the points decided in the principal case in the text, (*Evans v. Eaton*,) the following are deserving of notice. It is clear that this section does not include all the matters of defense which the defendant may be legally entitled to make; as, for instance, it does not include the case of the non-existence of the fact of infringement in any shape, the case of an assignment from the plaintiff, or a written license or purchase from the plaintiff, or that the patentee is an alien not entitled to a patent, which are clearly bars to the action upon the very terms of the act, as well as the general principles of law. *Whittemore v. Cutter*, 1 Gallis. R., 429, 435. So, if the specification do not describe the invention in clear and exact terms, so as to distinguish it from other inventions, but be so ambiguous and obscure that it cannot be with reasonable certainty ascertained for what the patent is taken, or what it includes, the patent is void for ambiguity, and the fact may be shown in his defense by the defendant. *Lowell v. Lewis*, 1 Mason's R. But if the invention is *definitely* described in the patent and specification *so as to distinguish it from other inventions before known*, the patent is good, although it does not describe the invention in such full, clear, and exact terms that a person skilled in the art or science of which it is a branch could construct or make the thing, unless such defective description or concealment *was with intent to deceive the public*. *Whittemore v. Cutter*, 1 Gallis. R., 429; *Lowell v. Lewis*, 1 Mason's R. In order to defeat a patent, it is not necessary to prove that the invention has previously been in *general use*, and generally known to the public. It is sufficient if it has been previously known to and put in use by other persons, however limited in extent the use or the knowledge of the invention may have been. *Bedford v. Hunt*, 1 Mason's R. 7. The seventh section applies only to the cases of patents under State authority, before the Constitution of the United States. 8. The eighth section applied only to applications then pending for patents under the Patent Act of 1890. 9. The ninth section directs that in cases of interfering applications for a patent for the same invention, the same may be referred to arbitrators, chosen by the applicants and the Secretary of State, whose award shall be final, "as far as respects the granting of the patent"; and if either of the applicants refuse to choose an arbitrator, the patent shall issue to the opposite party. It has been held that such an award is not conclusive in any other respect than as to the mere issuing of the patent; and that it decides nothing as to the right of invention, or other claims of either party, but that either party may contest, in a suit at law, the validity of the patent. *Stearns v. Barrett*, 1 Mason's R. 10. The tenth section provides that upon oath or affirmation being made before the district judge of the district where the patentee, his executors, &c., reside, that any patent was obtained "*surreptitiously or upon false suggestion*," (the words of the act of 1790 are "*surreptitiously by or upon false suggestion*,") the district judge may, if the matter appear sufficient, at any time within three years after the issuing of the patent, grant a rule that the patentee show cause why process should not issue against him to repeal the patent; and if sufficient cause be not shown, the rule shall be made absolute, and the judge shall order process to be issued against such patentee, &c., *with costs of suit*. And if no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by the court for the repeal of the patent; and if the plaintiff fails in his complaint, the *defendant* shall recover costs. It has been held that the pro-

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ceedings upon the rule to show cause are summary; and that when it is made absolute, it is not that the patent be repealed, but only that process issue to try the validity of the patent, on the suggestion stated in the complaint. That this process is in the nature of a *scire facias* at the common law, to repeal patents, and the issues of facts, if any, are to be tried, not by the court, but by a jury; that the judgment upon this process is in the nature of a judgment on a *scire facias* at common law, upon which a writ of error lies, as in other cases, to the Circuit Court, where there is matter of error apparent on the record, by bill of exceptions or otherwise. That the patent itself is slight but *prima facie* evidence, in favor of the patentee, that it is his invention; that if it appear that he is but a joint inventor, and he takes out the patent as his *sole* invention, it is an obtaining of the patent upon *false suggestion* within the act. *Stearns v. Barrett*, 1 Mason's R., 11. The remaining sections of the act (11, 12) contain no matter of any general importance; the eleventh being directory only as to the fees of office, and the twelfth being a repealing clause of the act of 1790.

## EVANS v. EATON.

(7 Wheaton, 356.)

1. A party cannot entitle himself to a patent for more than his own invention; and if the patent be for the whole of a machine, he can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation.
2. If the same combination existed before in machines of the same nature up to a certain point, and the party's invention consists in adding some new machinery, or some improved mode of operation to the old, the patent should be limited to such improvement; for if it includes the whole machine, it includes more than his invention, and therefore cannot be supported.
3. When the patent is for an improvement, the nature and extent of the improvement must be stated in the specification, and it is not sufficient that it be made out and shown at the trial, or established by comparing the machine specified in the patent with former machines in use.
4. The former judgment of this court in the same case, commented on, explained, and confirmed.
5. A person having an interest only in the question, and not in the event of the suit, is a competent witness.
6. In general, the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and does not exclude him.

## ERROR to the Circuit Court of Pennsylvania.

This is the same case which was formerly before this court, and is reported *ante*, vol. 3, p. 454; and by a reference to that report the form of the patent, the nature of the action, and the subsequent proceedings will fully appear. The cause was now again brought before the court upon a writ of error to the judgment of the Circuit

Court, rendered upon the new trial had in pursuance of the mandate of this court.

Upon the new trial, several exceptions were taken by the counsel for the plaintiff, Evans. The first was to the admission of one Frederick as a witness for the defendant, upon the ground of his interest in the suit. The witness, on his examination on the *voir dire*, denied that he had any interest in the cause, or that he was bound to contribute to the expenses of it. He said that he had not a hopper-boy in his mill at present, it being then in court; that it was in his mill about three weeks ago, when he gave it to a person to bring down to Philadelphia; and that his hopper-boy spreads and turns the meal, cools it some, dries it, and gathers it to the bolting-chest. Upon this evidence, the plaintiff's counsel contended that Frederick was not a competent witness. But the objection was overruled by the court.

Another exception was to the refusal of the court to allow the deposition of one Shetter to be read in evidence by the plaintiff, which had been taken according to a prevalent practice of the State courts, instead of being taken pursuant to the provisions of the act of Congress.

But the principal exceptions were to the charge by the Circuit Court, in summing up the cause to the jury, which it is deemed necessary here to insert at large.

WASHINGTON, J. This is an action for an infringement of the plaintiff's patent, which the plaintiff alleges to be:

1. For the whole of the machine employed in the manufacture of flour, called the hopper-boy.
2. For an improvement on the hopper-boy.

The question is, is the plaintiff entitled to recover upon either of these claims? The question is stated thus singly, because the defendant admits that he uses the very hopper-boy for which the patent is, in part, granted, and justified himself by insisting:

1st. That the plaintiff was not the original inventor of, but that the same was in use prior to the plaintiff's patent, the hopper-boy as patented.

2d. That his patent for an improvement is bad, because the nature and extent of the improvement is not stated in his specification; and if it had been, still the patent comprehends the whole machine, and is therefore too broad.

1st. The first is a mixed question of fact and law. In order to enable you to decide the first, it will be well to attend to the descrip-

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tion which the plaintiff has given to this machine in his specification, a model of which is before you. Its parts are: (1.) An upright round shaft, to revolve on a pivot in the floor. (2.) A leader or upper arm. (3.) An arm set with small inclining boards, called flights and sweepers. (4.) Cords from the leader to the arm, to turn it. (5.) A weight passing over a pulley, to keep the arm tight on the meal. (6.) A log at the top of the shaft, to turn it, which is operated upon by the water-power of the mill. The flights are so arranged as to track the one below the other, and to operate like plows, and at every revolution of the machine to give the meal two turns towards the center. The sweepers are to receive the meal from the elevator, and to trail it round the circle for the flights to gather it to the center, and also to sweep the meal into the bolt.

The use of this machine is stated to be: to spread any granulated substance over a floor, to stir and expose it to the air, to dry and cool it, and to gather it to the bolt.

The next inquiry under this head is, when was this discovery made? Joseph Evans has sworn that, in 1783, the plaintiff informed him that he was engaged in contriving an improvement in the manufactory of flour, and had completed it in his mind some time in July of that year. In 1784, he constructed a rough model of the hopper-boy, but, having no cords from the extremities of the leader to those of the arm, it was necessary, in making his experiments, to turn round the arm by hand. In 1785, he set up a hopper-boy in his mill, resembling the model in court and the machine described in his specification. The evidence of Mr. Anderson strongly supports this witness, and, indeed, the discovery, as early as 1784 or 1785, is scarcely controverted by the defendant.

The defendant insists that a hopper-boy similar to the plaintiff's was discovered and in use many years anterior even to the year 1783, and relies upon the testimony of the following witnesses:

Daniel Stauffer, who deposes that he first saw the Stauffer hopper-boy in his father's, Christian Stauffer's, mill, in the year 1774; in the year 1775 or 1776, he erected a similar one in the mill of his brother Henry, and another in Jacob Stauffer's mill, in 1777, 1778, or 1779.

Philip Frederick swears that in 1778 he saw a Stauffer hopper-boy in operation in Christian Stauffer's mill, and in the year 1783 he saw one in Jacob Stauffer's mill, and another in U. Charles's mill, and that it was always called Stauffer's machine.

George Roup stated that in 1784 he erected one of these hopper-boys in the mill of one Braniwar, and that in 1782 Abraham Stauf-

fer described to him a similar machine, which his father used in his mill.

Christopher Stauffer, the son of Christian, has sworn that his father, having enlarged his mill in the year 1780, erected a new hopper-boy of the description above mentioned, which is still in use in the same mill, now owned by Peter Stauffer.

If these witnesses are believed by the jury, they establish the fact asserted by the defendant, that the Stauffer hopper-boy was in use prior to the plaintiff's discovery.

The next inquiry is into the parts, operation, and use of the Stauffer hopper-boy. This consists of an upright square shaft, which passes lightly through a square mortise in an arm, underneath which are fixed slips of wood, called flights, and the arm is turned by a log on the upper end of it, which is moved by the power which moves the mill.

The arm, with the flights, operates as it turns upon the meal placed below it, and its use is, in a degree, to cool the meal and to conduct it to the bolt. It will now be proper to compare this machine with the plaintiff's. They agree in the following particulars: They each consist of a shaft, or log, to turn it by the power of the mill, and an arm with flights on the under side of it; they each operate on the mill below the arm, to cool, dry, and conduct it to the bolt.

In what do they differ? The plaintiff's shaft is *round*, and consequently could not turn the arm, into which it is loosely inserted, if it were not for the cords which connect the extremities of the arm to those of the leader. The shaft of the Stauffer hopper-boy is *square*, and therefore turns the arm without the aid of a leader or of cords. It has neither a weight nor pulley, nor are the flights arranged in the manner the plaintiff's are, and consequently it does not, in the opinion of most of the witnesses, cool or prepare the flour for packing as well as the plaintiff's.

The question of law now arises, which is, are the two machines, up to the point where the difference commences, the same in principle, so as to invalidate the plaintiff's claim to the hopper-boy as the original inventor of it? I take the rule to be, and so it has been settled in this and in other courts, that if the two machines be substantially the same, and operate in the same manner to produce the same result, though they may differ in form, proportions, and utility, they are the same in principle; and the one last discovered has no other merit than that of being an improved imitation of the one before discovered and in use, for which no valid patent can be granted, because he cannot be considered as the original inventor of the ma-



chine. If the alleged inventor of a machine, which differs from another previously patented merely in form and proportion, but not in principle, is not entitled to a patent for an improvement, which he cannot be by the second section of the law, he certainly cannot, in a like case, claim a patent for the *machine itself*.

The question for the jury, then, is, are the two hopper-boys substantially the same in principle?—not whether the plaintiff's hopper-boy is preferable to the other. Because if that superiority amounts to an *improvement*, he is entitled to a patent only for an improvement, and not for the whole machine. In the latter case, the patent would be too broad, and therefore void when the patent is single.

If you are of opinion that the plaintiff is not the original inventor of the hopper-boy, he cannot obtain a verdict on that claim, unless his is an excepted case. The first, second, third, and sixth sections of the general Patent Law conclusively support this opinion. But the *judgment* of the Supreme Court in this case, (3 Wheat. Rep., 519, *ante*.) is relied upon by the plaintiff's counsel to prove that this is an excepted case; insomuch that the plaintiff is entitled to a verdict, although you should be satisfied that he is not the original inventor of the hopper-boy. But we are perfectly satisfied that the interpretation put upon the last clause of the judgment by the plaintiff's counsel is incorrect; and that for the following reasons: 1. The question of priority of invention was not before the Supreme Court, and it is therefore incredible that any opinion, much less a judgment, would have been given upon that point. The error in the charge, which this part of the judgment was obviously intended to correct, is stated by the Chief Justice in the following words:

"The second error alleged in the charge, is in directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to be made thereon by Oliver Evans.

"This part of the charge seems to be founded on the opinion that if the patent is to be considered as a grant of the exclusive use of distinct improvements, it is a grant for the hopper-boy itself, and not for an improvement on the hopper-boy." Page 512.

It contradicts what is stated on page 517, where it is said that the plaintiff's claim is to the machine "*which he has invented*," &c. Now, if he did not invent the hopper-boy, he has no claim to it; and if so, could the court mean to say that he was nevertheless entitled to recover under that claim? Such a decision was certainly not called for by the terms of the "act for the relief of Oliver Evans," but would seem to be in direct violation of it. The act directs a patent

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to issue to Oliver Evans, not for his *hopper-boy, elevator, &c.*, but “for his invention, discovery, and improvement in the art, &c., and on the several machines which he has discovered, invented, and improved.” Now, if the *hopper-boy* was not *invented, &c.*, by O. E., this act, without which O. E. could not have obtained a patent, did not authorize the Secretary of State to grant him one for that machine; or if granted, it is clear that it was improvidently done. If, indeed, the Supreme Court had been of opinion that the fact of Oliver Evans’s prior invention was decided, and could constitutionally have been decided, by Congress, there might have been more difficulty in the case; but the argument of counsel, which pressed that point upon the court, was distinctly repudiated. We conceive that the meaning of that part of the opinion is, that this court erred in stating to the jury that O. Evans was not entitled to recover if the *hopper-boy* (that is, the original *hopper-boy*) had been in use prior to the plaintiff’s alleged discovery of it; because if the plaintiff was entitled to claim an *improvement* on the *hopper-boy*, which this court had denied, and which the Supreme Court affirmed, this court was clearly wrong in saying to the jury that the plaintiff could not recover for his improvement, which, in effect, was said. Upon the whole, then, the court is of opinion that O. Evans is not entitled to a verdict in his favor as the inventor of the *hopper-boy*, if you should be of opinion that another *hopper-boy*, substantially the same as his in principle, as before explained, up to the point where any alteration or improvement exists in his *hopper-boy*, was invented and in use prior to the plaintiff’s invention or discovery, however they may differ in mere form, proportions, and utility.

2d. The plaintiff’s next claim is to an improvement on a *hopper-boy*, which claim, we were of opinion, in another case, has received the sanction of the Supreme Court. His counsel contended that his improvement is: (1.) On the original method of supplying the bolt by manual labor; (2.) On his own *hopper-boy*; and (3.) On some *hopper-boy*, invented by some other person. Let this position be analyzed.

1. It is said to be an improvement on the original method by manual labor. But it is obvious that if this be the invention, it is of an original machine, because wherever the Patent Law speaks of an improvement, it is on some *art, machine, or manufacture, &c.*, and not on manual labor, which was applied to the various arts long before the invention of machinery to supply its place.

2. An improvement on his own discovery.

But where is the evidence of such invention? It is true that Joseph

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Evans has stated that the plaintiff constructed, in 1784, a rude model of a hopper-boy; but it was no substitute for manual labor, because, without the cords or leading lines, the arm could not move, and it was therefore turned by hand. It was, in fact, in an incomplete state; in progress to its completion, but not given out, or prepared to be given out, to the world as a machine, before 1785, when the cords to turn the arm were added.

3. An improvement on a former machine.

This is a fair subject for a patent; and the plaintiff has laid before you strong evidence to prove that this hopper-boy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law which has been raised by the defendant's counsel remains to be considered, which is that the plaintiff's patent for an improvement is void, because the nature and extent of his improvements are not stated in his specification.

The patent is for an improved hopper-boy, as described in the specification, which is referred to and made part of the patent. Now, does the specification express in what this improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating, and claims as his invention the machine, the peculiar properties or principles of it, namely, the spreading, turning, and gathering the meal, and the rising and lowering of its arm by its motion to accommodate itself to the meal under it. But does this description designate the improvement, or in what it consists? Where shall we find the original hopper-boy described, either as to its construction, operation, or use, or by reference to any thing by which a knowledge of it may be obtained? Where are the improvements on such original stated? The undoubted truth is, that the specification communicates no information whatever upon any of these parts. This being so, the law, as to ordinary cases, is clear that the plaintiff cannot recover for an improvement. The first section of the general Patent Law speaks of an improvement as an *invention*, and directs the patent to issue for this said invention. The third section requires the applicant to swear or affirm that he believes himself to be the true inventor of the art, machine, or improvement for which he asks a patent; and, further, that he shall deliver a written description of his invention, in such full, clear, and exact terms that any person acquainted with the art may know how to construct and use the same, &c. That it is necessary to the validity of a patent that the specification should describe in what the improvement consists, is decided by Mr. Justice STORY, in the cases referred to in the ap-

pendix to 3 Wheat. Rep., and in the case of *Bombon v. Bule*, *Bovill v. Moore*, *M'Farlane v. Price*, *Harmer v. Playne*, and perhaps some others. What are the reasons upon which this doctrine is founded? They are to guard the public against an unintentional infringement of the patent during its continuance, and to enable an artist to make the improvement, by a reference to some known and certain authority, to be found among the records of the Secretary of State, after the patent has run out. But it is contended, by the plaintiff's counsel, that the law would be unreasonable to require, and that it does not require, this to be done, unless the improvement is upon a *patented* machine, a description of which can be obtained by a reference to the records of the Secretary of State's office; that it might often be impossible for the patentee to discover, and, consequently, to describe, the parts of a machine in use, perhaps, only in some obscure part of the world. The answer to this is, that an improvement necessarily implies an original, and unless the patentee is acquainted with the original which he supposes he has improved, he must talk idly when he calls his invention an improvement.

If he knows nothing of an original, then his invention is an original, or nothing; and the subsequent appearance of an original, to defeat his patent, is one of the risks which every patentee is exposed to under our law.

As to the supposed distinction between an improvement on a machine patented and one not so, there is nothing in it. In both cases the improvement must be described, but with this difference: that in the former case it may be sufficient to refer to the patent and specification for a description of the original machine, and then to state in what the improvements, or such original, consists; whereas in the latter case it would be necessary to describe the original machine, and also the improvement. The reason for this distinction is too obvious to need explanation.

If the general law upon this subject has been correctly stated, the next question is, is this an excepted case? It is contended by the plaintiff that it is so. First, in virtue of the act for the relief of O. E.; and, second, by the decision of the Supreme Court.

1. Under the private act, that declares that the patent is to be granted in the *manner and form* prescribed by the general Patent Law. What constitutes the manner and form in which a patent is granted by the law? The obvious answer is, the petition—the patent, with the signature of the President and the seal of the United States affixed to it—the oath or affirmation, the specification, or description of the invention, as required by the third section, the drawings and

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models, if required. Will it be contended that a patent would be granted in the *manner and form* prescribed by this law, if there were no description whatever of the invention? And if it would not, which is taken for granted, where is the difference between the total absence of a specification, and one which has no reference at all to the invention for which the patent is granted?

This is not the case of an imperfect or obscure description, but of one which relates exclusively to the whole machine, whereas the invention for which the patent is granted is for an improvement.

2. The opinion of the Supreme Court, which states "that it will be incumbent on the plaintiff, where he claims for an improvement, to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists." 3 Wheat. Rep., 518, *ante*. But how is it to be shown? The court has not pointed out the manner, and we therefore think the only fair implication is, that it must be shown as the statute of the United States and the general principles of law require; that is, by the patent and specification. If it may be shown by parol evidence to the jury, as the plaintiff's counsel contend it may, then it may be fairly asked, *cui bono*, which sort of a showing would then be, so far as it would be productive of any useful purpose? As to the defendant, the evidence comes too late to save him from the consequence of an error innocently committed. As to the public at large, with a view to caution during the continuance of the patent, and to information of the nature of the improvement after its termination, the evidence given in this case must be evanescent and totally useless.

We feel perfectly convinced that the meaning of the Supreme Court, as to this patent, is again misunderstood by the plaintiff's counsel, not only for the reasons above mentioned, but because the *extent and construction* of the plaintiff's patent, and not the validity of it, in relation to any one of the machines, were the questions before that court, and none others (in reference to the charge) were argued at the bar, or reasoned upon by the Chief Justice in delivering the opinion.

Upon the whole, we are of opinion that the plaintiff is not entitled to a verdict for the alleged infringement of his patent for an improvement of the hopper-boy.

Whereupon a verdict and judgment thereon were rendered for the defendant in the Circuit Court, and the cause was again brought by writ of error to this court.

*Mr. C. J. Ingersoll*,\* for the plaintiff, premised a review of Evans's inventions and improvements as in proof in the cause, originating in 1783, and perfected, as regards the hopper-boy, in 1785; the grants from the legislatures of Delaware, Maryland, and Pennsylvania, in 1787; the first patent of the plaintiff under the Federal government, in 1790, and the second in 1808, by virtue of the special act of Congress for the relief of Oliver Evans. The great utility of those improvements was now universally acknowledged; while the patentee was deprived of all their advantages. It was a singular misfortune for him, among others, to be under the necessity of bringing his patent a second time before this court for revision, in the same case, in which much of the matter in dispute was the construction of the opinion formerly pronounced, reversing that of the Circuit Court of Pennsylvania, which that court had occasion to review. It was the earnest hope of the plaintiff that a full and final decision would now take place, so as to put the subject at rest.

With respect to the matters of evidence, he contended: (1.) That David Aby was incompetent as a witness, because he was sued *in pari delicto*, and of course disposed to vacate the patent he had himself infringed. Interest in such a question is equivalent to interest in the cause. Perhaps even the verdict might be given in evidence, under the sixth section of the act of 1793, ch. 11, which enjoins it on the court to declare the patent void in the event of a verdict for the defendant. The plaintiff's answer to this objection is, that as the patent is for several machines and improvements, the court could not annul such a patent but on the foundation of a verdict against all the claims. But why not? Why not declare it void *pro tanto*? Every principle applicable to common cases applies to this. Nay, it is even more necessary, in so complicated a monopoly, to guard the public against imposition or vexation, by demands founded on any part of it, tried and abrogated. (2.) It was objected to David Aby, as a witness, that he and six others, including the defendants in these cases, as was ascertained on his *voir dire*, combined to defeat the suits, and for that purpose contributed a common purse to bear the expenses of defending them. If any surplus remained, it was to be returned by the witness, who acted as treasurer; if any deficiency, it was to be raised by further levies from the contributors. This was breaking down all distinction between bias and interest. It amounted, perhaps, to maintenance. 5 Burr., 2730; Phill. Ev., ch. 5, page 49. (3.) David Aby was suffered to prove the existence of the Stauffer

\*Some part of his argument is applicable to the points of evidence in the subsequent case of *Evans v. Hettich*.

## Argument for the plaintiff.

original hopper-boy, when the notice was that evidence would be given of the existence of the improved hopper-boy. The notice is in 3 Wheat. Rep., 470. By this, a complete surprise was inflicted on the plaintiff. The defendant's position was, that for this purpose he waived the notice of special matter and gave the evidence, under the general issue, as proof of non-user. But as the notice is equivalent to a special plea, was it competent to the defendant, after putting it in, to abandon it on the trial? There no doubt are cases when the defendant might avail himself of the general issue. 3 Wheat. Rep., App., 27, *ante*. But this was a case of special matter, *tending* to prove that the specification does not contain the whole truth, or that the thing was not *originally* discovered by the patentee. The decisive proof of this position is, that the defendant was allowed to use the same evidence to show that the plaintiff was not original with his hopper-boy, which he used to show that the defendant did not use the hopper-boy. It was an evasion of the wholesome provisions of the sixth section of the act of 1793, (act of 1793, ch. 11, § 6; 3 Wheat. Rep., 504, *ante*), calculated to destroy a patent by means which a patentee never could possibly controvert. It was an aggravation of these objections, that the court charged the jury that after a witness was ruled by the court to be competent, the jury could not disqualify him on the ground of discredit, but must believe him, unless otherwise contradicted. By this course of proceeding, the defendants were their own witnesses, and the plaintiff was not allowed to discredit them. (4.) The court should have suffered the plaintiff to prove that the son of one of the Stauffers, and the executors of another, purchased Evans's improvements. On the former occasion, similar evidence was sanctioned as to the Stauffers themselves, the alleged originators of the hopper-boy. 3 Wheat. Rep., 495, 505, *ante*. And why not the acknowledgments of their descendants and legal representatives? It was treated before as evidence of opinion. If so, why not the opinion of one generation as well as another? But it was more than opinion. It was traditionary history of the invention and improvements. (5.) The court should have suffered the defendant's witness, Philip Frederick, to be asked whether Daniel Stauffer was subject to fits of mental derangement. Stauffer was the defendant's principal witness; and that was a most material circumstance in his faculty to bear credible testimony as to remote periods and obscure circumstances. Besides, the witness, Philip Frederick, if he had denied the fact, might have been contradicted by other testimony; in which respect it was a very important inquiry to be made of him, with a view to Frederick's credit. (6.) The deposition of Michael Forner

was overruled, after that of John Shetter had been received, under precisely the same circumstances. Neither of them was taken according to the act of Congress, which is inconvenient and unfair in its operation. Rules for depositions were entered by both parties. Both parties took depositions under these rules. When the defendant offered to read Shetter's deposition, no objection was made, and it was laid before the jury. But when the plaintiff offered to read Forner's, taken in the same manner and under the same rules, it was objected to and overruled. The clerk testified that for twenty years the practice had been to take depositions by rule, on notice, instead of taking them under the act of Congress, which requires no notice where the witness lives more than one hundred miles from the place of trial. There was, therefore, evidence of mutual consent and understanding between the parties, deducible both from the invariable practice and from the rules entered and acted on in these cases. Yet the court rejected the plaintiff's proof, and suffered the defendants' to remain as received, in force. Thus, the plaintiff was most unexpectedly deprived of some of his most material testimony, while the defendants themselves were their own witnesses.

The main matter in dispute was on the court's construction of the word *improvement* which it imputed to the patent. This radical difficulty escaped notice when these cases were before discussed in the Circuit and Supreme Courts. 1. It was a misapprehension to suppose that the word exists at all in the patent or specification in connection with the hopper-boy. The patent is for improvements in the art of manufacturing flour, and for certain other machines, one of which is denominated an *improved* hopper-boy. But the distinction is obvious between something patented as an improvement of a hopper-boy, and something patented as an improved hopper-boy. The latter was so called as substituting mere machinery for manual labor. It might be so called as a caveat against unknown but possibly existing originals, which, in the strong illustration of the court, would avail a defendant if he could prove their existence in the mountains of China. It might be so called as meaning nothing more than amelioration of the inventor's own original essays. Evans's hopper-boy was a great and most beneficial improvement, which he called an improved hopper-boy. But it had no original. Even the bolt-filler ascribed to Stauffer, alleged to be of earlier origin, was as different in principle as it was inferior in practice to the plaintiff's machine.

2. It was a second error of the court, to take it for granted that the improved hopper-boy was not so described in the specification



## Argument for the plaintiff.

as to distinguish it from all things before known or used, and to enable a person skilled in the art to make it. It is so described. [Here the counsel went into a specification of the peculiar structure and properties of the hopper-boy.] No one skilled in the art could misapprehend this description, or be misled by it. The error of the court was in condescending to consider itself skilled in the art of which this is a branch. The law does not require of patentees to describe new *and* old, but merely to distinguish new *from* old. Otherwise a patent would be more complex and voluminous than a Welsh pedigree. Take a boat, for instance; must every species, from the ark downwards, be described? The peculiar properties of the improved hopper-boy are perfectly explained. It is not a mere change of form and proportions, but a combination of well-known materials, on new principles, essentially set forth in the specification, so as to prevent all interfering claims during the exclusive term, and to impart the rights to the public afterwards. The authorities were misunderstood by the court in this respect. They all require, to be sure, a discrimination, when the subject-matter is an improvement. But they require only an essential improvement; not a recapitulation of the particulars of both the old rudiments and the new combinations, in detail, distinguishing them in terms.

3. This, however, was a question of fact to have been submitted to the jury, instead of being, as it was, exclusively assumed and determined by the court. How can a court decide whether a person skilled in the art could understand a description and copy a machine? The cases are uniformly so. 8 T. R., 95; 11 East's Rep., 101; 2 Marsh. Rep., 211; Starkie's N. P. Rep., 199; 3 Meriv., 622; 1 Gallis., 438; 2 Gallis., 51; 1 Mass., 182, 452; 3 Wheat. Rep., 513, App., 17, *ante*. In all these cases, the court left this inquiry as a fact to the jury. Indeed, the sixth section of the act of 1793, ch. 11, treats it not only as a matter of fact, but of fraud. It must appear that the specification is untrue, either deficient or redundant, in order to deceive the public. It is matter of concealment. Can the court infer this *scienter*?

4. Indeed, it may well be doubted whether any discrimination is necessary where, as in this case, there is but one patent in existence. The second section of the law speaks of the case of a prior patented machine. The court would have the third section to be substantive, without association with the second and sixth. But how can a patentee describe what he never saw? If not before patented, how could he see or know? If he knew, but concealed his knowledge, is it not matter of fraud? The cases, when examined, will be found

to have most of them referred their reasoning to the point of conflicting patents. Such is the fact in *Harmer v. Playne*, *Bovill v. Moore*, and *Lowell v. Lewis*. Which explanation is all-important to a correct understanding of those cases.

5. The special act of Congress for the *relief* of Oliver Evans vouchsafes him from all *technical* obstacles. His improvements by that time were universally acknowledged. Congress did not mean to forestall the ascertainment of their *originality*, which any citizen might try, if he chose, nor their utility. But the relieving act dispenses with specification, oath, fee, and all the other prerequisites of common cases. It was not designed merely to prolong the term of monopoly, but to relieve it from vexatious and frivolous embarrassments. Accordingly, it uses the term *improvements*, in addition to the terms applied to such subjects by the act of 1793; and confers on Oliver Evans an exclusive right in his discoveries, machines, and improvements, in general and specifically. The obvious design of this act of grace was to relieve the grantee from all the formalities to which patentees in common are subjected, leaving the question of priority or originality alone open to inquiry by the country.

6. But even this inquiry was not competent to these defendants, who are citizens of Pennsylvania. The act of Assembly of that Commonwealth, in 1786, confers on Evans the exclusive right in his hopper-boy, and inflicts penalties on all infractors of it. To this act, the defendants directly acceded and contributed by their representatives; and it is a well-settled principle that they are bound by their legislation. 10 East's Rep., 536; 3 John. Ch. Rep., 598. Nor is this position at all affected by the seventh section of the act of 1793, ch. 11.

*Mr. Sergeant, contra.*

A patent is intended to secure to an inventor the exclusive right for a limited time to his invention. At the expiration of the period, the thing thus secured is to become public property, which any one is at liberty to use. In the meantime, every one is to abstain from using the thing patented, at the peril of a severe responsibility in damages. The provisions of the Patent Law have a view to these several objects, all of which are to be promoted as far as possible, and reconciled with each other, the public security and the benefit being protected, as well as the interests of the inventor. He is to enjoy the fruits of his ingenuity upon terms and conditions which are compatible with the safety, the peace, and the interests of other citizens.

## Argument for the defendant.

A patent, therefore, in the first place, can only be for an *original invention*. It is of no importance that a man really believes himself to be the inventor, or is the *true* inventor, having made the discovery himself, without even the knowledge that the thing he supposes himself to have invented was known or used before, or described in some public work. However honest he may be, he has not merit, as respects the rest of the community, in discovering what was already known and open to common use, nor will he be allowed to appropriate the thing to himself because he has made a mistake. The *truth* of his invention, though not an original one, will protect him against a summary proceeding to set aside his patent *under the tenth section of the act of 1793, ch. 11*; but it will not avail him to enforce his claim in an action against an individual. The want of originality, proved by showing that the thing was used or known before, or described in some public work, is, in every case, a valid and conclusive defense.

Again, an invention may be of a machine, or of an improvement on a machine, of something that was entirely unknown before, or of an addition to, or alteration in, what was previously known, so as to make it more useful. Each of these is a patentable object; but the patent, as to both, is to be for the *invention* only, and the laws that govern it, thus understood, will be found to be exactly the same. Novelty is an essential part of the merit, and it is only what is *new* that is to be secured by the patent. A mistake is just as fatal to the patentee in the one case as in another; and if he should really believe himself to have invented an improvement, when, in truth, it was known, used, or described before, he could not give legal effect to his patent. There is, however, one peculiarity in the case of patents for improvements. Improvement being a relative term, presupposes the existence of something to which it refers, known to the inventor at the time of making the supposed improvement. If he does not know of it, he cannot know he has improved upon it; and if he does know of it, he can readily describe the improvement he has made—that is, his own invention. A man who has never heard of a time-keeper, might suppose himself the inventor of one; but it is impossible to conceive that a man who has never heard of such a thing should believe himself to be the inventor of an improvement upon the time-keeper.

A patent for an entire machine covers the whole; a patent for an improvement, on the contrary, covers only the improvement, and necessarily *supposes there are parts which are not patented*. It is the line between these and the parts which are patented that defines the re-

spective pretensions of the patentee and the public; and unless that line be somehow marked, it is impossible to say where the one terminates and the other begins. Confusion, uncertainty, extortion, fraud, and litigation would be the inevitable consequence.

It is the business and duty of the inventor, then, at the time of applying for his patent, and before he can receive a patent, to deliver a "written description of his *invention*, and of the manner of using or process of compounding the same, in such full, clear, and exact terms *as to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same,*" &c. Section 3. This *specification* is to remain in the office of the Secretary of State, and a copy of it is everywhere made evidence. The design of this provision is manifest: it is to secure to the public the use of the invention, after the expiration of the period for which the patent is granted, and to enable individuals, in the meantime, to know what it is that is intended to be secured, so that they may avoid interference, or, if they think proper, dispute the claim of originality. For both these purposes, it was necessary that there should be authentic and recorded evidence, accessible to all, and remaining unchangeable and unchanged. Without a specification, the patent would be void. A specification which does not comply with the requirements of the act of Congress is, to all legal intents, no specification, and the patent would be equally void, as if there were literally no specification.

In the present case, the patent is to be regarded either (1) as a patent for the whole machine, or (2) as a patent for an improvement on an old and known machine. The utmost that can be contended is, that the patentee has an election to consider it as the one or the other; and that is a very liberal concession, inasmuch as it is founded upon the ambiguity of his own specification, from which, generally, a man ought not to be permitted to derive an advantage. But it is clear that it cannot be a patent for both. That would be a legal absurdity, involving a plain contradiction in terms.

1. As a patent for the whole machine, including the plaintiff's alleged improvement, it is void, because the plaintiff was not the original inventor of the machine. The fact that a hopper-boy, known by the name of an S. or Stauffer hopper-boy, having all the essential parts of the plaintiff's machine, and applied to the same uses and purposes, (whether more or less perfectly is not material to inquire,) existed, and was in use before the date of the plaintiff's earliest alleged discovery, has twice been proved to the satisfaction of intelli-

## Argument for the defendant.

gent juries in each of these cases, and is now to be taken for granted as conclusively established. At the former trial, the learned judge who presided (Mr. Justice WASHINGTON) instructed the jury, if they should be of opinion that Oliver Evans was not the original inventor, to find for the defendant; which they did accordingly, being fully satisfied of the fact. Upon error to this court, the judgment was reversed, on the ground that the patent was not for the machine, but for an improvement, the phrase "improved hopper-boy" being, after much hesitation, deemed equivalent to "improvement" on a hopper-boy. But the opinion of the court distinctly admits what, indeed, cannot be questioned, that if, as respects the hopper-boy, the patent had been for the whole machine, the direction of the learned judge would have been right.

In giving to the plaintiff the benefit of the alternative, the case was put in the most favorable view for him. He might claim as inventor of the whole machine, or he might claim as inventor of the improvement; but, under this patent, he could not claim for both; and in claiming for either, he must, of course, abide by the settled principles of law applicable to the construction of the patent thus adopted. Each must be taken singly. The two could be confounded, so as to entitle him upon the one to the benefit of principles belonging to the other. If the patent be for the whole machine, it is void if he is not the original inventor; and that he is not, has been fully established.

It is intimated, however, and will probably be insisted upon hereafter, that, admitting the S. or Stauffer hopper-boy to have been previously known and used, the two machines are so entirely different that Mr. Evans might well be entitled to a patent for the whole. As a question of fact, that has been decided by the verdict of the jury; and the identity of the machine must now be taken for granted, unless the jury were led to the conclusion by an erroneous charge from the court. What constitutes identity, and what diversity, is frequently a question of great difficulty. It was the right and the duty of the judge to inform the jury what were the principles to guide their deliberations in deciding it, and this he has done with admirable clearness, and in conformity with the best authority upon this abstruse part of the law. "Where a specific machine already exists," (says Mr. Justice STORY,) "producing certain effects, if a mere addition is made to such machine, to produce the same effects in a better manner, a patent cannot be taken for the whole machine, but for an improvement only." *Whittemore v. Cutter*, 1 Gallis., 430. And the same learned judge says: "The material question, therefore, is not

## Argument for the defendant.

whether the same elements of motion, or the same component parts, are used, but whether the given effect is produced substantially by the same mode of operation, and the same combination of powers, in both machines." *Odiorne v. Winkley*, 2 Gallis., 54. The identity here is perfectly apparent upon the description, and still more so upon inspection of the models. The *object* of both is the same—to dispense with manual labor, and supply the hopper; to supply it gradually, in small, successive, regular portions, by means of the power that moves the mill—substituting mechanical contrivances for human agency. The *effect* is the same—to turn, stir, and cool the flour, and thus prepare it for bolting before it is delivered. The *construction* of the machines, as to the "mode of operation" and "the combination of powers," is the same. In both there is an upright shaft, with a cog, turned by the power that moves the mill; an arm resting lightly on the meal, and turned by the upright shaft; something on the under part of the arm, whether flights or sweepers, to gather in the meal to the hopper. So far they are the same. Now for the differences. The plaintiff's machine has a round shaft instead of a square one; it has leading lines, which are necessary in consequence of the shaft being round, and a weight to balance the arm. These may all be improvements, but they are only *improvements*, and do not make a different machine. The name itself bespeaks identity; the old machine was called a bolt-filler, or hopper-boy, and the plaintiff's is called "an improved hopper-boy."

But if the machines be so entirely different as to entitle the plaintiff to a patent for the whole, though the S. hopper-boy was previously known and used, then it would necessarily follow that, even if the plaintiff were the original inventor of the improved machine, and that was the first invention, yet any one might, with impunity, make and use such a machine as the S. hopper-boy; that is to say, by stripping off some of the parts, he might entitle himself to use the residue. This is a proposition too monstrous to be maintained. If it be sound, it decides this case without any regard to the question of the original invention, for the defendant Eaton used only the S. hopper-boy.

A sure test, however, of the identity, is to consider what parts are indispensable to both machines. They are, the upright shaft with a cog in it, the arm, and the sweeps. With these, the machine will work; without them, it will not. These parts are common to both machines. What is it that the plaintiff has added? What is not indispensable, but perhaps better. This is exactly the definition of an improvement. Can he, in his improved machine, dispense with any one of the parts that belong to the old machine? The answer

## Argument for the defendant.

is clear: he cannot. Can we dispense with any of his additions? Yes, with all of them. The machine is complete—an efficient agent for its purpose—without them; the evidence even leaves it doubtful whether, apart from the elevator, it is not the better of the two. It is certainly in use, and is the very machine for the use of which Mr. Eaton is sued. There can be no serious doubt that, if the plaintiff has any claim, it is only for an improvement.

2. As a patent for an improvement, it is void, because the specification does not show in what the improvement consists, or, in other words, what it is that the plaintiff claims as his invention—"the nature and extent of the improvement are not stated in his specification." This was the precise ground of the decision below.

The counsel for the plaintiff who opened the argument was understood to concede that, if the patent be for an improvement, and there be nothing in the circumstances of this particular case to make it an exception from the general rule, the law was correctly laid down. And certainly there can be no doubt of this, whether we consider the spirit and terms of the act of Congress, the decisions in England, or the adjudged cases in the United States.

The current of authority of every sort is uniform to establish that the invention, to be patented, must be described in such full and exact terms as to "distinguish the same from all things before known." The second section of the act has no relation to this question. That provides for the case where one man has a patent for a machine, and another for an improvement, declaring that the one shall not be at liberty to use the invention of the other, and thus precisely limiting their respective rights. Does it follow that, if a machine has not been patented, he who improves upon it has a right to appropriate the whole to himself, and withdraw what was before public property from the public use?—that no one can afterwards make use of the old and known machine, without the license of the patentee? The section was made with a different view, and leaves what is not provided for upon the same footing on which it before stood. What was common property, remains so; the patentee of the improvement is at liberty to use it, because it is common, and the legislation was necessary to enable him; but he is not allowed to appropriate it to himself, to the exclusion of others, any more than to appropriate the invention of a prior patentee. The sixth section, which makes it a good defense that the patentee has stated more or less than the truth in his specification, "for the purpose of deceiving the public," has no relation to the question. There is no allegation here that the machine will not produce the described effect, or that

## Argument for the defendant.

more or less has been stated for the purpose of deceiving or misleading the public. Nor is this, the court will recollect, a summary proceeding to set aside the patent under the tenth section.

But the question, and the only question, is, whether, in an action by a patentee against a person charged with infringing his patent, it is not necessary for the plaintiff to show in what his invention consists. In the former argument of this case, this court have laid it down expressly that "in all cases where his claim is for an improvement, it will be incumbent on *him* to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists." 3 Wheat. Rep., 518, *ante*. How is this to be shown? The answer is obvious: it is to be shown from the specification. That such was the meaning of the court, is evident from their adopting almost the very words of the act of Congress which are employed to describe the office of the specification, "so that a person understanding," &c. That nothing else could be their meaning, is evident; for such, it cannot be denied, is the clear design of the act of Congress, and such is the established law as collected from authoritative decisions. The patent must not be more extensive than the invention; therefore, if the invention consists of an addition or improvement only, and the patent is for the whole machine or manufacture, it is void. Bull. N. P., 76; *Boulton v. Bull*, H. Bl. Rep., 463. In England, the specification is not annexed to the patent, but is enrolled in Chancery. Yet, the specification is a part of the patent, for the purpose of ascertaining the nature and extent of the alleged invention. *Boulton v. Bull*; *Hornblower v. Boulton*, 3 Term Rep., 95.

In this country, it is filed in the Department of State. An authenticated copy of it is always annexed to the patent, and forms a part of the patent, absolutely essential, because the patent, properly so called, in fact gives no description, referring for that to the specification. The established formula used in all patents, and to be found in the present patent, is, "the said improvement, a description whereof is given in the words of the said Oliver Evans himself, in the schedule hereto annexed, *and is made a part of these presents*." Now, what should the patent comprehend? Where the combination of a certain number of the parts has existed, up to a certain point, in former machines, the patentee merely adding other combinations, the patent should comprehend such improvements only. *Bovill v. Moore*, 2 Marsh. Rep., 211. And the cases that have been already referred to clearly decide that, if the invention be of an improvement only, it is indispensable that the patent should not be broader than the invention; and the specification should be drawn up in terms that do not include any-



## Argument for the defendant.

*thing but the improvement.* It is essential to point out what is new and what is old, so as to show precisely the extent of the alleged improvement. "The patentee ought, in his specification, to inform the person who consults it what is new and what is old. He should say, my improvement consists in this, describing it by words, if he can, or, if not, by reference to figures." But here the *improvement* is neither described in words nor figures; and it would not be in the wit of man, unless he were previously acquainted with the construction of the instrument, to say what was old and what was new. A person ought to be warned by the specification against the use of a particular invention. Per Lord ELLENBOROUGH: *M'Farlane v. Price*, 1 Starkie's Rep., 199. It need not be denied that this description might be sufficiently given by reference, as to some other patented machine, or to some well-known machine in familiar use. For instance, to use the illustration employed by Lord Ellenborough, if we should say, take a common watch, and add or alter such and such parts, describing them. All that is contended, and that is fully supported by authority and by reason of the case, is, that the specification must, in some way or other, distinguish the new from the old, the improvement from what was known before, so as to show what the patented invention is, or else the patent is broader than the invention, and void. The decided cases in the United States are to the same effect. If the inventor of an improvement obtain a patent for the whole machine, the patent, being more extensive than the invention, is void. *Woodworth v. Parker*, 1 Gallis. Rep., 439; *Whittemore v. Cutter*, 1 Gallis. Rep., 429; *Odiorne v. Winkley*, 2 Gallis. Rep., 51.

The cases are brought together, well digested, and the principles stated, in the Appendix to 3 Wheat. Rep., 13, *ante*.

How else can the extent of the improvement be shown? Shall it be by evidence at the trial? Then the design of the act would be entirely defeated, and the specification useless. The argument of the court below upon this point is perfectly conclusive. To say that the patent may be for the whole machine, and the claim for as much as the plaintiff can prove to be original, or rather the defendant cannot disprove, is to make the right depend, not upon the patent, nor even upon the fact of originality, but upon the evidence the party may have it in his power to produce, and his intelligence and skill in applying it. The right, instead of being uniform everywhere, might be one thing in one State, and another in another. In different courts of the same State, it might be different. And even in the same court, at different times, as the particular evidence happened to vary, it would be more or less extensive. The patent would, in

effect, be nothing but an outline, large enough, of course, to be filled up as occasion might serve. This is an absurdity, and, what is worse, a great temptation to fraud. Besides, under this supposition, how is any man to inform himself what it is that is patented, so that he may avoid the danger of the infringement? It is too late, at the time of trial, to answer any good purpose to the defendant. And how are the public to be informed at the expiration of the time, or how is a person of skill to be able to make the improvement? In short, of what use is the specification, unless it be to define, with precision, the extent and nature of the improvement? The act of Congress emphatically refers to the specification, and to that alone, as furnishing everything, without extrinsic aid; and so it must do. If it be broader than the invention, the patent is void.

But it is objected here that this was a question for the jury, and not for the court. Whether the specification is broader than the invention may, perhaps, in some cases, be a question of fact, or a mixed question of fact and of law, the construction of the written instrument of specification being for the court, and the other evidence in the case for the jury. But if it be "incumbent upon the plaintiff to show the extent and nature of his improvement," and that is to be shown from the specification, then it is plainly incumbent upon him to show from the specification, where he claims for an improvement, that he has described an improvement, as distinguished from a known machine. And that, it is submitted, being exclusively a question arising upon the face of the instrument, is a question for the court. Let us examine the specification. Is there anything in it which even professes to describe an improvement, as distinguished from a machine known or used before? Does it not plainly, and in terms, include the whole machine? That is evidently a question of law upon the face of the instrument, and it may be confidently pronounced that it does include the whole, and that no man can so read the specification as to ascertain which parts are claimed by the plaintiff and which are not, or that there are any parts which are not claimed by him. But it is due to the court further to say that the charge in this respect must, as in all other cases, be understood with reference to the allegations and to the evidence. If there had been an attempt to prove, or even an assertion, the most distant intimation, that men of skill in mechanics, bringing to the study of this most difficult specification the aid of peculiar knowledge, could discern in it a line between new and old, or any defined limits of improvement, that would doubtless have been fit to be heard; and whatever matter proper for the consideration of a jury might have arisen, would have been submitted

## Argument for the defendant.

to the jury. But no such evidence was offered; the record shows it. No such suggestion even was made; it was not pretended; the charge shows it; for the part excepted to was itself a reply by the court to an argument of the plaintiff's counsel, which admitted that the specification did not show in what the improvement consisted, by contending for the extravagant position that it was competent to show by evidence at the trial, which is in effect to say, that the plaintiff was entitled to whatever the defendant had not disproved.

It has been said, however, and to our very great surprise, that the court below erred in dealing with this patent as a patent for an improvement; that it is not for an improvement, but for an *improved hopper-boy*. When this case was formerly before the Circuit Court, that court dealt with the patent as a patent for a hopper-boy, and not for an improvement. Upon error to this court, one error principally relied upon was, that the court below had thus construed it to be a patent for the machine. 3 Wheat. Rep., 486, 502, *ante*. And it was contended that an "improved hopper-boy," and an "improvement on a hopper-boy," were one and the same. "This," says one of the counsel, "was a patent for an *improvement* on the particular machine in question, and not for its original invention." And of that opinion were the court, after much deliberation. 3 Wheat. Rep., 517, *ante*. And can it now be contended, in the same court and by the same party, that this is not to be dealt with as a patent for an improvement? But the truth is, it has been treated in this case as a patent for both the machine and the improvement, so as to give the plaintiff the full benefit of either construction. The real aim of the argument is to maintain that a patent for the whole may be expounded as a patent for each of the parts, and legally covering as many as the patentee may be able to prove he has invented; that it may be a patent in words for one thing, and in law for another; that it may have a sort of elastic ambiguity, capable of contraction, if not of expansion, so as to adapt itself to whatever it may be found convenient at any given time to embrace. This is against all settled principles; it is against good policy; and it is against the words and the spirit of the act of Congress.

Such being unquestionably the established law upon the subject of patents in general, it remains only to inquire whether the case of Oliver Evans is, on any account, an exception. And it is insisted here that the special act for his relief makes it an exception. The history of that act is sufficient to show that its only object was to authorize a new patent to be issued, by reason of the first having been declared void for irregularity of form, attributable to the officers of

## Argument for the defendant.

the government. This gave an equitable title to relief. The appropriate relief was an extension of the time, so that the inventor might enjoy the privileges of a patent for the same time that he would have enjoyed them if the irregularity had not occurred—that is to say, the same privileges. This was sufficiently liberal, for the first patent had actually expired before the new one was granted. The new patent, too, was made retrospective, and gave to Oliver Evans an exclusive right for twenty-eight years, double the usual period; yet it was contended formerly that this special act, liberal as it confessedly was, went the further length of dispensing altogether with the necessity of proving he was the inventor, and even precluded all right to question the invention, which was in effect to say that the exclusive privilege was secured to him, whether he was the inventor or not. That was overruled by this court, upon the plainest grounds. 3 Wheat. Rep., 513, *ante*. And the whole scope of the opinion then delivered distinctly establishes that, except the extension of time and the union of different inventions in the same patent, which otherwise perhaps could not be regularly joined, the patent to be issued was to be, in all respects, conformable to the general law and subject to the same regulations as other patents. Such was the interpretation of the plaintiff himself; he applied in the usual manner by petition, with a specification and oath. Such was the interpretation of the officers of the government; the patent underwent the usual examination, and is in the usual form. Such is at this moment the interpretation; for it is upon the adoption of the general law by reference that the jurisdiction of the Federal courts, in cases growing out of this patent, entirely rests. If that law be not applicable, this court has no power to adjudicate the cause. It is needless to pursue this further, being already decided by the former decision of this court. For the terms and conditions upon which the patent was to be granted—the jurisdiction to attach to it, the rules to govern it—the special act makes no provision, but by reference to the existing laws; and but for this reference, we could not advance a single step in the inquiry.

All that has been said of the act of the Legislature of Pennsylvania, passed in the year 1787, may be disposed of in a single word. What its provisions were, does not appear; and if it did, the right they conferred, whatever it may have been, was surrendered by accepting a patent under the law of the United States. The seventh section of the act of Congress is express.

In conclusion, then, it is confidently submitted that the patent of Oliver Evans must be considered as a patent either for the machine or for the improvement.

## Argument for the plaintiff.

That if it be for the machine, it is void ; because it is fully proved that he was not the original inventor, but the machine was known and used before.

That if it be for an improvement, it is void ; because it is broader than his invention, and does not specify in what his improvement consists, so as to distinguish it from what was known and used before.

The learned counsel also argued the points of evidence in this and the next following case, (*Evans v. Hettich*,) but, as they are so fully noticed in the opinion of the court, it is not thought necessary to report that part of his argument.

*Mr. Harper, in reply*, observed that, in the opinion of the Circuit Court, two propositions were distinctly affirmed: (1.) That Evans's patent of the hopper-boy was a patent for an improvement, and not for an original invention or discovery. (2.) That, being for an improvement, it was void, because the specification did not in terms distinguish the improvements from the original machine, called the Stauffer hopper-boy. Both these propositions were indispensable for supporting the judgment below. He denied them both, and should endeavor to show that they were equally void of foundation. If he could succeed in overthrowing either, the judgment of the Circuit Court must be reversed, and the patent-right of the plaintiff supported ; but he believed, and should endeavor to show, that both were wholly unfounded.

And, first, is the patent of Oliver Evans a patent for an improvement, or for an original invention ? The decisions of the Circuit Court maintained the former. He should endeavor to demonstrate the latter.

In the outset of this investigation, it would be proper to remark that the specification makes part of the patent ; and he had the authority of this court, in the former decision in this case, (3 Wheat. Rep., 507, *ante*,) for saying that, in order to ascertain what Oliver Evans obtained by his patent, one of the proper points of inquiry was, what did he ask for ?—what was it his wish and intention to obtain ? This question may be satisfactorily answered by referring to that part of his specification which relates to the hopper-boy. This specification is printed at length in a note to 3 Wheat. Rep., and the part of it now in question is found at page 468. The description of the machine is very full, minute, and clear, and it concludes with this declaration: "I claim as my invention the peculiar properties or principles which this machine possesses, namely, the spreading, turn-

ing, and gathering the meal at one operation, and the using and lowering its arms by its motion, to accommodate itself to any quantity of meal it has to operate on."

This was what he claimed as his invention. For this he asked a patent. Not for the machine which he had thus improved, but for the principle on which it was made to operate. He has not very accurately expressed himself, or distinguished between the object to be obtained and the mode of proceeding for its attainment; between the end and the means; the result and the *modus operandi* by which it is produced. But still his meaning is obvious. The object, the end to be obtained, the result, was the "spreading, turning, and gathering the meal at one operation." The principle of the machine, the *modus operandi* by which the object was to be accomplished in a new and better way, was the power of the machine to raise and lower its arms by its own motion, so as to accommodate itself to any greater or less quantity of flour on which it may have to operate. This, then, is his invention or discovery which he claims as his own, and for which he demands a patent. His demand is complied with. He gets what he asked. This is what the grantors intended to give him; and I appeal again to the former decision for the doctrine that, in order to ascertain what is given, we must look to the request of the receiver and the intention of the giver.

It is, then, a patent for the peculiar principle of his machine, for its new mode of operating, that Oliver Evans asked for and received. That a new *modus operandi*, by a new combination of old instruments or machines so as to produce either a new effect or an old effect in a new way, is the proper subject-matter of a patent, appears from numerous authorities, and may be considered as a settled principle of the Patent Law. It was on this principle that Watt's patent for his improvements on the steam-engine, which made so much noise in Westminster Hall and produced such important effects, was finally supported and established.

The English law of patents, though different from ours in its origin, was probably the same in its principles. Indeed, our act of Congress was a mere enactment of the principles and system which the English courts had established. That system grew out of the ancient prerogative of the crown in England to grant monopolies. This power, long and often most oppressively exercised, was abolished in the early part of James the First's reign, by an act of Parliament, which was one of the earliest fruits of the increase of knowledge, the progress of correct ideas, and the improvement in the condition of society, which, at that time, had begun to appear. But, for the

## Argument for the plaintiff.

encouragement of industry and ingenuity, a proviso was introduced into the statute, that the King might still grant a monopoly "of any manner of new manufactures" to the first inventors, for any term not exceeding fourteen years. See the case of *Hornblower v. Boulton*, 8 T. R., 105; the opinion of Mr. Justice LAWRENCE. Upon this short proviso, this apparently scanty foundation, the whole structure of the English Patent Law was raised by the English government and courts. The system which they thus established was adopted by our act of Congress. This system required a specification. Nothing is said of it by the statute; but the government required it, by an express clause, of every patent. The principle on which it was required was this: The statute conferred a benefit on the inventor, by giving him a monopoly of his invention for a limited time. For this benefit conferred on the patentee by the community, it was thought just that he should make a return. That return consisted in the knowledge and free use of his invention, which, by his specification, he should enable the community to obtain after the expiration of his monopoly. This principle enables us not only to understand the origin and object of the specification, but also its nature and character, as its object was to put the public in possession of the invention, after the monopoly had ceased, so as to enable all persons to use it beneficially; it was indispensable that the invention should be so fully and clearly explained as to enable persons skilled in the same art to make and use it. This was all that was to be effected by the specification, and consequently all that it was required to contain. The very same certainty of description which would enable persons skilled in the art to make and use the invention, after the monopoly should expire, would enable them to avoid making and using it, so as to subject themselves to penalties or loss, during the continuance of the monopoly.

In the same manner, it was established that improvements in old machines or processes might be combined as "new manufactures," and become the subject of patents. This principle was also incorporated into our act of Congress, in express terms. And here the same rule was adopted with respect to the specification. The "new manufacture," whether it consisted in a machine or process entirely new, or in the improvement of an old one, was to be described with such certainty as to enable persons skilled in the art to make and use the invention, after the monopoly should expire, and to avoid it while the monopoly should exist. The principle and object were the same in both cases, and the same rule was adopted in both, by our act of Congress, as well as by the English decisions.

We shall now be able to perceive the application of the case of

Watt's patent (8 T. R., 95) to the point under consideration, which, let it be considered, is to ascertain how far the discovery of a new *modus operandi*, so as to produce a new effect, or an old one in a new way, is the proper subject of a patent, as a useful invention, and not as an improvement.

The expansive power of steam had been many years before discovered by the Marquis of Winchester, who applied it, though very imperfectly, to various mechanical purposes. Among the rest, he employed it to put machines in motion, by communicating to them the movement which the steam was made to produce in beams and levers. Thus was laid the foundation of that wonderful invention, the steam-engine. Various machines of this kind, more or less perfect, were, from time to time, brought into use; and at length Newcomen made a steam-engine, which was long considered as having attained the utmost point of perfection. It consisted of a cylinder, or large tube of iron, made perfectly smooth and uniform within, and completely closed at the bottom, but open at the top. Inside of this cylinder was placed, horizontally, a thick, strong plate of iron, so fitted at the edges to the inner surface of the cylinder as to be airtight, and yet to play easily up and down. Into the center of this plate was fitted a strong upright stem of iron, of the length required; and the stem and plate together made what is called the piston. The upper end of the piston stem was fastened by a joint to a horizontal beam, which was made fast by a joint, near the center or at the farthest end, so as to allow its near end to play up and down with the piston to which it was attached. At the bottom of the cylinder, under the piston, was introduced a pipe, or tube, leading from the boiler where the steam was generated into the cylinder, and furnished with a valve. When this valve was opened, it let the steam through the pipe into the lower part of the cylinder under the piston, which was thus raised up by the explosive power of the steam, and raised with it the end of the horizontal beam to which it was attached. When the piston, and with it the beam, had been raised as high as was intended, the valve in the steam pipe was shut by the motion of the machine, and at the same moment a valve was opened by the same means in a pipe which connected the cylinder with a vessel of cold water. A quantity of this water was then introduced into the cylinder under the piston, where it condensed the steam more or less completely and created a vacuum more or less perfect, in consequence of which the piston was pressed down by the weight of the atmospheric air resting upon it, and carried down with it the end of the horizontal beam to which it was attached. When it had subsided as



## Argument for the plaintiff.

low as was desired, it opened the steam valve, and let in the steam under the piston, which was raised as before, and again pressed down by the weight of the air, on the steam being again condensed by the introduction of cold water. This operation went on continually, and thus an ascending and descending motion was produced, which was communicated by the horizontal beam to the whole machinery.

The defect of this engine at length began to be observed. It consisted in the cooling of the cylinder by the cold water let in to condense the steam. The cylinder being thus rendered colder than steam, a considerable portion of the steam introduced was condensed by this coldness while the piston was rising, and was thus destroyed before it had done its office. This rendered a greater generation of steam necessary, and of course a greater consumption of fuel. The steam, too, was not suddenly or perfectly condensed, so as to let the piston descend with sufficient rapidity or force, by which the power and effect of the machine were diminished. The water, also, into which the steam had been converted by condensation, remained in the bottom of the cylinder, and further impeded the descent of the piston. These defects were seriously felt in a country where fuel was dear, and became continually more and more so. At length they threatened to render the engine entirely useless, by creating a greater expense in fuel than could be compensated by the labor-saving power of the machine.

Then Watt arose, who, after long reflection and many experiments, conceived the happy idea of condensing the steam in a vessel different from that in which it was to perform its office. This he effected by connecting with the machine another vessel called a connector, which was connected with the cylinder by a pipe with a valve in it. This valve being opened by the motion of the machine, at the same moment when the piston had ascended to its greatest height, the steam rushed through it into the conductor, where it met a stream of cold water, introduced by the same means which had been before employed for letting it into the cylinder. This cold water condensed it as fast as it came in; and a pump was also contrived, to work by the motion of the machine, and drew out of the conductor all the steam that remained uncondensed and all the water produced by the condensation. Thus a most perfect vacuum was created in the condenser, and consequently in the cylinder connected with it; the piston descended with freedom, rapidity, and force; and the cylinder, not being touched or affected by the cold water, retained a heat equal to that of steam; so that no portion of the steam introduced into it was condensed too soon.

This was the great improvement, but others were employed to increase its effect. The cylinder was surrounded by a case the best calculated to retain heat, and the space between this case and the cylinder was kept full of steam or boiling water. Thus the cylinder was kept in the hottest possible state—the state best adapted to the preservation of the steam while performing its office; and as steam thus preserved was found to be more effectual than atmospheric air in bringing down the piston, the top of the cylinder was closed, and steam was introduced above the piston as well as below it. This steam was conducted into the condenser, and there condensed and pumped out, in the same manner with that introduced below; and thus the piston, being alternately pressed up and down by the elastic power of steam, in its most efficacious condition gave a most powerful, steady, and uniform motion to the engine. Oily substances were employed, instead of water, in keeping the vessels air tight; especially the top of the cylinder, where the steam of the piston played through it. Thus the machine was rendered as perfect as it seems capable of becoming.

Now, in what does this machine differ from the steam-engine of Newcomen, which was in use before? Both had a boiler to produce the steam, and a cylinder to receive it. The piston was the same in both, and connected in the same manner with the horizontal beam, for the purpose of communicating the motion to the rest of the machinery. In both, the piston was raised by the expansive power of the steam; this steam, after its office had been performed, was condensed by cold water, so as to create a vacuum in the cylinder, and permit the piston to descend; and in both, pipes and valves of the same construction were used, for introducing alternately the steam and the cold water. In what, then, did they differ? Merely in a new *modus operandi*, by which, with the addition of another vessel, the cold water was prevented from cooling the cylinder, while it conducted the steam; and the steam was made to operate in forcing the piston down as well as in forcing it up. In this new *modus operandi*, produced by a different arrangement and construction of the old machines, with the addition of one new vessel, to receive and condense the steam, consisted the great invention of Watt; for which he obtained his patent, avowedly as for a new invention, or, in the language of the British statute, a “new manufacture,” and not for an improvement. His specification is inserted at length in 8 T. R., 96, note (a), where it will appear that he speaks of his discovery as a new invention, and not as an improvement, and never once mentions or alludes to the old machine.

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In what did this new discovery consist? I answer, with the two judges of the Common Pleas in England who were in favor of this patent, and one of whom was Lord Chief Justice EYRE, (*Boulton v. Bull*, 2 H. Bl., 463,) and with the four judges of the King's Bench, who were unanimous on the point, (8 T. R., 95,) that it consisted in the new principle on which the steam was condensed, and which was carried into effect by a new combination of the old machinery, with the addition of one new instrument.

The word "principle," as used in relation to this subject, is not taken in its general philosophical sense, where it means a law of motion or a property of matter; but in what may be termed its mechanical sense, in which it signifies a method of doing a thing, or of effecting a purpose—in other words, a *modus operandi*.

It is therefore established by this solemn and elaborate decision of six English judges against two, after repeated arguments and great consideration, that a new principle, or *modus operandi*, carried into practical and useful effect by the use of new instruments, or by a new combination of old ones, with or without the addition of one or more new ones, is an original invention for which a patent may be supported, without reference to any former invention or machine, for performing the same or a similar operation. This may be taken as a maxim which the cases referred to will be found fully to support.

Let us now apply this maxim to the patent of Oliver Evans. We shall soon see that, according to the doctrine thus established, his discovery was not a mere "improvement," as the court below pronounced it to be, but an original invention.

The learned counsel here produced two models, one of Evans's hopper-boy and one of Stauffer's, and explained minutely the difference between their principles, or *modus operandi*, which consisted in this: that in Stauffer's hopper-boy, the arms, through a square mortise in which the square upright post was made to pass, were carried round by means of the upright post pressing upon the sides of the square mortise, which renders it impossible for the arms to rise and fall of themselves, as the meal under them might increase or diminish; while in the hopper-boy of Evans, the upright post is round, and it passes loosely through a round hole in the arms, which are carried round by two pieces of timber of the proper length, called leaders, which are inserted firmly into the upper part of the post, and attached at their ends by lines, or small cords, to the corresponding ends of the arms. These lines and leaders, being put in motion by the upright post, trail round the arms, which at the same time play loosely on the post, and rise and fall of themselves, as the meal under

them increases or diminishes in quantity. And to make them press more lightly on the meal, and rise and fall with more facility, as occasion may require, a weight a little lighter than themselves is attached to them by a cord which passes over a pulley in the upper part of the post. This weight nearly balances the arms, and enables them to play up and down much more easily and effectually.

The counsel also produced a drawing of Evans's machine, from the Patent Office, to show that his model was correct, and referred to the facts of the evidence in the record, where the machine of Stauffer is described, and its properties and defects explained.

He then proceeded to remark that the machine of Evans was obviously constructed upon a new principle; that the *modus operandi* was entirely new. The great object of both machines was to conduct the meal into the bolting-chest, and to stir, turn, dry, and cool it on its way thither. The essential agents in this operation were the arms, which if they remained stationary on the post, as they must of necessity do in Stauffer's machine, could not possibly perform this operation to advantage. They might sink down on the meal, as its quantity decreased, but could not possibly rise when it was increased; consequently, when new meal was placed on the floor, the machine must be stopped, and the arms lifted up. Hence, its motion was unequal, and its operation necessarily very irregular and imperfect. It also required a hand constantly or frequently to be present, and thus increased the expense.

Thus, the condensation of the steam within the cylinder itself, in Newcomen's steam-engine, cooled the cylinder improperly, wasted steam, made more fuel necessary, and rendered the operation of the machine imperfect and too expensive. Here the similarity of imperfection is complete.

Evans removed the imperfection of the hopper-boy, not by merely adding to its parts, but by introducing a totally new principle and *modus operandi*. He detached the arms from the upright post entirely, and carried them round by means of the leaders and lines which have been described, leaving them to play freely up and down on the post, so as to accommodate themselves to the decreasing or increasing quantity of meal under them; and their movement up and down he facilitated, regulated, and rendered perfect by means of the weight and pulley. The *modus operandi* of the two machines consisted in the manner of carrying round the arms. This was the principle of both machines. That of Evans was new, and infinitely superior.

So Watt remedied the defects of Newcomen's steam-engine, by

## Argument for the plaintiff.

condensing the steam in a different vessel from the cylinder, and increased the effect by introducing the steam above the piston as well as below it. This was a new principle; and here again the resemblance between the two cases is complete.

It being, then, clear that Evans had made a new invention as to the hopper-boy, and not merely what the law on this subject calls an improvement, and the cases showing that such an invention is the subject-matter of a patent for an original invention, it follows that he might have obtained a patent for his invention as an original invention, and not merely as an improvement. This leads to the inquiry, for what was this patent granted? Was it for an original invention of his own, or for an improvement on Stauffer's invention?

We have the authority of this court, in its former decision in this case, (3 Wheat. Rep., 454, *ante*.) for saying, that when we inquire what was granted, it is proper, in the first place, to ascertain what the grantee wished to obtain, and, next, what the grantor had the intention and the power to give. What Evans wished to obtain, is fully and most explicitly stated in the concluding sentence of his specification. *Ibid.*, 468, note, *ante*. After describing most fully and clearly the structure, principle, and operation of his hopper-boy, he concludes thus: "I claim as my invention the peculiar properties which this machine possesses, namely, the spreading, turning, and gathering the meal at one operation, and the rising and lowering its arms by the motion, to accommodate itself to any quantity of meal it has to operate on." Here it is manifest that he describes the effect intended to be produced, which was the same in both machines, namely, the spreading, turning, and gathering the meal at one operation; and his *modus operandi* for producing this effect, which was entirely new, namely, the rising and lowering of the arms of the machine by its own motion, so as to accommodate itself to the increasing or diminishing quantity of meal. For this *modus operandi*, this property or principle, he claims a patent.

It is equally clear that the grantor of the patent intended to give what he thus asked for; that is, a patent for this new principle. This appears from the special act of Congress, on which the patent is founded, and to which it refers; from the terms of the patent itself; and from the specification, which is expressly incorporated into it as one of its constituent parts.

As a further illustration of this position, the most celebrated and important invention of modern times may be referred to—an invention which was destined to produce more important effects than any other single effort of the human mind. He alluded to the steam-

boat—that sublime conception, which had conferred so much glory on its author and his country. What was a steamboat but a new combination of these well-known machines, a boat, a steam-engine, and a flutter-wheel—machines most familiar to all who knew anything of such subjects. But they were so combined as to produce a new and most surprising effect, by a new *modus operandi*. This method consisted in attaching a steam-engine and two flutter-wheels to a boat of proper dimensions and strength, and arranging them in such a manner that the flutter-wheels were set in motion by the steam-engine, and struck against the water, instead of being struck by it, as they are in a common saw-mill. Thus striking against the water, they act as oars, or rather as paddles, and propel the boat forward. Now, what was there new in this machine? Not the instruments, but the manner of combining them, and their manner of operating produced by this combination; and yet no one has denied to the author of this beautiful and sublime idea the merit of an original invention, or called in question his patent, as a patent for an original invention. He, however, merely combined old machines, changing their forms and proportions so as to suit his new purpose. Evans not only combined old machines, but added new and essential parts, and by means of both produced a *modus operandi* altogether new and highly useful. Upon what ground, then, can it be said that he is not an original inventor, when Watt was solemnly adjudged and Fulton unanimously allowed to be so?

I therefore contend that Evans was an original inventor, and not an improver merely; and that his patent is for an original invention, and not for an improvement. If so, the decision of the Circuit Court in these two cases (the present case, and the subsequent case of *Evans v. Hettich*) must be reversed, and the patent of my client is established.

But if it be not a patent for an original invention, but merely for an improvement, the decision below was erroneous, in declaring that the specification is defective. This defect consists, according to the decision below, in the omission to state particularly in what the improvement consists, and to distinguish it in terms from the preëxistent machine.

Here a very familiar maxim is applicable: *quod neminem ad vana aut ad impossibilia lex cogit*. The law requires nobody to do that which would be useless if done, or it is impossible to do. And *cui bono* make this discrimination? how can it be made? and by what provision of the law is it required? On the answer to these three questions the case must depend. If it can be shown that such a dis-

## Argument for the plaintiff.

crimination would be useless if made, or is impracticable, and that it is not expressly or positively required by the act of Congress, it will follow that the judgment below must be reversed.

And (1.) *cui bono* make the discrimination? What good would it or could it do to anybody? In order to answer these questions, we must revert again to the object and uses of the specification.

The Patent Law confers a benefit on the discoverer of any artful invention, which consists in a monopoly of his invention for a limited time. The consideration which it requires him to pay for this benefit is to put the public in possession of his invention, so as to enable all to use it after this monopoly shall expire, and all to avoid involving themselves in controversies and difficulties, by inadvertently infringing it, while it continues. Hence the necessity of a specification; and here we find its uses, its extent, and its limitations. The British statute said nothing of a specification; but it was introduced by the executive government as a condition of every patent, and its character, objects, and properties have been accurately settled by judicial decisions in England. From those decisions it was borrowed by our act of Congress, and incorporated into its positive enactments. In both systems, its objects and uses, and consequently its nature and properties, are the same. Its object and all is to enable the public to enjoy the invention, beneficially and fully, after the monopoly shall have expired, and to avoid interference with it while it shall continue. Now, what is necessary for attaining this object? Certainly nothing more than this: that the invention should be so described in the specification by writing, and, where the nature of the subject will permit, by drawings and models, so that any one competently skilled in the art or science to which it relates may be enabled to understand, make, and use it. This is what the English decisions have established as the necessary properties of the specification, and what our statute expressly and in terms requires.

Now, it is obvious that, in the case of an improvement, the principle is exactly the same as in that of an original invention. The invention, that is, the thing in its improved state, must be accurately and fully described—by writing always, and by drawings and models where the nature of the case will permit. When this is done, it is manifest that any one who can understand the improved thing, so as to make and use it, may, in every possible case, distinguish the improvement from any and every original or antecedent thing of the same sort. Take these two hopper-boys as an example, and inspect the models which I hold in my hands. Cannot any man who has sufficient mechanical skill to make a hopper-boy, and under-

stand its use, see at one glance in what these two machines differ from each other? Does not the court see it? Cannot any such mechanic, therefore, make and use the hopper-boy of Stauffer, if he should think proper, and avoid all interference with the improvement of Evans? It cannot be doubted that he may. And so may a person sufficiently skilled in the art or science to which an improvement relates, in every possible case. When he has the improvement, or the improved thing sufficiently described, as the hopper-boy of Evans is admitted to be, and is informed of any preëxisting machine or thing of the same general nature which he wishes to make, sell, or use, he can look at that thing, compare it with the improved machine or with the description, drawings, and models in the Patent Office, see the difference, and make and use the original or old one, without the least danger of interfering with the improvement. Where, then, is the use of describing the original or the old invention in the specification of the improvement, and of discriminating in terms between them? It is manifest that such a description would be perfectly useless and vain, and *neminem ad vana lex cogit*.

2. But admitting that it might be of some use, would it be possible? This is the next head of inquiry; and I contend that it would not.

And here let it be remembered that this doctrine of discrimination is not confined to such inventions as are express or avowed improvements on particular inventions. It extends necessarily to all inventions which improve anything that existed before. In the present case, there happened, so far at least as is now known, to be but one hopper-boy, that of Stauffer, in use before Evans's. But suppose there had been twenty, of as many different kinds: would they not all have been original with respect to Evans's, or antecedent to it? Undoubtedly; and every man, notwithstanding Evans's patent, would have had a right to use them all, or any of them. What reason or principle could require the description of one in the specification of Evans, which would not equally apply to all? There certainly is none. Let us take the example of a patent for an improved stove, for increasing the heat, or for any other object. How many millions of stoves, of what an endless variety of constructions, are used in the world. Must the patentee of this improved stove, or of this improvement on stoves, describe them all in his specification, and point out in terms the difference between each of them and his invention? It is manifest that he must, according to the doctrine of the Circuit Court; and it is equally manifest that he could not possibly do it. His specification would constitute a library of itself, which no man



## Argument for the plaintiff.

would or could read, and which the Patent Office could hardly contain. So, also, improved chimneys, improved carriages, and all the multitude of other improvements, real or imaginary, on things in general use, for which patents are obtained, having preëxistent things of the same nature, and used for the same general purpose, must be described in each specification; which, if it were possible to write it, as it would very seldom be, would be far too voluminous to be understood or read.

Thus, it is manifest that the discrimination contended for would be impossible as well as useless, in relation to improvements on unpatented machines. Where, indeed, a machine is already patented, it is very easy to describe it in the specification of the improvement, and point out all the particulars in which they differ from each other. The original specification is in the Patent Office, and may be referred to; the drawings and models are there, and may be seen. Here the rule requiring a discrimination in terms between the original invention and the improvement would not be unreasonable, and it might be useful, by tending to prevent disputes between the different patentees. The mistake of which we complain has probably arisen from not discriminating between improvements on patented and unpatented inventions. In the latter, the discrimination is manifestly impossible as well as useless. In the former, it would be easy, and might be of some use. It might be proper to require it in one case, whether the law positively enjoins it or not. To require it in the other, would be to make the law require what is both useless and impossible. This can never be done by the construction merely of a statute, which must always be reasonable. But it may be said that the statute positively enjoins it. If so, we must submit. When the legislature has clearly expressed its will, the court have no duty but to obey. This brings us to the question, what has the legislature enjoined on this subject?

3. All that can be supposed to relate to it is contained in the second and third sections. The second speaks of improvements; the third of specifications. It points out the object of the specification, and directs what shall be done for its attainment. The object is to put the public in complete possession of the invention, whether an improvement or an original discovery, so that interference with it may be avoided while the patent continues, and its benefits may be fully enjoyed by the public after the patent expires. To this end, it enjoins that the applicant "shall deliver a written description of his invention, and of the manner of using or process of compounding the same, in such full, clear, and exact terms as to distinguish the

## Argument for the plaintiff.

same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same." This is the directory part. The thing is to be described "so as to distinguish it from all other things before known." How distinguish it? By describing all the things before known, and pointing out in terms in what it differs from them all? Certainly not; but by giving a description of it so complete and accurate as "to enable any person skilled in the art, &c., to make, compound, and use the same." Is the discrimination contended for, but not mentioned in the statute, necessary for this purpose? By no means. Any person skilled in the art or science, in order to make, compound, and use the new invention, has but to look to the description of the invention itself. He need not know how nearly it resembles or how widely it differs from any other thing before known. With these he has no concern. And if, on the other hand, he wishes to use nothing before used and known, and to avoid interfering with the patented invention or improvement, he has only to compare the thing which he so wishes to make or use with the description of the patented invention or improvement contained in the specification, and he will immediately see wherein they differ, and be enabled to avoid the latter while he uses the former.

This section (the third) further directs, with a view to the same objects, that the applicant, the inventor, "in case of any machine," shall "fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character by which it may be distinguished from other inventions." Here, as in the rest of the section, nothing is said about improvements, as distinguished from original discoveries. They are all treated equally as "inventions," and are placed precisely on the same ground. They are all to be so described as that they may be distinguished in their principles and *modus operandi*, as well as in their construction and composition, from other inventions; and this is to be effected by means not of a formal discrimination in terms between them and any other thing or things of the same general nature, but of a full and accurate verbal description, aided by drawings, models, and specimens, where the matter is of such a nature as to admit their use. In all this, nothing is said or hinted about "improvements," as contradistinguished from "original discoveries." All are treated alike as "inventions," and the same means of enabling all concerned to distinguish them from things before used or known are provided in relation to both.

## Argument for the plaintiff.

In fact, what is an "improvement" but a new invention? Every thing that is made better is improved, and every thing that makes another better, or does it in a better way, is an improvement. If it be new, it is an invention so far as it goes. The greater the improvement, the greater is the invention; and any improvement differs from any other, or from an original discovery, if there be any such thing, not in nature, but in degree. They may be greater inventions or less, more or less ingenious, or more or less useful; but as far as they are, so they are all inventions, and are treated precisely alike by this portion of the Patent Law, which, I again repeat, makes no mention and gives no hint of a discrimination in the specification of an improvement, between the improvement, or the thing as improved, and the original thing on which the improvement is made. Treating them all alike as "inventions," it requires, with respect to all, that they shall be so described as clearly to distinguish them, that is, as to enable all concerned to distinguish them, from all other things of the same nature before in use or known. To construe the statute so as to make it require a description not only of the new invention, but of all things of the same general nature before known, and a discrimination in terms between them, would be as unreasonable in the case of an improvement as of an original discovery, and would be perfectly unreasonable in either. It would make the statute do that which its terms do not indicate, and which the law can never be presumed to intend. It would make it require what it is not only impossible in a great variety of cases to do, but what, if done, would in every case be wholly useless and vain. This it cannot be so construed as to require; for *neminem ad vana aut ad impossibilia lex cogit*.

The counsel then adverted to the second section, where it was supposed, he said, that something might be found to support this doctrine of discrimination. That section spoke particularly of improvements, as to which the third was wholly silent. It said nothing whatever of the specification, its objects or motive. It made two provisions, both useful as declarations of the law, to put persons on their guard and prevent mistakes, but both undoubtedly law, without any such declaration. The first was, that the discoverer and patentee of an improvement in anything before patented should not be entitled to make, use, or vend the original; nor the inventor and patentee of the original to make, use, or vend the improvement. Here again they were both considered as inventors, and both put on the same footing. It was declared, for general information, and to prevent doubts and mistakes, that one should not be entitled to the invention of the other; but nothing was said about the manner of

## Argument for the plaintiff.

distinguishing these inventions one from the other. That was left to the third section, where it was done without the least mention or hint of the formal discrimination in terms contended for in the judgment below. It was manifest that this discrimination could derive no countenance from this branch of the second section. It obviously could derive none from the other branch, which, merely for giving information to the public and preventing mistakes, declared "that simply changing the form or proportions of any machine or composition of matter, in any degree, shall not be deemed a discovery." This merely amounts to saying, what would clearly have been the construction of the law without any such declaration, that to constitute a patentable discovery, either original or by improvement, there must be a new principle or *modus operandi*, and not merely a change of form or proportion. If the change of form or proportion should be such as to produce a new principle or *modus operandi*, then it would be a discovery or invention, whether it amounts to an original or an improvement only; and here again improvements were treated as inventions, equally with original discoveries, the distinction between them being not in nature, but merely in degree.

But the point under consideration has been expressly settled by the former decision in this case; the same objection for want of this discrimination was made in the court below, on the first trial, and the same doctrine on the subject expressly laid down by the Circuit Court. This doctrine formed one of the grounds of objection, distinctly stated in the argument of the former case in this court, and was distinctly noticed by the court; and with this part of the opinion below, and the objection to it, distinctly in view, this court decided this patent on this same specification to be valid, notwithstanding its want of a discrimination in terms between the improvement and the original invention, which was an express decision on this point in favor of the plaintiff in error. He referred to various parts of the report of the former case of *Evans v. Eaton*, (3 Wheat. Rep., 454, *ante*.) to support these positions; remarking, that although the court certainly was not bound absolutely by its own decisions, and ought to overrule them when satisfied of their incorrectness, yet they were the great landmarks of the law, and ought not to be overturned or shaken without the strongest and clearest reasons.

The learned counsel also cited the authorities cited in the margin, as to the objection to the charge of the court below, upon the ground that it had invaded the proper province of the jury, in respect to the sufficiency of the specification, and to the nature of the patentee's invention as an improvement or an original discovery. 12 H. Bl.,

478, 484, 497; 8 T. R., 99, 101, 103; 1 Gallis., 481; 1 Mason, 189, 191.

Mr. Justice STORY delivered the opinion of the court.

This is the same case which was formerly before this court, and is reported in 3 Wheat. Rep., 454, and by a reference to that report the form of the patent, the nature of the action, and the subsequent proceedings will fully appear. The cause now comes before us upon a writ of error to the judgment of the Circuit Court, rendered upon the new trial had in pursuance of the mandate of this court.

Upon the new trial, several exceptions were taken by the counsel for the plaintiff. The first was to the admission of a Mr. Frederick as a witness for the defendant. It is to be observed, that the sole controversy between the parties at the new trial was, whether the plaintiff was entitled to recover for an alleged breach of his patent by the defendant in using the improved hopper-boy. Frederick, in his examination on the *voir dire*, denied that he had any interest in the cause, or that he was bound to contribute to the expenses of it. He said he had not a hopper-boy in his mill at present, it being then in court; that it was in his mill about three weeks ago, when he gave it to a person to bring down to Philadelphia; and that his hopper-boy spreads and turns the meal, cools it some, dries it, and gathers it to the bolting-chest. Upon this evidence, the plaintiff's counsel contended that Frederick was not a competent witness, but the objection was overruled by the court. It does not appear from this examination whether the hopper-boy used by Frederick was that improved by the plaintiff or not; but, assuming it was, we are of opinion that the witness was rightly admitted. It is perfectly clear that a person having an interest only in the question, and not in the event of the suit, is a competent witness; and, in general, the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and does not exclude him. If nothing had been in controversy in this case as to the validity of the patent itself, and the general issue only had been pleaded, the present objection would have fallen within the general rule. But the special notice in this case asserts matter which, if true, and found specially by the jury, might authorize the court to adjudge the patent void, and it is supposed that this constitutes such an interest in Frederick in the event of the cause that he is thereby rendered incompetent. But, in this respect, Frederick stands in the same situation as every other person in the community. If the patent is

declared void, the invention may be used by the whole community, and all persons may be said to have an interest in making it public property. But this results from a general principle of law, that a party can take nothing by a void patent; and so far as such an interest goes, we think it is to the credit and not to the competency of the witness. It is clear that the verdict in this case, if given for Evans, would not be evidence in a suit against Frederick, but Frederick would be entitled to contest every step in the cause, in the same manner as if no such suit had existed. *Non constat* that Frederick himself will ever be sued by the plaintiff, or that, if sued, any recovery can be had against him, even if the plaintiff's patent should not be avoided in this suit. It therefore rests in remote contingencies whether Frederick will, under any circumstances, have an interest in the event of this suit, and the law adjudges the party incompetent only when he has a certain, and not a contingent, interest. It has been the inclination of courts of law, in modern times, generally, to lean against exceptions to testimony. This is a case which may be considered somewhat anomalous; and we think it safest to admit the testimony, leaving its credibility to the jury.

Another exception was to the refusal of the court to allow a deposition to be read by the plaintiff, which had been taken according to a prevalent practice of the State courts. It is not pretended that the deposition was admissible according to the positive rules of law, or the rules of the Circuit Court; and it is not now produced, so that we can see what were the circumstances under which it was taken. No practice, however convenient, can give validity to depositions which are not taken according to law, or the rules of the Circuit Court, unless the parties expressly waive the objection, or, by previous consent, agree to have them taken and made evidence. This objection, therefore, may at once be dismissed.

The principal arguments, however, at the bar, have been urged against the charge given by the Circuit Court in summing up the charge to the jury. The charge is spread *in extenso* upon the record, a practice which is unnecessary and inconvenient, and may give rise to minute criticisms and observations upon points incidentally introduced for purposes of argument or illustration, and by no means essential to the merits of the cause. In causes of this nature, we think the substance only of the charge is to be examined; and if it appears, upon the whole, that the law was justly expounded to the jury, general expressions, which may need and would receive qualification if they were the direct point in judgment, are to be understood in such restricted sense.

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Opinion of the court.

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It has been already stated that the whole controversy at the trial turned upon the use of the plaintiff's hopper-boy; and no other of the inventions included in this patent was asserted or supposed to be pirated by the defendant.

The plaintiff, with a view to the maintenance of his suit, contended that his patent, so far as respected the hopper-boy, had a double aspect: 1. That it was to be as a patent for the whole of the improved hopper-boy, that is, of the whole machine, as his own invention. 2. That if not susceptible of this construction, it was for an improvement upon the hopper-boy, and he was entitled to recover against the defendant for using his improvement. The defendant admitted that he used the improved hopper-boy, and put his defense upon two grounds: 1. That if the patent was for the whole machine, that is, the improved hopper-boy, the plaintiff was not the inventor of the improved hopper-boy so patented. 2. That if the patent was for an improvement only upon the hopper-boy, the specification did not describe the nature and extent of the improvement; and if it did, still the patent comprehended the whole machine, and was broader than the invention. To the examination of these points, and summing up the evidence, the attention of the Circuit Court was exclusively directed; and the question is, whether the charge, in respect to the matters of law involved in these points, was erroneous, to the injury of the plaintiff.

We will consider the points in the same order in which they were reviewed by the Circuit Court. Was the patent of the plaintiff, so far as respects his improved hopper-boy, a patent for the whole machine, as his own invention? It is not disputed that the specification does contain a good and sufficient description of the improved hopper-boy, and of the manner of constructing it; and if there had been any dispute on this subject, it would have been matter of fact for the jury, and not of law for the decision of the court. The plaintiff, in his specification, after describing his hopper-boy, its structure and use, sums up his invention as follows: "I claim as my invention the peculiar properties or principles which this machine possesses, in the spreading, turning, and gathering the meal at one operation, and the raising and lowering of its arms by its motion, to accommodate itself to any quantity of meal it has to operate upon." From this manner of stating his invention, without any other qualification, it is apparent that it is just such a claim as would be made use of by the plaintiff, if the whole machine was substantially, in its structure and combinations, new. The plaintiff does not state it to be a specific improvement upon an existing machine, confining his claim

to that improvement, but as an invention substantially original. In short, he claims the machine as substantially new in its properties and principles, that is to say, in the *modus operandi*. If this be true, and this has been the construction strongly and earnestly pressed upon this court by the plaintiff's counsel, in the argument at the present term, what are the legal principles that flow from this doctrine? The Patent Act of the 21st of February, 1793, ch. 11, upon which the validity of our patents generally depends, authorizes a patent to the inventor, for his invention or improvement in any new and useful art, machine, manufacture, or composition of matter not known or used before the application. It also gives to any inventor of an improvement in the principle of any machine, or in the process of any composition of matter which has been patented, an exclusive right to a patent for his improvement; but he is not to be at liberty to use the original discovery, nor is the first inventor at liberty to use the improvement. It also declares that simply changing the form or the proportion of any machine or composition of matter, in any degree, shall not be deemed a discovery. It further provides that, on any trial for a violation of the patent, the party may give in evidence, having given due notice thereof, any special matter tending to prove that the plaintiff's specification does not contain the whole truth relative to his discovery, or contains more than is necessary to produce the effect, (where the addition or concealment shall appear to have been to deceive the public,) or that the thing secured by the patent was not originally discovered by the patentee, but had been in use, or had been described in some public work, anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a person's invention; and provides that in either of these cases judgment shall be rendered for the plaintiff, with costs, and the patent shall be declared void. It further requires that every inventor, before he can receive a patent, shall swear or affirm to the truth of his invention, "and shall deliver a written description of his invention, and of the manner of using or process of compounding the same, in such full, clear, and exact terms as to distinguish the same from all things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same; and in the case of any machine, he shall fully explain the several modes in which he has contemplated the application of the principle or character by which it may be distinguished from other inventions."

From this enumeration of the provisions of the act, it is clear that the party cannot entitle himself to a patent for more than his own



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invention; and if his patent includes things before known, or before in use, as his invention, he is not entitled to recover, for his patent is broader than his invention. If, therefore, the patent be for the whole of a machine, the party can maintain a title to it only by establishing that it is substantially new in its structure and mode of operation. If the same combinations existed before in machines of the same nature, up to a certain point, and the party's invention consists in adding some new machinery, or some improved mode of operation, to the old, the patent should be limited to such improvement; for if it includes the whole machinery, it includes more than his invention, and therefore cannot be supported. This is the view of the law on this point which was taken by the Circuit Court. That court went into a full examination of the testimony, and also of the structure of Evans's hopper-boy and Stauffer's hopper-boy, and left it to the jury to decide, whether, up to a certain point, the two machines were or were not the same in principle. If they were the same in principle, and merely differed in form and proportion, then it was declared that the plaintiff was not entitled to recover; or, to use the language of the court, if the jury were of opinion that the plaintiff was not the inventor of the hopper-boy, he was not entitled to recover, unless his was a case excepted from the general operation of the act. We perceive no reason to be dissatisfied with this part of the charge; it left the fact open for the jury, and instructed them correctly as to the law. And the verdict of the jury negatived the right of the plaintiff as the inventor of the whole machine. The next inquiry before the Circuit Court was, whether the plaintiff's case was excepted from the general operation of the act. Upon that, it is unnecessary to say more than that the point was expressly decided by this court in the negative, upon the former writ of error. And we think the opinion of this court, delivered on that occasion, is correctly understood and expounded by the Circuit Court. It could never have been intended by this court to declare, in direct opposition to the very terms of the Patent Act, that a party was entitled to recover, although he should be proved not to have been the inventor of the machine patented; or that he should be entitled to recover, notwithstanding the machine patented was in use prior to his alleged discovery. There is undoubtedly a slight error in drawing up the judgment of the court upon the former writ of error; but it is immediately corrected by an attentive perusal of the opinion itself. And we do not think that it can be better stated or explained than in the manner in which the Circuit Court has expounded it.

We are, then, led to the examination of the other point of view in

which the plaintiff's counsel have attempted to maintain this patent: that is, by considering it not as a patent for the whole of the machine or improved hopper-boy, but as an improvement of the hopper-boy. Considered under this aspect, the point presents itself which was urged by the defendant's counsel, namely, that if it be a patent for an improvement, it is void, because the nature and extent of the improvement are not stated in the specification. The Circuit Court went into an elaborate examination of the law applicable to this point, and into a construction of the terms of the patent itself, and came to the conclusion that no distinct improvement was specified in the patent; that such specification was necessary in a patent for an improvement, and that for this defect the plaintiff was not entitled to recover, supposing his patent to be for an improvement only of an existing machine. It may be justly doubted whether this point at all arises in the cause; for the very terms of the patent, as they have been already considered, and as they have been construed at the bar by the plaintiff's counsel, at the present argument, seem almost conclusively to establish that the patent is for the whole machine, that is, for the whole of the improved hopper-boy, and not for a mere improvement upon the old hopper-boy. But, waiving this point, can the doctrine asserted at the bar be maintained, that no specification of an improvement is necessary in the patent; and that it is sufficient, if it be made out and shown at the trial, or may be established by comparing the machine specified in the patent with former machines in use? That there is no specification of any distinct improvement in the present patent, is not denied; that the patent is good without it, is the subject of inquiry. Let this be decided by reference to the Patent Act.

The third section of the Patent Act requires, as has been already stated, that the party "shall deliver a written description of his invention in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in the art or science, &c., &c., to make, compound, and use the same." The specification, then, has two objects: one is to make known the manner of constructing the machine, (if the invention is of a machine,) so as to enable artisans to make and use it, and thus to give the public the benefit of the discovery after the expiration of the patent. It is not pretended that the plaintiff's patent is not in this respect sufficiently exact and minute in the description. But whether it be so or not, is not material to the present inquiry. The other object of the specification is, to put the public in possession of what the party claims as his own invention, so as to ascertain if he claim anything that

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is in common use, or is already known, and to guard against prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented. It is, therefore, for the purpose of warning an innocent purchaser, or other person using a machine, of his infringement of the patent, and at the same time of taking from the inventor the means of practicing upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is, or different from its ostensible objects, that the patentee is required to distinguish his invention in his specification. Nothing can be more direct than the very words of the act. The specification must describe the invention "in such full, clear, and distinct terms as to distinguish the same *from all other things before known.*" How can that be a sufficient specification of an improvement in a machine which does not distinguish what the improvement is, nor state in what it consists, nor how far the invention extends—which describes the machine fully and accurately as a whole, mixing up the new and old, but does not in the slightest degree explain what is the nature or limit of the improvement which the party claims as his own? It seems to us perfectly clear that such a specification is indispensable. We do not say that the party is bound to describe the old machine, but we are of opinion that he ought to describe what his own improvement is, and to limit his patent to such improvement. For another purpose, indeed, with the view of enabling artisans to construct the machine, it may become necessary for him to state so much of the old machine as will make his specification of the structure intelligible. But the law is sufficiently complied with in relation to the other point, by distinguishing, in full, clear, and exact terms, the nature and extent of his improvement only.

We do not consider that the opinion of the Circuit Court differs, in any material respect, from this exposition of the Patent Act on this point; and if the plaintiff's patent is to be considered as a patent for an improvement upon an existing hopper-boy, it is defective in not specifying that improvement, and therefore the plaintiff ought not to recover.

Upon the whole, it is the opinion of the majority of the court that the judgment of the Circuit Court ought to be

AFFIRMED WITH COSTS.

Mr. Justice LIVINGSTON dissented. At this late period, when the patentee is in his grave, and his patent has expired a natural death, we are called on to say whether his patent ever had a legal existence,

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and it may seem not very important to the representatives of the patentee what may be the decision of this court. But, understanding that many other actions are pending for a violation of this part of the patent-right, and that infractions have taken place for which actions may yet be commenced, and believing that the decision we are about to make will have a very extensive, if not a disastrous, bearing on many other patents for improvements, and will, in fact, amount to a repeal of many of them, I have thought proper to assign my reasons for dissenting from the opinion just delivered.

In doing this, my remarks will be confined principally to the charge of the court, so far as it applies to the claim of Evans for an improvement on a hopper-boy.

I was much struck with the argument of the plaintiff's counsel in favor of the patent being for an original invention, and not for an improvement; nor would it, in my opinion, be a forced construction to regard it as a patent for a combination of machines to produce certain results, and not for any of the machines, nor the different parts of which the whole is composed.

But considering it as a patent for an improvement on a hopper-boy, in which light it had been regarded as well by the Circuit as by this court, when this cause was here before, I proceeded to examine the charge, so far as it relates to this part of the subject.

The court, after stating in what particulars the plaintiff's counsel contended that his improvement consists, which is unnecessary to repeat here, proceeds:

"The plaintiff has laid before you strong evidence to prove that his hopper-boy is a more useful machine than the one which is alleged to have been previously discovered and in use. If, then, you are satisfied of this fact, the point of law which has been raised by the defendant's counsel remains to be considered, which is; that the plaintiff's patent for an improvement is *void, because the nature and extent of his improvement is not stated in the specification.*

"The patent is for an improved hopper-boy, as described in the specification, which is referred to and made part of the patent. How does the specification express in what his improvement consists? It states all and each of the parts of the entire machine, its use and mode of operating; and claims as his invention the peculiar properties or principles of the machine, namely, the spreading, turning, and gathering the meal, and the raising and lowering of its arms by its motion, to accommodate itself to the meal under it. But does this description designate the improvement, or in what it consists? Where shall we find the *original hopper-boy described*, either as to its

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construction, operation, or use, or by reference to anything by which a knowledge of it may be obtained? Where are the improvements on such originals stated? The undoubted truth is, that the specification communicates no information whatever upon any of these points." And after some farther reasoning on the subject, and showing that the plaintiff's case is not excepted from the general rule of law by the act which was passed for his relief, the court declares that for this imperfection or omission in the specification the "plaintiff is not entitled to recover for an alleged infringement of his patent for the improvement on the hopper-boy." This was equivalent to saying that for this defect in the specification the patent for the improved hopper-boy was void, and, of course, that no action at all, whatever might be the state of the evidence, could be maintained for the use of it. It left nothing, as it regarded the improved hopper-boy, for the jury to decide. Such is the charge, and it is delivered in terms too plain to be misunderstood.

The objections to it are now to be considered. In doing this, it will be shown :

1st. That the specification is not defective, and that although it does not discriminate in what particulars the machine in question does differ from other hopper-boys in use, yet if, from the whole of the description taken together, the machine is specified so minutely and so accurately as to be directly and easily distinguished from all other hopper-boys antecedently known, everything has been done which the law requires, and the patent is good.

2d. That if the specification be vicious in the points mentioned, the patent ought not to be considered as absolutely void; but it is enough, and the public interest is sufficiently guarded, if care be taken care that it shall not be extended to create a monopoly in any other machine, which may or may not be mentioned in the patent, which was previously known or in use. And—

3d. That if a patent must be set aside for such defect in the specification, it should be left to the jury, on the evidence before them, to decide whether the improvement patented be not set forth with all necessary precision.

1. I have said the specification is not defective.

In determining this question, it would seem but natural and just that the validity of a patent granted under a particular act of Congress should be tested by the terms there used, and by the decisions of our own courts, so far as they are of authority, and that we should be extremely cautious in adopting the rules which have been introduced into other countries, and under laws not in every respect like

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our own, however respectable the tribunals may be which may have prescribed those rules; and this the more especially as most of the decisions in England, which are generally cited, and seem to have been implicitly followed in this country, are of a date long subsequent to the revolution, and many of them posterior to the passage of the Patent Laws in this country, and which could not therefore have been in the contemplation of Congress at the time. Besides, there is somewhat of hardship in constantly applying to a patentee in this country adjudications made on a British act of Parliament very unlike our own, and with which decisions he has no means of becoming acquainted until long after a knowledge of them can be of any service. Already have we extended to patents for improvements on old machines several recent decisions in England, although it was long doubted in that country, and as late as the year 1776, whether by the act of the 21 James I, ch. 3, there could be a patent for an addition only. When the English courts decided in favor of such patents, they also made rules for their construction as cases arose, there being no direct provisions in the statute on the subject. As we have provided by law, not only for the security of inventions entirely new, but also for the protection of those who may discover any new and useful improvement on any art, machine, &c., not known or used before, and have prescribed the terms on which patents under it may be obtained, it would seem, if all those terms are complied with, and the invention be really new and useful, that no court can have a right to add any other terms, or to require of a patentee anything more than what the law has enjoined on him. Let us now try the patent before us by this rule. The act of the 21st February, 1793, ch. 11, after stating in what cases letters patent for inventions may issue, and how they are to be obtained, requires, *inter alia*, that the inventor, before he receives his patent, shall take a certain oath, and shall deliver a written description of his invention, and of the manner of using the same, in such full, clear, and exact terms as to *distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make and use the same.* And in the case of a machine, he shall fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character by which it may be distinguished from other inventions; and he is to accompany the whole with drawings and written references, where the nature of the case admits of it, and a model of his machine, if required by the Secretary of State, is also to be delivered.

In the present case, the patent is for an improved hopper-boy,

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a particular description of which, and its uses, will be found in 3 Wheat. Rep., 466. It is not pretended that this machine, if made in conformity with the description given by Mr. Evans, could not, in fact, be distinguished from everything else before known, when brought into comparison with it, nor that a skillful person, from its description, would not be able to make one like it; which would seem to satisfy every requisition of the law. But the defendant's counsel say this is not enough. It should, not only in its organization and aggregate be different from everything else, but every respect in which it differs in its construction or operation from other machines should be minutely stated in the specification; or, in other words, that other machines heretofore used for similar purposes should be either described or referred to therein, and the differences between the patented machines and those in former use be carefully designated.

The answer to this is, that the law does not require it—that it is impracticable, and would be of no use.

We have seen already that the law prescribes no precise form of specification, which would have been impracticable, and imposes no obligation to describe, in any particular mode, the machine in question. Not a word is said as to showing in what particulars the improvement patented differs from all other machines for the same purpose then in use. If, on the whole description taken together, the machine of the plaintiff can be distinguished from other machines, when compared with his, the words and the object of the law are satisfied. The law appears to have nothing else in view, in requiring a specification, than the instruction of the public; that is, to guard them against a violation of the patented improvement, and to enable them, when the letters patent expire, from the specification filed, to make a machine similar to the one which had been patented. The only inquiry, therefore, ought to be, whether this obvious intention of the legislature has been answered by the particular specification which may be the subject of litigation; and if enough appears, either to prevent a person from encroaching on the right of the patentee, or to enable a skillful person to make a machine which shall not only resemble the one patented, but produce the like effect, more ought not to be required. Whether these ends be attained by a particular description of every part of the improved machine, or by describing in what respect it differs from other machines, can make no difference. The information to the public is as valuable and intelligible, if not more so, in the former case than in the latter. If it be, taken altogether, an improved machine, for the purpose of

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producing certain results, and so described that it may be distinguished from other machines, and that others may be made on the same model, it is a literal compliance with all that the law requires. If the different parts of the machine, and their combination or connection, be accurately described or intelligibly set forth, why should it not be supported, although no reference be made to other machines dissimilar in their construction, and which, although applied for the same purpose, are inferior in the beneficial results produced by them? To the objection, that it does not precisely appear in what the patent hopper-boy differs from those antecedently in use, the answer is, and it ought to be conclusive, that the patentee does not mean to abridge or restrain the public from using those or any other machines, so that they differ from the one described by him; and that any mechanic, on having his specification before him, can avoid an interference with his invention. To confine our examination to the only hopper-boy which was produced on this trial, and which was called Stauffer's hopper-boy, and of which a model has been exhibited to the court, together with a model of Evans's improved hopper-boy, can a doubt be entertained for an instant that they are very dissimilar, and that any mechanic would not, in a moment, point out the distinctions between them, either from the specification or the model—or that he would not be able to make a Stauffer hopper-boy, or the improved hopper-boy of Evans, as he might be directed; and in like manner he would be able, when brought together, to discriminate between any other hopper-boy and that of Evans, provided they were different, so that those who were desirous of having a hopper-boy, on an old construction, and of not interfering with the rights of Mr. Evans, would labor under no difficulty whatever? But inasmuch as Evans himself has not discriminated or exhibited in his specification all the points of difference between his and other hopper-boys, it is supposed that his patent is for some hopper-boy already in use, as well as for his improvement thereon. The very terms of his specification precluded every supposition of that kind. If there were a thousand of those machines, on different constructions, in use before the date of his patent, he leaves to the public the undisturbed enjoyment of them. He meddles not, nor does he pretend to interfere with any of them, until they make or use one constructed, in all its parts, upon his model. That form, and that form alone, he claims as his invention or improvement. It would not have been difficult, even from British authorities, to show that this specification was sufficient; but I prefer recurring to our own law as the only proper criterion of the validity or invalidity of



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the specification in question. My opinion is, that it has all the certainty which is required by law.

Such a specification as is required by the Circuit Court, is not only not prescribed by law, but, to me, it appears to be one extremely difficult, if not impracticable.

If the inventor of an improved hopper-boy is to discriminate, in his specification, between his improvements and any particular hopper-boy which may be produced on the trial, and is to be nonsuited for not having done so, however correct and distinguishing it may be in every other respect, he must do the like as to all other hopper-boys; and if he must describe any, he must describe all others with which he may be acquainted; and, after all, some one may be introduced at the trial, of which he had never heard, or which he had never seen, and inasmuch as he had not stated in what respects it was improved by his machine, although this would immediately be seen on inspection, he must not only fail of recovering damages for a manifest violation of his right, but must have his patent declared void by the court, without a trial by jury, and be deprived of the fruits of a most valuable improvement, not because he was not the *bona fide* inventor—not because he had not described his improvement with sufficient certainty, according to the act of Congress—but because something more was required of him, of which he had no means of information. The only hopper-boy which made its appearance on this trial, except the plaintiff's, was that known by the name of the Stauffer hopper-boy; but *non constat* that there may not have been a hundred different kinds in use, and some entirely unknown to the plaintiff. If he could have described them all, which would not have been an easy task, and stated in what particulars his hopper-boy differed from them all, his specification would have extended to an immoderate length, and, after all, have been less intelligible and satisfactory than a full description, such as is given here, of all the parts of which his consisted, and of the manner in which they are put together. There may be cases in which an improvement may be so simple as to describe it at once by reference to the thing or machine improved, as in the case of an improvement of this kind on a common watch. But even in the case of a watch, if the improvement pervades the whole machine, it would be a compliance with the terms of the law, if the patentee described every part of his improved watch, with its principle, without discriminating particularly in what respect his different wheels, &c., varied from all other watches then in use. Many patents have been obtained for improvements on stoves, locks, &c.; but has it ever been required of the pat-

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entee, in such cases, not only to describe in what manner his stove or lock is constructed, and the benefits resulting from such construction, but to point out every particular in which they differ from those already in use? This, to say the least, would be a work of great labor, and of little or no use to the public, who would be at liberty to use a stove or lock of any construction not interfering with the one described in the specification of the patentee.

A few observations will show that such a description as the defendant's counsel contend for would be of no greater use than the one which Mr. Evans has adopted. After all the pains to discriminate had been taken, the question would still recur, how is the improved hopper-boy to be constructed? And if, from the specification, that could not be ascertained, then, and then only, ought it to be pronounced defective. But if, from the description, the improved hopper-boy could be made by a skillful mechanic, then the public is informed, not only of what has been patented, but of what still remains common as before, and if an action be brought for a violation of the patented right, and it should appear that the hopper-boy used is not of such construction, the plaintiff must fail in his suit. It cannot be said, with any justice, that if the discrimination be not made, the patent includes not only the improvement, but the old machine on which the improvement is ingrafted. The old machine still remains public property; may be used by every one; nor can any person be considered as infringing on the patent-right until he adds to the machine already in use the improvements of the patentee, or, in other words, until he makes a machine resembling, in all its parts, the one which is described in the specification.

2. But if the specification be defective in the points which have been mentioned, is the patent therefore necessarily void? This is a question of vital importance to every patentee.

I am aware that it has been said in England that the patent must not be more extensive than the invention; therefore, if the invention consists in an improvement only, and the patent is for the whole machine, it is void. But I am not aware that it has ever been decided there, that when a patent is for an "improved machine," and is taken out *only* for the machine *thus* improved, and not for the machine as before used, that such patent is void. But whatever may have been some of the late decisions in that country, I prefer, and think it the better course, to consider this question also under our own act, which, in this respect, is different from the English statute, and will therefore afford us more light and be a safer guide than either that statute or the judgment on it. In what part, then, of our act, may it be asked,

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is an authority given to the Federal courts to declare a patent void for a defective specification, however innocently made, and which in its consequences can injure no one? I state the question in this way, not because I think it necessary to show that if injurious consequences might flow from an imperfect specification, a patent must necessarily be declared void, but because I think it must be admitted that there is no evidence whatever in this cause to induce any one to believe that Mr. Evans either intended to take or that he did receive a patent for anything beyond his invention, which was the hopper-boy in the improved condition in which he describes it. To declare a patent for a highly-useful improvement absolutely void, merely for a defective specification, if this be one, is a very high penalty, and should not be lightly inflicted, unless rendered absolutely necessary by law; the more especially as, without recurring to so harsh a measure, a court and jury will always be able to confine a remedy on the patent to violations of the improvement actually secured, and if the patentee should be so foolish or ill-advised as to attempt to bring within its reach the machine in its unimproved state, or any other machine before common, he would do it, not only with no prospect of success, but with the certainty of a defeat, attended with a very heavy expense. As long, therefore, as he could maintain no action but for his improvement, it is not perceived why he should be visited with so heavy a denunciation as the forfeiture of his improvement, merely because, by some construction of his specification, which might after all be a mistaken one, he had included in his invention some thing of ever so trifling a nature which was already known. But if such be the law, and such the frail tenure on which these rights are held, however hard it may apply in particular cases, it must have its course. But I cannot think it our duty, or that we have any right, to pronounce a patent void on this account; but that this important office is exclusively confided to a jury. Whether we have this right or not, will now be examined. If such summary authority were intended to have been conferred on the Federal courts, the Patent Law ought to have been, and would have been, explicit. This is so far from being the case, that in the Patent Law, a provision, but of a different kind, is inserted on this very subject, which is not the case in the statute of James. It was foreseen that it must sometimes happen, either from the imperfection of language or the ignorance of a patentee, that defective specifications would be made; it was also foreseen that an imperfect specification might be made from design, and with a view of deceiving the public. We accordingly find it provided, by law, that among other matters which the defendant may rely on in an action for infringing a patent-right,

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is, "that the specification filed does not contain the *whole* truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition must *fully* appear to have been made for the purpose of *deceiving* the public." If judgment is rendered for the defendant on this ground, the patent is to be declared void. This section applies as well to patents for an improvement on an existing machine as for an invention entirely new, and was intended to protect the patent in either case against an avoidance for an imperfect and innocent specification of the invention patented. If, therefore, the defect which is alleged really exist in the specification of the patented improvement, the court is not authorized, on its mere inspection, to declare it imperfect, and the patent on that account void. Both questions are clearly questions of fact, and are so treated by the legislature. The party has a right to insist with the jury, not only that his specification is perfect, but that, if it be otherwise, no deception was intended on the public; and on either ground they may find a verdict in his favor. So if, on the allegation that the thing secured by patent was not originally discovered by the patentee, a verdict passes against the plaintiff, he loses his patent. In like manner, in this case, if it had appeared that the "improved hopper-boy," which was the thing secured by patent, had not been originally discovered by Mr. Evans, and a verdict had passed against him on that ground, there would have been an end of his patent. From the tenth section, also, an argument may be drawn against the right of a court to declare a patent void, on mere inspection, for redundancy or deficiency in a specification. This section provides a mode of proceeding before the District Court, where there may be reason to believe a patent was obtained surreptitiously, or upon false suggestions; and if, on such proceeding, it shall appear that the patentee was not the *true inventor*, judgment shall be rendered by such court for a repeal of the patent. This is the only case in which a power is conferred on a court to vacate a patent without the intervention of a jury. If a proceeding of this kind had been instituted before the proper tribunal against Mr. Evans, the court would have examined witnesses, and have formed its opinion on their testimony; and it is not clear that even in this case a jury might not have been called in. This section has been taken notice of, to show that it could never have been the intention of the legislature that a patent should be avoided, on any account whatever, on the opinion of the court alone, without some examination other than that of the specification, whatever might be its excess or poverty of description. If it had been intended to vest so important a power in the court, it.

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Syllabus.

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would not have been left to mere implication, but would have been conferred in terms admitting of no doubt. My opinion, therefore, on this part of the charge is, that the court erred in taking upon itself to pronounce the patent void, even if the specification had been defective or imperfect in not particularly describing what the improvements of the patentee were, this being a power expressly delegated to a jury, who, under all the circumstances of the case, are to decide both questions of fact; that is, whether the specification be deficient or superfluous, and the *intention* with which it was made so. I repeat once more, that whatever may have been the decisions in England, which are not admitted to be contrary to the view which has here been taken of the subject, they are not of authority, and are upon an act so very different in its structure from our own as to afford little or no useful information upon the subject. One great and important difference in the two laws is, that the statute of James I. has not prescribed a mode in which a patent for a vicious specification is to be set aside. The patent is granted on condition that a specification be enrolled.

I give no opinion on the questions which arise from the admission of certain witnesses who were supposed to be disqualified on the score of being interested; for if the patent for the hopper-boy be void for a defect in its specification, and that question is not to be referred to the jury, and such I understand to be the opinion of four of the judges, it is very unimportant whether any error was committed in this respect by the court before which the cause was tried, as a verdict must ever be rendered against the representatives of the patentee on this ground, whatever may be the state of the evidence.

Mr. Justice JOHNSON and Mr. Justice DUVALL also dissented.

JUDGMENT AFFIRMED WITH COSTS.

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EVANS v. HETTICH.

(7 Wheaton, 453.)

1. It is no objection to the competency of a witness in a patent cause that he is sued in another action for an infringement of the same patent.
2. The sixth section of the Patent Act of 1793, ch. 156, which requires a notice of the special matter to be given in evidence by the defendant under the general issue, does not include all the matters of defense which the defendant may be legally entitled to make. And where the witness was asked whether the machine used by the defendant was like the model exhibited in court of the plaintiff's patented machine: *Held*, That no notice was necessary to authorize the inquiry.

3. Where a deposition has once been read in evidence without opposition, it cannot be afterwards objected to as being irregularly taken.
4. It is no objection to the competency or credibility of a witness, that he is subject to fits of derangement, if he is sane at the time of giving his testimony.

### ERROR to the Circuit Court of Pennsylvania.

This was an action for the infringement of the same patent as in the preceding case of *Evans v. Eaton*, and was argued by the same counsel. The points involved will be found to be fully discussed in the argument of that case, to which the learned reader is referred. The following is the charge delivered to the jury in the court below, which it is thought necessary here to insert.

After stating the evidence on both sides, Mr. Justice WASHINGTON proceeded as follows:

The facts intended to be proved by the evidence given in this cause may be arranged under the following heads: (1.) Such as respect the value of the plaintiff's hopper-boy. (2.) The time of its discovery. (3.) The kind of machine used by the defendant. (4.) The time of its discovery and use.

1st. As to the first, the court has no observations to make, except that if you should find a verdict for the plaintiff, you will give the actual damages which the plaintiff has sustained by reason of the defendant's use of his invention, which the court will treble.

2d. The evidence applicable to this head, if believed by the jury, proves that, in 1783, Oliver Evans commenced his investigation of the subject of an improvement in the manufacture of flour; and in the summer of the same year he declared that he had accomplished it. In 1784, he made a model of his hopper-boy, which had no cords, weight, or pulley; and consequently the lower arm was, for the sake of the experiment, turned by the hand. In 1785, it was in operation in a mill, in as perfect a state as it now is.

3d. If the witness who was called to prove the kind of machine used by the defendant is believed by the jury, it consists of an upright square shaft, with a cog that turns it, and which is moved by the water-power of the mill. This shaft is inserted into a square mortise, in an arm or board somewhat resembling an S, with strips of wood fixed on its under side, and so arranged as to turn the meal below it, cool, dry, and conduct it to the bolting-chest. This arm slips, with ease, up and down the shaft, and must be raised by hand, and kept suspended until the meal is put under it. It has no upper arm, pulley, weight, or leading lines; and the strips below the arm are like the rake, as it is called, in the plaintiff's hopper-boy. This

## Statement of the case.

machine has acquired the name of the S, or the Stauffer hopper-boy.

4th. The witnesses examined to prove the originality and use of the defendant's hopper-boy, if believed by the jury, date it as early as about the year 1765; and its erection and actual use in mills, in 1775 and 1778; and progressively to later periods. Objections have been made, on both sides, to the credit of some of the witnesses who have been examined, not on the ground of want of veracity or of character, but of interest, short of that which can affect their competency. These objections have been pressed so far beyond their just limits as to require from the court an explanation of their real value. Where the evidence of witnesses opposed by other witnesses is relied upon, by either side, to prove a particular fact, the jury must necessarily weigh their credit, in order to satisfy their own minds on which side the truth is most likely to be; and, in making this inquiry, every circumstance which can affect the veracity of the witnesses, whether it concerns their moral character, or whether it arises from some interest which they may have in the question, or from feelings favorable to one or the other of the parties, should be taken into the calculation. But if the fact in controversy may exist without a violation of probability, and the proof is by witnesses exclusively on that side, there is nothing to put into the opposite scale against which to weigh the credit of those witnesses; and if the objection to their credit be worth anything, it must be to the full extent of rejecting their testimony altogether, or else it is worth nothing. The jury cannot compromise the matter, or halt between two opinions,—they must decide that the fact is so, or is not so; and if the latter be cause of objection to the credit of the witnesses, it would amount to the confounding of the questions of competency and credibility; for the effect would be the same, whether the court refused to permit the witnesses to testify on the ground of incompetency, or the jury should reject their testimony, when given, on that of want of credibility. I have thought it proper to submit these general observations to the consideration of the jury.

We come now to the question of law which arises out of these facts, which is: What are *the things* in which the plaintiff alleges, and has proved, he has an exclusive property, which he asserts the defendant has used, and which the defendant denies?

The first claim is for an improved hopper-boy, which the plaintiff insists is granted by his patent, which has received the sanction of the Supreme Court, and which the defendant acknowledges. This being, then, conceded ground, the court will proceed to examine it;

and the inquiry will be, whether the plaintiff is entitled to a verdict for an infringement of his patent for his improved hopper-boy. The objection relied upon by the defendant is, that the plaintiff has not set forth in his specification what are the improvements of which he claims to be the inventor so that a person skilled in the art might comprehend distinctly in what they consist. This objection, in point of fact, is fully supported. Neither the specification nor any other document connected with the patent states, or even alludes to, any specific improvement in the hopper-boy. Taking this as true, how stands the law? The third section of the Patent Law declares that "before an inventor can receive a patent he shall deliver a written description of his *invention*, in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable a person skilled in the art, &c., of which it is a branch, &c., to make and use the same."

What, then, is the plaintiff's invention, as asserted by his counsel, conceded by the defendant, and sanctioned by the Supreme Court in the case of *Evans v. Eaton*? The answer is, an improvement of the hopper-boy, or an improved hopper-boy, which that court has decided to be substantially the same. If this be so, then the above section of the law has declared that he must specify this improvement in full, clear, and exact terms. If he has not done so, he has no valid patent on which he can recover.

The English decisions correspond with the injunctions of our law. *Boulton v. Bull*, *Bovill v. Moore*, *M'Farlane v. Price*, *Harmer v. Playne*. See 3 Wheat. Rep., App. 21, *ante*. The American decisions, so far as we have any reports of them, maintain the same doctrine. Mr. Justice STORY, in the case of *Lowell v. Lewis*, lays it down "that if the patent be for an *improvement* in an existing machine, the patentee must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new; for if both are mixed together, and a patent taken for the whole, it is void." What is the reason for all this?

In the first place, it is to enable the public to enjoy the full benefit of the discovery, when the patentee's monopoly is expired, by having it so described on record that any person skilled in the art of which the invention is a branch may be able to construct it. The next reason is, to put every citizen upon his guard, that he may not, through ignorance, violate the law by infringing the rights of the patentee, and subjecting himself to the consequences of litigation. The inventor of the original machine, if he has obtained a patent for it, and all persons claiming under him, may lawfully enjoy all the



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benefits of that discovery, notwithstanding the improvement made upon it by a subsequent discoverer. If he has not chosen to ask for a monopoly, but abandoned it to the public, then it becomes public property, and any person has a right to use it. The inventor of an improvement may also obtain a patent for his discovery, which cannot legally be invaded by the inventor of the original machine or by any other person. These rights of each are secured by law, and there is no incompatibility between them. But if a man, wishing to use the original discovery, and honestly disposed to avoid an infraction of the improver's right, is unable to discover, from any certain and known standard, where the original invention ends and the improvement commences, how is it possible for him to exercise his own acknowledged right, freed from the danger of invading that of another? And to what acts of oppression might not this lead? Might not the patentee of this mysterious improvement obtain from the ignorant, the timid, and even the prudent members of society, who wish to use only the original discovery, the price he chooses to ask for a license to use his improvement, and in this way compel them to purchase it, rather than incur expenses and inconveniences far greater than the sum demanded? If this may happen, then the improver enjoys, in a degree, the benefit of a discoverer, both of the original machine and also of the improvement. In short, the patentee of the improvement may, to a certain extent, keep men at arm's length as to the use of the original invention, or make them pay for it, in derogation of the rights of the inventor of the original machine. If the law, as applicable to cases in general, be rightly laid down, the next inquiry is, is the present an excepted case? The plaintiff's counsel have not directly asserted it to be so; but they have referred, with some emphasis, to what is said by the Supreme Court in the case of *Evans v. Eaton*. 3 Wheat. Rep., 518, *ante*. The expressions are, "In all cases where the plaintiff's claim is for an improvement on a machine, it will be incumbent on him to show the extent of his improvement, so that a person understanding the subject may comprehend distinctly in what it consists."

This decision does not state in what way the extent of the plaintiff's improvement is to be proved; nor did the case require that the Supreme Court should be more explicit. The obvious conclusion is that the court left that matter undecided, and meant that the extent of the plaintiff's improvement should be shown according to rules of law. A contrary construction would be most unfair and unwarranted.

Is it possible to believe that if the Supreme Court intended to

decide contrary to the provisions of the third section of the Patent Law, and of the English and American decisions, that this was a case without the influence of that law and those decisions, that such intention would have been expressed in such general terms? This cannot be admitted; neither can the private act for the relief of Oliver Evans warrant the argument that this case is freed from the restrictions contained in the third section of the Patent Law, because, except as to the extent of the grant, it refers to, and the Supreme Court in the before-mentioned case considers it as within, the provisions of that law.

Is it likely that the Supreme Court could have meant that the plaintiff might cure the defects of his specification by *proving to the jury* in what his improvement consisted? If so, then, as to the present defendant, such an explanation would be unavailing to save him from the consequences of an error against which the sagacity of man could not have guarded him. He has sinned already, if he has invaded the plaintiff's right, and it is too late to convince him of his error, if he must be a victim of it for the want of that light which is now shed upon the act long after his supposed transgression. But of what avail would that explanation be after the expiration of the plaintiff's monopoly? The parol evidence given in a court of justice being seldom recollected with accuracy, it affords the most unsafe notice of facts, particularly when they respect matters of art, that can well be supposed. What man, who wishes not to invade the plaintiff's patent, would venture to erect a hopper-boy merely upon the information which he could gather from this trial? He could obtain none upon which he could safely rely; nor could any artist, after the expiration of the plaintiff's right, be enabled from such a source to know how to construct the improved hopper-boy. But even if the extent of the improvement could be proved in this way, the plaintiff has not attempted to prove it, and, what is more, his counsel, though repeatedly called upon to point it out, have not been able to do it.

Can the jury, without evidence, and without the aid of the plaintiff or his counsel, say in what those improvements consist? If they had never seen another hopper-boy, supposed to be the original, this would be impossible. If, having seen the Stauffer hopper-boy, they can do by so comparing with it the plaintiff's improved hopper-boy, then the consequence seems almost to be inevitable that the Stauffer hopper-boy is the original one—the point which, under the next head, is denied by the plaintiff. But if the specification had stated in what the plaintiff's improvement consisted, still he is not entitled

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to a verdict for a violation of his patent, unless he has proved, to your satisfaction, that the defendant has infringed it.

Upon the whole, then, this patent, so far as it is for an improvement, cannot be supported; and, as to any claim founded on this right, the plaintiff is not entitled to your verdict.

2. The plaintiff contends that he is the original inventor, not only of the improved hopper-boy, but of the whole machine; that his patent grants him the exclusive right for both; and that this claim has received the sanction of the Supreme Court. Whether, in point of fact, he is the original inventor of the hopper-boy, will be attended to hereafter. Neither shall I stop to inquire whether the plaintiff's patent grants him the right, because, if the Supreme Court has sanctioned the claim, that is law to this court. The part of the decision of that court relied upon by the plaintiff's counsel is found in 3 Wheat. Rep., 517, where the Chief Justice says: "The opinion of the court, then, is, that Oliver Evans may claim under his patent the exclusive use of his inventions and improvements in the art of manufacturing flour and meal, and in the several machines which he has invented, and in his improvements on machines previously discovered."

It would seem almost impossible to misunderstand this positive declaration of the court. It appears to be the result of the previous reasoning. It states that the plaintiff may claim: (1.) The exclusive use of improvements and inventions in the art of manufacturing flour. (2.) In the *several machines* which he has invented. (3.) In his *improvements* on machines previously discovered. As to the first, there is no dispute in the cause. The third has been already disposed of, and the second will now be examined. It is contended, by the defendant's counsel, that this is not the correct construction of the above sentence of the court, because it is inconsistent with the pretensions of the plaintiff's counsel, and with the argument of the Chief Justice, throughout the opinion, which led to the above conclusion. This supposed inconsistency may, in the opinion of this court, be explained by the following observations:

The exceptions taken to the charge of this court, in the case of *Evans v. Eaton*, were, first, that Oliver Evans's patent was only for the combined effect of all the machines mentioned in his patent, and, second, in directing the jury to find for the defendant, if they should be of opinion that the hopper-boy was in use prior to the improvement alleged to be made by Oliver Evans. These were the only questions presented to the view of the Supreme Court, upon which it was deemed proper by that court to give an opinion.

The reasoning of the Chief Justice, therefore, is intended to prove and correct these errors in the charge, by showing that Oliver Evans was entitled, by his patent and the accompanying documents, not only to the general combination of the different machines, but to an *improvement* on the hopper-boy, one of the machines used in combination. If he had a right to an improvement on the hopper-boy, then this court was clearly wrong in directing the jury to find a verdict for the defendant, if they should be of opinion that the hopper-boy was in use prior to the plaintiff's improvement, because it was unimportant who was the original discoverer of the hopper-boy, provided the plaintiff had a patent for an improved hopper-boy, and the defendant used that improvement, and the charge precluded that inquiry. But whilst the Chief Justice aims to prove that Oliver Evans was entitled to this double claim, he does not exclude any other claim. There is an expression relied upon, by the defendant's counsel, as having this appearance; but it is more likely that the word relied on is a typographical error, than that the court should both deny and affirm the plaintiff's right as an original inventor of the hopper-boy. When the court came to state definitely what were the plaintiff's claims under this patent, the whole are distinctly stated. The act for the relief of Oliver Evans authorizes a grant to him of his improvement in the art of manufacturing flour, and in the several machines which he has invented, and in his improvement, &c. The court says that "the application is for a patent coëxtensive with the act," &c. 3 Wheat. Rep., 508, *ante*.

If, then, in this enumeration of the plaintiff's rights under the patent, those to the machines had been omitted, it might have been supposed that it was not recognized by that court, and it is, consequently, introduced in order to prevent a conclusion against its validity, although it had not been brought into view in the previous argument, because a matter not in dispute. This course of reasoning is, we think, strongly fortified by what the court says, page 518, "In all cases where his claim is for an *improvement*," &c. Now, if his claim was confined to an improvement produced by the combined operation of all the machines, and if an improvement in the separate machines, why should the court have stated hypothetically that which was to be proved in case the plaintiff claims for an improvement? The sentence following immediately that which was relied on by the defendant's counsel seems to explain it, and to fortify the construction which we have given to it. Upon the whole, we are of opinion that the question who is the original inventor of the hopper-boy is left open by the Supreme Court, and is now to be decided by the jury. If,

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then, the jury should be of opinion, upon the evidence, that the hopper-boy which the defendant uses was invented and was in use prior to the discovery of Oliver Evans, then your verdict ought to be for the defendant. But to this construction there are objections made which it is proper to notice.

1. It is contended that the *judgment* of the Supreme Court in *Evans v. Eaton*, (3 Wheat. Rep., 519, *ante*.) where it is said that there is error in the proceedings below, in this, that in the charge the opinion is expressed "that Oliver Evans was not entitled to recover if the hopper-boy in his declaration mentioned had been in use previous to his alleged discovery," entitles the plaintiff to a verdict, although the jury should be of opinion that he is not the original inventor of the hopper-boy. That the court did not mean this, is most obvious, from what is said on page 517, that Oliver Evans may claim the exclusive use in the several machines *which he has invented*. Could the Supreme Court intend to say, immediately after, that he is entitled to a verdict for a machine which he has not invented? Can it be supposed that the court meant to ride over the third section of the Patent Law, and set up a different rule to govern this case, without having stated the reasons for so extraordinary a distinction? This is altogether inadmissible. It is also worthy of remark, that the words "in his declaration mentioned," in the judgment of the Supreme Court, are not in the charge of the Circuit Court, as stated by the Chief Justice; and it is the insertion of those words in the judgment which produces all the difficulty. Leave them out, and then the judgment is consistent with the whole reasoning of the Chief Justice, which condemned the charge of the Circuit Court, because it precluded Oliver Evans from obtaining a verdict for his *improvement*, if he was not the original inventor of the elementary parts of this machine. Retain them, and it follows that if Oliver Evans was proved not to be the inventor of the hopper-boy in his declaration mentioned, still the defendant was not entitled to a verdict. This would be in such direct opposition to the sixth section of the Patent Law, that we cannot suppose this was the meaning of the Supreme Court.

2. The next objection to the construction is, that the act of the Legislature of Pennsylvania, of 1787, conveyed to Oliver Evans the original hopper-boy, and, consequently, the existence and use of the Stauffer hopper-boy, at a period prior to the plaintiff's discovery, cannot now be urged to invalidate his patent. It is by no means to be admitted that the act operates to make such a transfer. But if it did, still the plaintiff cannot recover, if he appears not to be the first

or original discoverer of the hopper-boy. His claim is not derivative either from the State or from an individual. His suit is founded on his patent, and unless he was himself the original inventor of the hopper-boy, he cannot recover.

3. Another objection stated by the plaintiff's counsel is, that the Stauffer hopper-boy, although the jury should believe it was in use in many mills before the plaintiff's discovery, had fallen into disuse, and therefore cannot be urged to invalidate the plaintiff's right of recovery. The answer to this is, that, whether it fell into disuse or not, if it was used before the plaintiff's discovery, the plaintiff could not obtain a patent for it, so as to exclude the defendant from using it, if he chose to do so.

4. The last objection is, that the use of the Stauffer machine cannot affect the plaintiff's patent, unless it was public. Whether that hopper-boy was in public use or not, the jury will judge from the evidence. It was erected and used in four or five mills, if the defendant's witnesses are believed. But this argument has no foundation in the act of Congress, which does not speak of public use. It is material whether the patentee had notice of the prior invention or not. If it was in actual use, in any part of the world, however unlikely or impossible that the fact could come to the knowledge of the patentee, his patent for the same machine cannot be supported.

A verdict was rendered for the defendant, and, exceptions being taken to the above charge, the cause was brought by a writ of error before this court.

Mr. Justice STORY delivered the opinion of the court.

This case is an action for an infringement of the same patent as in *Evans v. Eaton*, (*ante*.) and many of the remarks in that case are applicable to this; and therefore the opinion now delivered will refer to such points only as are not completely disposed of by the opinion already delivered. The evidence in this case does not establish that the defendant used the plaintiff's improved hopper-boy; but the hopper-boy used by the defendant is asserted to be Stauffer's hopper-boy. At the new trial, a Mr. Aby was offered as a witness by the defendant, to prove the nature and character of the hopper-boy used by the defendant. The plaintiff objected to his testimony as incompetent, because he was sued by the plaintiff for an infringement of his patent-right, under circumstances similar to those alleged in proof against the defendant. The court overruled the objection, and the witness was then sworn on the *voir dire* as to his interest in the suit;

## Opinion of the court.

but, upon a full examination, it did not appear that he was really interested, and the court therefore permitted him to be sworn in chief. The plaintiff took an exception to this decision of the court. The objection to the competency of Aby, so far as he has an interest from being sued, cannot be distinguished, in principle, from that already overruled in the case of *Evans v. Eaton*. There is this additional circumstance in this case, that Aby was not called as a general witness, but to establish a single fact, namely, the nature of the hopper-boy used by the defendant. The other objection, upon his answers on the *voir dire*, is disposed of by the single remark that he purged himself of any real interest in the event of the suit. A question was asked of this witness, on his examination in chief, whether the hopper-boy in the defendant's mill was like the model exhibited in court of the plaintiff's patented hopper-boy. The plaintiff objected to the question, because such testimony could not be given in this case, for want of notice thereof. But the objection was overruled by the court, and, in our judgment, with perfect correctness. No notice was necessary to authorize the inquiry; and if the plaintiff meant to rely on the notice required by the sixth section of the Patent Act in certain cases, it is only necessary to say that this was not within the provision of that class of cases. The question was perfectly proper under the general issue. Similar objections were taken to other witnesses, but it is unnecessary to remark on them.

An inquiry was proposed by the plaintiff to one of the witnesses, whether one Peter Stauffer had paid the plaintiff for a license for his mill, but the court refused to allow the question to be asked; and we see no reason why it should have been allowed, for it merely referred to an act among strangers, which ought not to prejudice the defendant. A similar question was proposed to be asked of the same witness, whether the executors of Jacob Stauffer had paid the plaintiff for a license for the mill of Jacob. The court overruled the question; and, for the same reason, it was rightly overruled.

The deposition of one John Shetter was read in evidence by the defendant, without opposition, and afterwards the plaintiff moved to have the same rejected, because not taken according to the rules of the court; but the court refused to reject it, and, in our judgment, rightly, because it having been once introduced with the acquiescence and consent of the plaintiff, he could not afterwards avail himself of the objection.

The plaintiff then proposed to ask a question of a witness, whether Daniel Stauffer was subject to fits of derangement, and whether the witness had said so; but the court overruled the question. It does

## Opinion of the court.

not appear distinctly in the record that Daniel Stauffer was a witness in the cause; but if he was so, the question was properly overruled, because a person being subject to fits of derangement is no objection either to his competency or credibility, if he is sane at the time of giving his testimony.

The next objection of the plaintiff's counsel, is to the charge of the court, in summing up the cause to the jury; but the points on which that charge materially depends have been so fully discussed in the opinion just delivered in *Evans v. Eaton*, that it is unnecessary to examine them at large.

Upon the whole, it is the opinion of the majority of the court that the judgment ought to be

AFFIRMED WITH COSTS.

## EX PARTE WOOD &amp; BRUNDAGE.

(9 Wheaton, 603.)

1. Under the tenth section of the Patent Act of the 21st of February, 1793, ch. 11, upon granting a rule, by the judge of the District Court, upon the patentee, to show cause why process should not issue to repeal the patent, the patent is not repealed *de facto* by making the rule absolute; but the process to be awarded is in the nature of a *scire facias* at common law to the patentee, to show cause why the patent should not be repealed, with costs of suit; and upon the return of such process, duly served, the judge is to proceed to stay the cause, upon the pleadings filed by the parties and the issue joined thereon. If the issue be an issue of fact, the trial thereof is to be by a jury; if an issue of law, by the court, as in other cases.
2. In such a case, a record is to be made of the proceedings antecedent to the rule to show cause why process should not issue to repeal the patent, and upon which the rule is founded.

THIS cause was argued by *Mr. Haines*\* in support of the rule, and by *Mr. Emmett*† against it.

Mr. Justice STORY delivered the opinion of the court.

The district judge of the Southern District of New York, under the tenth section of the Patent Act of the 21st of February, 1793, ch. 11, granted a rule upon Charles Wood and Gilbert Brundage, at the instance and complaint of Jethro Wood, to show cause why process should not issue against them to repeal a patent granted to

\*He cited *Stearns v. Barrett*, 1 Mason's Rep., 153; 8 Mod., 28; 1 Salk., 144.

†He cited 1 U. S. Law Journal, 88; *Ex parte O'Rielly*, 1 Ves. jun., 112; *Ex parte Fox*, 1 Ves. & Beames, 67; *Jefferson's Case*, 2 Saund., 15.



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them for a certain invention in due form of law; and, upon hearing the parties, no sufficient cause being, in his judgment, shown to the contrary, he, on the 2d day of July, 1823, passed an order that the said rule be made absolute, and that the said patent be repealed, and that process issue to repeal the said patent, and for the costs of the complainant. The patentees, by their counsel, moved the court to direct a record to be made of the whole proceedings, and that process, in the nature of a *scire facias*, should be issued, to try the validity of the patent. The court denied the motion, upon the ground that these were summary proceedings, and that the patent was repealed *de facto* by making the rule absolute, and that the process to be issued was not in the nature of a *scire facias* to try the validity of the patent, but merely process repealing the patent.

A motion was made, on a former day of this term, in behalf of the patentees, for a rule upon the district judge to show cause why a mandamus should not issue from this court, directing him to make a record of the proceedings in the cause, and to issue a *scire facias* for the purpose of trying the validity of the patent. The rule having been granted, and due service had, the case has since been argued by counsel for and against the rule; and the opinion of this court is now to be delivered.

Two objections have been urged at the bar against the making this rule absolute. The first is, that these proceedings, being summary, are not properly matters of record. The second, that this is not a case in which, by law, a *scire facias*, or process in the nature of a *scire facias*, can be awarded to try the validity of the patent.

Both of these objections are founded upon the provisions of the tenth section of the patent act, and must be decided by a careful examination of those provisions. The words are, "That upon oath or affirmation being made before the judge of the District Court where the patentee, his executors, &c., reside, that any patent which shall be issued in pursuance of this act was obtained surreptitiously, or upon false suggestion, and motion made to the said court within three years after issuing the said patent, but not afterwards, it shall and may be lawful for the judge of the said District Court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee, or his executor, &c., show cause why process should not issue against him to repeal such patent; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute; and thereupon the judge shall order process to be issued against such patentee, or his executors, &c., *with costs of suit*. And in case no sufficient cause shall be shown to the contrary, or if it shall appear

that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of the said patent. And if the party at whose complaint the process issued shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court and recovered in due course of law."

Upon the slightest inspection of this section, it will be at once perceived that, however summary the proceedings may be, they are of vast importance to the parties, and involve the whole right and interest of the patentee. The jurisdiction given to the court is not general and unlimited, but is confined to cases where the patent was obtained surreptitiously, or upon false suggestions, where the patentee resides within the district, and where the application is made within three years after the issuing of the patent. It is, therefore, certainly necessary that all these facts, which are indispensable to found the jurisdiction, should be stated in the motion and accompanying affidavits; and without them the court cannot be justified in awarding the rule. It follows, of course, that in any record that is to be made of the proceedings they constitute the preliminary part, and ought not be omitted. In the present case they have been wholly omitted; and the record is, in this respect, incomplete and inaccurate.

But it is said that, technically speaking, these proceedings are not matters of record. They are certainly proceedings of a court of record, for such are all the courts of the United States, in virtue of their organization, both upon principles of the common law and the express intendment of Congress. In general, the interlocutory proceedings in suits are not entered of record, as they are deemed merely collateral incidents. But where a special jurisdiction is given to a court, as in the present instance, it appears to us that, in conformity to the course of decisions in this court upon the subject of jurisdiction, all the preliminary proceedings required to found that jurisdiction should appear of record, as they constitute an essential part of the case. In general, motions and rules made in the course of suits over which the court has an acknowledged jurisdiction are not entered of record. But where a rule is the sole foundation of the suit, and the first step in its progress, that rule can only be granted under special circumstances prescribed by law. It is not sufficient to show that the rule itself was granted, but it must also appear by the proceedings that it was rightfully granted.

But the more material question is, whether the proceedings, so far as the rights of the patentees are concerned, terminated with the rule being made absolute, so that *ipso facto* the patent was repealed, and

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the process to be issued was only process to enforce or declare the repeal; or whether the process was in the nature of a *scire facias* at common law to repeal the patent, if, upon a future trial, the same should be found invalid.

This question must be decided by the terms of the section in controversy; but, in the interpretation of those terms, if their meaning is somewhat equivocal, that construction ought certainly to be adopted which, not departing from the sense, is most congenial to our institutions, and is most convenient in the administration of public justice. The securing to inventors of an exclusive right to their inventions was deemed of so much importance, as a means of promoting the progress of science and the useful arts, that the Constitution has expressly delegated to Congress the power to secure such rights to them for a limited period. The inventor has, during this period, a property in his inventions—a property which is often of very great value, and of which the law intended to give him the absolute enjoyment and possession. In suits at common law, where the value in controversy exceeds twenty dollars, the Constitution has secured to the citizens a trial by jury. In cases of equity and admiralty jurisdiction, they have the security of a regular and settled course of proceedings; where the rules of evidence and the principles of decision are well established. And in all these cases, there is the farther benefit, conferred by our laws, of revising the judgments of the inferior courts by the exercise of appellate jurisdiction. It is not lightly to be presumed, therefore, that Congress, in a class of cases placed peculiarly within its patronage and protection, involving some of the dearest and most valuable rights which society acknowledges and the Constitution itself means to favor, would institute a new and summary process, which should finally adjudge upon those rights without a trial by jury, without a right of appeal, and without any of those guards with which, in equity suits, it has fenced round the general administration of justice. The Patent Acts have given to the patentee a right to sue at common law for damages for any violation of his invention, and have given him a farther right to claim the interference of a court of equity, by way of injunction, to protect the enjoyment of his patent. It would be somewhat surprising if, after such anxious legislation, there should exist in the act a clause which, in a summary manner, enables any person to repeal his patent, and thus sweep away his exclusive property, without interposing any guards by way of appeal, or any regular proceedings by which the validity of titles, in ordinary cases, is examined and contested.

With these considerations in view, let the tenth section of the act

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be examined. Its object is to provide some means to repeal patents which have been obtained surreptitiously, or upon false suggestions—the very cases for which a *scire facias* issues at the common law. As the patents are not enrolled in the records of any court, but among the rolls of the Department of State, it was necessary to give some directions as to the correct time and manner of instituting proceedings to repeal them. It accordingly directs that the district judge may, upon proper evidence, under oath and motion made to the court, in his discretion, “grant a rule that the patentee, &c., show cause why process should not issue against him to repeal such patent; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the judge shall order process to be issued against such patentee, &c., with costs of suit.” It is obvious, from the language of this clause, that the rule is a rule not to repeal the patent, if it is made absolute, but a rule for process to issue to repeal the patent. It is not, then, the rule, but the process contemplated by the act, that repeals the patent. It is not a mere form, but it is of the essence of the proceedings, without which the rule has no efficacy. Is the process to be issued a process which *per se* repeals the patent, or are the words “to repeal such patent” to be construed as merely descriptive of the nature of the process, and of the effect of it, if judgment shall be finally pronounced in support of it? In other words, is it a process in the nature of an execution, or a judicial process in the nature of a *scire facias*, calling for further proceedings? If the words of the section had stopped at the clause already referred to, it would, perhaps, have been difficult to find a sufficient explanation of the legislative will to have led the court to the conclusion that judicial process, in the nature of a *scire facias*, was certainly intended; there would have been some reason for hesitation; but even then an interpretation against such process would not have been without serious embarrassments. It could not be arrived at without leaving much of questionable reasoning behind. But the section does not stop here. It goes on to make further provisions, which, if the process absolutely repealed the patent, could have no operation and no intelligible meaning. On the other hand, if the process was to be in the nature of a *scire facias*, all the words are sensible and operative, and describe the proper progress and proceedings upon such a writ. The clause is in these words: “And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of the patent.” These words follow after the clause awarding the process, and,

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of course, suppose the process already issued. The party is supposed to be called upon to show cause, which is precisely what a *scire facias* requires in its official mandate; and if no sufficient cause is shown to the contrary, or if it shall appear that the patentee was not the true inventor or discoverer, then the patent is to be repealed. If the process is merely to repeal the patent, and not to institute a trial, how can the party show cause?—how can it judicially appear that the patentee is not the inventor? These provisions are intelligible in a *scire facias*, for that authorizes subsequent inquiry into the law and the facts. But, farther, “judgment” is to be rendered. Now, it is not necessary to lay any particular stress on this word, as a known juridical phrase, expressive of the final decision of the court; but if the making the rule absolute repealed the patent, and the process is merely an execution, how could any subsequent judgment be rendered in the case? It would be contrary to all analogy, to all rules of judicial interpretation, to suppose that judgment is to succeed, and not to precede, the writ of execution. The clause goes on: “And if the party at whose complaint the process issued shall have judgment against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court and recovered in due course of law.” The language is here still more distinct and persuasive. It imports, in a clear manner, that some proceedings were to be had after the process issued, by which the case might be farther investigated; and if, upon such investigation, judgment should be against the complainant, the patentee should recover his costs. The language is, that the party at whose complaint the *process issued*, not the rule issued, shall have judgment against him. Upon what?—the rule? Certainly not; but upon the *process issued*. He shall pay the costs to which the defendant is put in defending the suit. What suit is here intended? We think it is clear that it means the suit upon the process, that is, upon the *scire facias*; for the proceedings upon the rule are not, in a technical or in any accurate sense, a suit. The costs of *defending* the suit are to be paid. But how can any costs arise from a defense upon a process which is final and absolute? It appears to the court, that to give the construction contended for by the counsel against the rule would be to reject the plain and obvious purport of the whole of the last clauses of the section, and make them a perfect nullity. In the other view, they have the entire effect, and are as reasonable and just in themselves as they are promotive of the security of vested rights and property.

Nor does the occurrence of the words “costs of suit,” in the pre-

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ceding part of the section, where it is said that "the process shall be issued, &c., with costs of suit," in the slightest degree impugn this interpretation. The true meaning of these words, in this connection, is not that costs of suit already incurred shall be paid and collected, but that the process shall be to show cause why the patent shall not be repealed, and costs of suit given to the complainant. In this view, it fortifies the construction already asserted by the court. That this is the true exposition of the words, is made apparent by examining the fifth section of the Patent Act of 1790, ch. 34, which is exactly similar in terms to the tenth section of the present act, except that it omits, in this place, the words "costs of suit." These words, therefore, were not intended to change, and cannot be admitted to change, the natural meaning of other parts of the section. And if the other words used in this connection are descriptive of the nature of the process, these words are merely explanatory of the legislative intent, that the costs of the suit should follow upon the final judgment in favor of the complainant. Without this provision, as the other clause giving costs applies to the patentee only, the complainant, although he should prevail in the suit, would not be entitled to any costs. This was a real defect in the first act, and is cured by the insertion of the words under consideration.

Nor are there any public mischiefs which will result from the view which the court takes of this section. On the contrary, it will subserve the purposes of general justice. If a patent has been fraudulently obtained, or upon false suggestions, it may be repealed within three years, if a jury upon a trial shall be satisfied of the fact. If such a repeal be not had, still the public have a perfect security. They may violate the patent with impunity, and, if sued for the violation, any person may show the same facts in his defense, and they will constitute a complete bar to the suit, by the express provisions of the sixth section of the Patent Act. Here, also, the trial will be ordinarily by a jury, and if the verdict is found upon such facts in favor of the defendant, the law expressly declares that "judgment shall be rendered for the defendant, with costs, and the patent shall be declared void." Many patents under this section have already, in such suits, been adjudged void; so that the danger of extensive imposition or injury is wholly chimerical. On the other hand, if, by any accident or mistake, the patentee should neglect to appear to oppose the rule, upon the argument on the other side, he may be remediless. But, upon the exposition of the statute adopted by the court, he will still be entitled to appear to the *scire facias*, and have a more deliberate opportunity to defend his right.

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Upon the whole, it is the opinion of the court that the rule ought to be made absolute, and that a peremptory mandamus issue to the judge of the District Court, directing him to enter upon record the proceedings in this cause antecedent to the granting of the rule, and upon which it was founded; that he award a process, in the nature of a *scire facias*, to the patentees, to show cause why the patent should not be repealed, with costs of suit; that upon such process being returned, duly executed, he proceed to try the same cause, upon the pleadings filed by the parties and the issue joined thereon; and that if the issue so joined be an issue of fact, then the trial thereof to be by a jury; if an issue of law, then by the court, as in other cases.

MANDAMUS ACCORDINGLY.

JUDGMENT. Upon the hearing of this cause, upon the rule to show cause heretofore awarded by this court, and on consideration of the arguments of counsel for and against making the same rule absolute, it is ordered and adjudged by the court that the same rule be, and hereby is, made absolute. And it is further ordered by the court that a peremptory mandamus issue to the district judge of the Southern District of New York, commanding him to enter upon record the proceedings in this cause, antecedent to the granting by him of the rule to show cause why process should not issue to repeal the patent in the proceedings mentioned, and upon which the said rule was founded; that the said judge do award a process in the nature of a *scire facias* to the patentees, to show cause why the said patent should not be repealed, with costs of suit; that upon the return of such process, as duly served, the said judge do proceed to try the cause, upon the pleadings filed by the parties and the issue joined thereon; and that if the issue be an issue of fact, the trial thereof be by a jury; if an issue of law, then by the court, as in other cases.

## KEPLINGER v. DE YOUNG.

(10 Wheaton, 358.)

1. A having obtained a patent for a new and useful improvement, to wit, a machine for making watch-chains, brought an action, under the third section of the Patent Act of 1800, ch. 179, (XXVI.) for a violation of his patent-right, against B; and on the trial an agreement was proved, made by the defendant with C, to purchase of him all the watch-chains, not exceeding five gross a week, which he might be able to manufacture within six months, and an agreement on the part of C to devote his whole time and attention to the manufacture of the watch-chains, and not to sell or dispose of any of them

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so as to interfere with the exclusive privilege secured to the defendant, of purchasing the whole quantity which it might be practicable for C to make. And it was proved that the machine used by C, with the knowledge and consent of the defendant, in the manufacture, was the same with that invented by the plaintiff, and that all the watch-chains thus made by C were delivered to the defendant, according to the contract :

*Held*, That if the contract was real and not colorable, and if the defendant had no other connection with C than that which grew out of the contract, it did not amount to a breach of the plaintiff's patent-right.

2. Such a contract, connected with evidence from which the jury might legally infer, either that the machine which was to be employed in the manufacture of the patented article was owned wholly or in part by the defendant, or that it was hired to the defendant for six months, under color of a sale of the articles to be manufactured with it, and with intent to invade the plaintiff's patent-right, would amount to a breach of his right.

## ERROR to the Circuit Court of Maryland.

This cause was argued by *Mr. Webster* and *Mr. Sergeant* for the plaintiff, and by the *Attorney-General* for the defendant.

Mr. Justice WASHINGTON delivered the opinion of the court.

This was a suit commenced by the plaintiff, Keplinger, in the Fourth Circuit for the District of Maryland, against the defendant, for the violation of the plaintiff's patent-right, secured to him according to law, in a certain new and useful improvement, to wit, a machine for making watch-chains, &c. The third count in the declaration, upon which alone this cause has been argued, is in the usual form, charging the defendant with having unlawfully used the said improvement, without the consent of the plaintiff first had and obtained in writing. The defendant pleaded the general issue, and gave notice to the plaintiff that he should deny that the exclusive right of using the improvement mentioned in the declaration was vested in the plaintiff, or that he was the original and first inventor of the said improvement, and that he should give evidence to establish those facts.

At the trial, the plaintiff read in evidence the letters patent, duly granted, bearing date the 4th of May, 1820, and proved that he was the true and original inventor of the machine specified in the patent, and that the defendant, together with John Hatch and John C. Kirkner, did use the said machine in the making of watch-chains from steel, from the 4th of May till some time in the month of December, 1820.

The defendant, in order to prove that any concern or connection which he had with the said Hatch and Kirkner, in the making of watch-chains by means of the said machine, was merely as a pur-



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chaser of watch-chains from them under the following contract, produced and gave the same in evidence. The agreement referred to, bearing date the 3d of May, 1820, is between M. De Young, and J. Hatch, and J. Kirkner, and witnesses: "That the said Hatch & Kirkner do hereby engage and obligate themselves to manufacture and deliver to M. De Young, or at his store in said city, not less than three gross, but as many as five gross, of wire watch-chains, agreeably to a sample to be deposited with T. Barly, (if practicable to manufacture so many,) in each week, from the date hereof, for the term of six months, one-half of which number to be with turned slides, and the other half wire slides; the whole number to be four strands, if the said De Young so choose; but he is to have the privilege of directing the description to be furnished, that is to say, what number of four, five, six, or eight strands,—the prices of which to be as follows: four strands, two dollars per dozen; six strands, two dollars sixty-six cents and two-thirds per dozen, and eight strands at the rate of three dollars thirty-three cents per dozen; said Hatch & Kirkner to devote their whole time and attention to said manufacture, and neither to sell, barter, nor dispose of, in any manner, or way, or means whatever, of any goods of the description hereinbefore described, or which may, in any manner or way whatsoever, interfere with the exclusive privilege hereinbefore granted, but will faithfully manufacture for said De Young, and none other, as far as five gross of chains per week, if practicable, and not less than three gross per week, at the prices hereinbefore stipulated, and payable as follows: one-half in cash at the end of every week, for the total number delivered within the week, and the other half in said De Young's promissory note, payable at sixty days from the date thereof. And the said De Young, on his part, doth hereby promise to receive from the said Hatch & Kirkner such quantity of watch-chains, answering the description of the sample, as it may be in their power to manufacture, not exceeding five gross per week, reserving to himself the privilege of directing what proportion thereof shall be four, six, or eight strands, and pay for the same weekly in the following manner, namely: the one-half amount of the week's delivery in cash, the other half in a note at sixty days, the same to be settled for weekly, in manner aforesaid, if required."

The defendant also gave evidence to prove that all the connection he ever had with the said Hatch & Kirkner, relative to watch-chains made by them, with the said machine or otherwise, was merely as a purchaser of such chains from them, under and in pursuance of the said contract.

The plaintiff then proved that, at the time of making the said contract, the defendant was fully apprised of the existence of the machine described and specified in the patent, and of its prior and original invention by the plaintiff, and of the intention of the plaintiff to obtain the said patent: and that the said contract was made with a view to the employment by the said Hatch & Kirkner, in the manufacture of watch-chains, of a machine precisely similar to that invented by the plaintiff, after the plaintiff should have obtained his patent; and that a machine precisely similar to that invented by the plaintiff was employed by the said Hatch & Kirkner, in the manufacture of watch-chains by them under the said contract, and with the knowledge and consent of the defendant during the whole period aforesaid, he and they having received notice, on the 5th of May, 1820, of the plaintiff's patent; and that the watch-chains so manufactured by Hatch & Kirkner, during the whole of the said period, were delivered by them to the defendant, and by him received, under and in conformity with the said contract.

Upon this evidence, the court, at the request of the defendant's counsel, instructed the jury that the plaintiff was not entitled to a verdict on the first and second counts in his declaration, because the acts which they charge, if true, constitute no offense against the plaintiff's patent; and that, if the jury should be of opinion, on the evidence, that the plaintiff is the sole and original inventor of the whole machine; and that the defendant had no other connection with Hatch & Kirkner, with regard to these chains, than that which arose from his said contract with them, under which he procured the chains to be made by Hatch & Kirkner, and sold them when so made; and that the said contract is a real contract,—then these acts constituted no breach of the plaintiff's patent-right on the part of De Young, and that the verdict must be for the defendant; and that this legal aspect would not be changed, although the defendant may, on any occasion, have supplied, at the cost of Hatch & Kirkner, the wire from which the chains so manufactured were made.

To this instruction, the plaintiff's counsel took a bill of exceptions, and a verdict and judgment having been rendered for the defendant, the cause was brought into this court by a writ of error.

The only question which is presented by the bill of exceptions to the consideration of this court is, whether the court below erred in the instruction given to the jury; and this must depend upon the correct construction of the third section of the act of Congress, of the 17th April, 1800, ch. 179, which enacts: "That where any patent shall be granted pursuant to the act of the 21st of February, 1793,

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ch. 156, and any person, without the consent of the patentee, his executors, &c., first obtained in writing, shall make, devise, *use*, or sell the thing whereof the exclusive right is secured to the said patentee, by such patent, such person so offending shall profit and pay to the said patentee a sum equal to three times the actual damage sustained by such patentee," &c.

The contract, taken in connection with the whole of the evidence stated in the bill of exceptions, if the same were believed by the jury, formed most certainly a strong case against the defendant, sufficient to have warranted the jury in inferring, either that the machine which was to be employed in the manufacture of the watch-chains was owned in the whole or in part by the defendant, or that it was hired to the defendant for six months, under the color of a sale of the articles which might be manufactured with it, and with intent to invade the plaintiff's patent-right. Whether the contract, taken in connection with the whole of the evidence, does or does not amount to a hiring by the defendant of the machine, or the use of it for six months, is a point which is not to be considered as being decided either way by the court. The bill of exceptions does not call for an opinion upon it.

But the contract, taken by itself, amounted to no more than an agreement by the defendant to purchase, at a fixed price, all the watch-chains, not exceeding five gross a week, which Hatch & Kirkner might be able to manufacture in the course of six months, with any machine they might choose to employ; and an agreement on the part of Hatch & Kirkner, to devote their whole time and attention to the manufacture of the chains, and not to sell or dispose of any of them so as to interfere with the exclusive privilege secured to the defendant, of purchasing the whole quantity which it might be practicable for them to make.

If this contract was real, and not colorable, which is the obvious meaning of the instruction, and the defendant had no other connection with Hatch & Kirkner in regard to these chains than what grew out of it, it would, in the opinion of the court, be an extravagant construction of the Patent Law, to pronounce that it amounted to a breach of the plaintiff's patent-right, by fixing upon the defendant the charge of having *used* the plaintiff's machine. Such a construction would be highly inconvenient and unjust to the rest of the community, since it might subject any man, who might innocently contract with a manufacturer to purchase all the articles which he might be able to make within a limited period, to the heavy penalty inflicted by the act, although he might have been ignorant of the

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plaintiff's patent, or that a violation of it would be the necessary consequence of the contract. It might possibly extend farther, and affect contracts express or implied, though of a more limited character, but equally innocent, as to which, however, it is not the intention of the court to express any opinion, as this case does not call for it.

This cause was argued, by the plaintiff's counsel, as if the opinion of the court below had been given upon the whole of the evidence. But this was not the case. No instruction was asked for but by the defendant's counsel, and that was confined to a single part of the case: the connection between the defendant and Hatch & Kirkner in regard to the watch-chains which the latter bound themselves, by their contract, to manufacture and deliver to the former. If the jury had been of opinion, upon the whole of the evidence, that the contract was not a real one, or that that instrument did not constitute the sole connection between those parties, or that the transaction was merely colorable, with a view to evade the law, the jury were not precluded by the instruction from considering the plaintiff's patent-right as violated, and finding a verdict accordingly.

Had the plaintiff's counsel thought proper to call upon the court for an opinion and instruction to the jury, upon any points arising out of the whole or any part of the evidence, it would have been their duty to give an opinion upon such points, leaving the conclusion of fact from the evidence to be drawn by the jury. But this course not having been pursued, this court can take no notice of the evidence, although spread upon the record, except so far as it is connected with the single point upon which the opinion which is expected to was given. As to the residue of that opinion, that "the legal aspect of the case would not be changed, although the defendant might, on any occasion, have supplied, at the cost of Hatch & Kirkner, the wire from which the chains so manufactured were made," it is quite as free from the objection as the preceding part of it, since it stands upon precisely the same principle.

JUDGMENT AFFIRMED WITH COSTS.

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ABRAHAM L. PENNOCK AND JAMES SELLERS v. ADAM DIALOGUE.

(2 Peters, 1.)

1. The record contains, embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial of the cause by each party in support of the issue. It is very voluminous, and as no exception was taken to its competency or sufficiency, either generally or for any particular purpose, it is not properly before the court for consideration, and forms an expensive

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and unnecessary burden upon the record. This court has had occasion, in many cases, to express its regret on account of irregular proceedings of this nature. There was not the slightest necessity of putting any portion of the evidence in this case upon the record, since the opinion of the court, delivered to the jury, presented a general principle of law, and the application of the evidence to it was left to the jury.

2. It is no ground of reversal, that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us that the court has given no erroneous directions.
3. If either party considers any point presented by the evidence omitted in the charge of the court, it is competent for such party to require an opinion from the court upon that point. The court cannot be presumed to do more, in ordinary cases, than to express its opinion upon questions which the parties themselves have raised on the trial.
4. It has not been, and indeed it cannot be, denied that an inventor may abandon his invention, and surrender or dedicate it to the public. This inchoate right, thus gone, cannot afterwards be resumed at his pleasure; for when gifts are once made to the public in this way they become absolute. The question which generally arises on trials is a question of fact, rather than of law—whether the acts or acquiescence of the party furnish in the given case satisfactory proof of an abandonment or dedication of the invention to the public.
5. It is obvious that many of the provisions of our Patent Act are derived from the principles and practice which have prevailed in the construction of the law of England in relation to patents.
6. Where English statutes—such, for instance, as the statute of frauds and the statute of limitations—have been adopted into our own legislation, the known and settled construction of those statutes by courts of law has been considered as silently incorporated into the acts, or has been received with all the weight of authority. This is not the case with the English statute of monopolies, which contains an exception, on which the grants of patents for inventions have issued in that country. The language of that clause in the statute is not identical with the Patent Law of the United States; but the construction of it adopted by the English courts, and the principles and practice which have long regulated the grants of their patents, as they must have been known, and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it.
7. The true meaning of the words of the Patent Law, “not known or used before the application,” is, not known or used *by the public* before the application.
8. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should, for a long period of years, retain the monopoly, and make and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure, and then, and then only, when the danger of competition should force him to procure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any further use than what should be derived under it during his fourteen years, it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.
9. If an invention is used by the public, with the consent of the inventor, at the time of his application for a patent, how can the court say that his case is nevertheless such as the act was intended to protect? If such a public use is

## Statement of the case.

not a use within the meaning of the statute, how can the court extract the case from its operation, and support a patent, when the suggestions of the patentee were not true, and the conditions on which alone the grant was authorized do not exist?

10. The true construction of the Patent Law is, that the first inventor cannot acquire a good title to a patent if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent. This voluntary act, or acquiescence in the public sale or use, is an abandonment of his right; or, rather, creates a disability to comply with the terms and conditions of the law, on which alone the Secretary of State is authorized to grant him a patent.

THIS case was brought before the court on a writ of error to the Circuit Court for the Eastern District of Pennsylvania.

In that court, the plaintiffs in error had instituted their suit against the defendants, for an infringement of a patent-right, for "an improvement in the art of making tubes or hose for conveying air, water, and other fluids." The invention claimed by the patentees was in the mode of making the hose, so that the parts so joined together would be tight, and as capable of resisting the pressure as any other part of the machine.

The bill of exceptions which came up with the record contained the whole evidence given in the trial of the cause in the Circuit Court. The invention for which the patent-right was claimed was completed in 1811, and the letters patent were obtained in 1818. In this interval, upwards of *thirteen thousand feet of hose*, constructed according to the invention of the patentees, had been made and sold in the city of Philadelphia. One Samuel Jenkins, by the permission of, and under an agreement between the plaintiffs as to the price, had made and sold the hose invented by the plaintiffs, and supplied several hose companies in the city of Philadelphia with the same. Jenkins, during much of the time, was in the service of the plaintiffs, and had been instructed by them in the art of making the hose. There was no positive evidence that the agreement between Jenkins and the plaintiffs in error was known to or concealed from the public. The plaintiffs, on the trial, did not allege or offer evidence to prove that they had delayed making application for a patent for the purpose of improving their invention, or that from 1811 to 1818 any important modifications or alterations had been made in their riveted hose. The plaintiffs claimed before the jury that all the hose which had been made and sold to the public prior to their patent had been constructed and vended by Jenkins under their permission.

Upon the whole evidence in the case, the Circuit Court charged the jury:

## Argument for the plaintiff.

“We are clearly of opinion that if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention, of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention to which a patent would have entitled him had it been applied for before such use. And we think it makes no difference in the principle, that the article so publicly used, and afterwards patented, was made by a particular individual, who did so by the private permission of the inventor. As long as an inventor keeps to himself the subject of his discovery, the public cannot be injured; and even if it be made public, but accompanied by an assertion of the inventor's claim to the discovery, those who should make or use the subject of the invention would at least be put upon their guard. But if the public, with the knowledge and the tacit consent of the inventor, is permitted to use the invention without opposition, it is a fraud upon the public afterwards to take out a patent. It is possible that the inventor may not have intended to give the benefit of his discovery to the public, and may have supposed that by giving permission to a particular individual to construct for others the thing patented, he could not be presumed to have done so. But it is not a question of intention which is involved in the principle which we have laid down, but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. It is for the jury to say whether the evidence brings this case within the principle which has been stated. If it does, the court is of opinion that the plaintiffs are not entitled to a verdict.”

To this charge the plaintiffs excepted, and the jury gave a verdict for the defendant.

*Mr. Webster, for plaintiff in error, contended:*

1. That the invention being of such a nature that the use of it, for the purpose of trying its utility and bringing it to perfection, must necessarily be open and public, the implication of a waiver or abandonment of the right, furnished by such public use, is rebutted by the circumstance that the article was made and sold only by one individual, and that individual was authorized and permitted so to do by the inventors.

2. That the use of an invention, however public, if it be by the permission and under the continual exclusive claim of the inventor, does not take away his right, except after an unreasonable lapse of time, or gross negligence in applying for a patent.

3. That the jury should have been instructed, that if they found

the riveted hose which was in use by the hose companies had been all made and sold by Jenkins, and by no one else, prior to the grant of the patent, and that he was permitted by the inventors under their agreement so to make and sell the same, that such use of the invention, not being adverse to their claim, did not take away their exclusive right, nor imply an abandonment of it to the public.

4. That if they found the hose had not been made or sold, prior to the grant of the patent, by any person but Jenkins, then the giving of permission to him, being in itself an assertion of claim, was not a dedication to the public; and that the public, by purchasing and using the hose thus made by the permission of the inventors, acquired no title to the invention; but, on the contrary, if the price paid included a premium for the invention, the public by so purchasing admitted the right of the inventors.

5. That, at any rate, there being no use *by the public* of this invention, it should have been left to the jury to say whether, under all the circumstances, considering the nature of the invention and the time necessary to perfect it, the plaintiffs have been guilty of negligence in not sooner applying for a patent.

Mr. Webster stated that the question to be decided by the court laid within a narrow compass. The defense set up was that the plaintiffs had suffered their invention to be used before their application for a patent, and had thus lost all right to the exclusive use of it.

The court, in this case, would be called upon to reverse the English decision relative to abandonments; for it was admitted that those cases had gone to the whole extent of the principles applied to this case in the Circuit Court. Those cases have decided that any public use of an invention, even for experiment, renders it no longer a new machine. In the courts of the United States a more just view had been taken of the rights of inventors. The laws of the United States were intended to protect those rights, and to confer benefits; while the provisions in the statute of England, under which patents are issued, are exceptions to the law prohibiting monopolies. Hence, the construction of the British statute had been exceedingly strait and narrow, and different from the more liberal interpretation of our laws.

By the decisions of our courts, there must be a *voluntary abandonment* or *negligence*, or *unreasonable* delay in obtaining letters patent, to destroy the right of the patentee. *Goodyear v. Mathews*, Paine's Rep., 300; *Morris v. Huntington*, Ibid., 348.

The exception to the charge of the court is, that the jury should have been instructed to decide, upon the evidence, whether the plaintiff meant to abandon his invention by the permission to Jenkins to



## Argument for the defendant.

use it. Jenkins must be considered as the private agent of the inventors, and their agreement with him, under which he made the hose, is to be considered rather as an assertion of their exclusive right to the invention than a surrender of it. By omitting to leave to the jury this question of an intention to abandon, the case was erroneously withdrawn from them. The rights of the parties also entitled them to have the causes of their delay in patenting their invention inquired of by the jury. As the case is presented on the bill of exceptions, the court in their charge undertook to state the whole law of the subject-matter to the jury, and the omission to instruct them on any one point is error.

If, in this charge of the court, anything is omitted which was matter of law for the jury, it is misdirection.

In a case in Massachusetts, said to be reported in 4 Mason's Rep., it was left to the jury to decide whether seventeen years' delay could be accounted for.

Under the provisions of the laws of the United States, the right is created by the *invention*, and not by the *patent*. The court, therefore, may have misled the jury, in stating that the plaintiffs allowed the invention to be used. The *thing invented* was only permitted to be used.

The suggestion that, by adopting the language of the English statute, the cases decided in England upon that statute are adopted, may be answered by a reference to those cases. They have all arisen within a few years since the enactment of our law; and, except the dictum of Lord Coke in 2 Institute, the authorities are all of modern date.

If this court shall be of opinion that, as no instructions were particularly asked upon the questions raised here, the court below were not bound to notice them in the charge, and that the court did not undertake to decide the whole law, the plaintiff in error can make out no case here. But if this court shall consider the questions now submitted doubtful, as the rights of the plaintiffs may not have been fully investigated, by sending the case back to the Circuit Court a more full investigation of all the points involved in it may be made.

*Mr. Sargeant, for the defendant, insisted:*

1. That mere invention gives no right to an exclusive use, unless a patent is obtained; and that if, at a time when no right is infringed, the public fairly acquire possession of it, the inventor cannot, by subsequently obtaining a patent, take it away.

2. That the inventor, by abstaining from getting a patent, encour-

aged the public to use the article freely, and thus benefited his own manufactory. And he is not at liberty, when this advantage is exhausted, to turn round and endeavor to reach another and a different kind of advantage, by appropriating the use exclusively to himself.

In the circuit where this cause was tried, it was not the practice to ask the court for special instructions to the jury. After the evidence had been closed and counsel heard, a charge was given to the jury, according to the nature of the case, upon the points made by counsel, or which might suggest themselves to the mind of the judge. It was competent, however, to either party, after the charge, to ask the opinion of the court upon any point supposed to have been omitted which was material to the decision. In this case, no such request had been made; and no objection can now be made to the charge for any imputed omission. The only question was, whether the principles laid down to the jury for their guidance were correct, and according to law, in the particular excepted to.

The charge must of course be considered with reference to the facts, the whole of which appear upon the record. The petition of the plaintiffs to the Secretary of State stated, in the words of the Patent Law, that they were the inventors of a "new and useful improvement," "not *known* or *used* before their application." The "application" was made in July, 1818. Their averment, therefore, upon which they obtained their patent, was, that the rivet hose was a new invention, not "known or used" before the year 1818. The facts proved upon the trial were that the invention had been completed and published in the year 1811, seven years before the application; that during that period it had been known and used as common public property, (and not as private property,) which any one might use as publicly known; and that it was so known and used with the knowledge of those who now claim to be the inventors, without any assertion or claim on their part of exclusive property, and without notice of intention to make such claim. There was not a single circumstance offered to explain the delay.

There was an attempt to show that the making of the article for use was limited by the authority and permission of the plaintiffs, and thence to infer that they did not intend to give it to the public. A witness produced by them, and the only person who appeared to have made the article, declared, in substance, "that he was taught by the plaintiffs in 1811 to make hose; that in *that* year he made a certain quantity of it for the Philadelphia Hose Company, plaintiffs being members of the committee; and that by permission of the plaintiffs

he made about thirteen thousand feet of hose, for different hose companies, from 1811 to the time of granting the patent."

Thus, in point of fact, nearly two miles and a half in length of hose had been made at different times in the course of seven years, before the patent, and had been sold to different hose companies, not to experiment with, in order to bring the invention to perfection, but for public use, as a thing already completed and adapted to the purpose of arresting the ravages of fire. It was so used; and from the year 1811 to the year 1818 it was never materially altered or improved. The thing patented in 1818 was precisely the thing invented, completed, and used in 1811.

Were the plaintiffs, under these circumstances, entitled to a patent? Or could a patent thus obtained be supported? The authorities upon the subject are decisive. He did not admit that the weight of judicial or legal opinion in England was lessened by the supposed difference in the policy of the two countries, or that in fact any such difference existed. It was true that the process or mode of legislation was varied according to the existing state of things. The statute of James was made to abolish monopolies; but it saved, by exception, the rights of the inventors of new and useful inventions who had before enjoyed exclusive privileges. The Constitution of the United States and the act of Congress, on the contrary, having no monopolies to deal with, created exclusive privileges in favor of the same description of persons. The one preserved to them a preëxisting monopoly, and the other conferred it upon them. Both were influenced by the merits of the inventor and the public advantage of encouraging inventive genius. And they were equally influenced by these considerations; for it required at least as strong a sense of their just claims to distinction, to except new and useful inventions from the statutory odium and denunciation of monopolies, as it did to confer upon them the benefits of monopoly by direct enactment. There was no reason, therefore, why the judicial construction of the statute of James, (from which our act of Congress was in this respect copied,) which had become, as it were, incorporated with and part of the statute, should not be as much respected as in the instance of any other statute. The adoption of the language of the statute was the adoption also of its settled interpretation. It could not surely be insisted that England was wanting in intelligence to discern the value of genius, or in liberality to reward it; or that there was a prevailing bias in her judiciary towards an unjust restriction of the rights of meritorious inventors. The sentiment of the nation and the government, in all its branches, was the opposite of this.

## Argument for the defendant.

Before referring to the cases, it might be well, however, to examine the matter a little upon principle. What is the right of an inventor? It is the right, *given to him by the law*, to apply for and obtain a patent for his invention. The patent, when duly obtained, secures to him the exclusive enjoyment. Has he any other right, before he obtains a patent, than the one just stated? It is obvious that he has not. This, then, is what the learned judge in his charge styles, with peculiar aptness, an inchoate right; that is, a right to have a title upon complying with the terms and conditions of the law. It is like an inchoate right to land, or an inceptive right to land, well known in some of the States, and everywhere accompanied with the condition that, to be made available, it must be prosecuted with due diligence to the consummation or completion of the title. If the condition be not complied with, the right is abandoned or lost, and the rights of others are let in. The abandonment is not a question of intention of the party, but it is the legal construction of his acts or omissions.

Had the plaintiffs ever such an inchoate right? According to the opinion of the judge, they undoubtedly had such a right by their invention in 1811. *Then*, they could have made out the case required by the first section of the act of Congress—they could have stated with truth that the thing invented “was not known or used before their application.” But in the year 1818 it was no longer true. It might be stated, but it could not be truly stated. They were unable to comply with the condition of law. For if the inventor, as was the case here, voluntarily permit his invention to be known and used as a thing not intended to be patented, how can he make this statement? By so doing, he abandons his inchoate right; he proclaims to the world that he does not mean to secure it by patent, and every one is at liberty to consider it abandoned, because every one acquainted with the law knows that he has incurred a disability. This is the inevitable legal construction of his conduct, and is altogether independent of his intention, unless we suppose the act to be guilty of the absurdity of requiring that to be stated which it does not require to be true.

But the terms of the act are in this respect too plain to admit of a doubt. Suppose an applicant should state that his invention had been known and used for seven years before his application, could he obtain a patent? Suppose he should state that he had always intended to reserve to himself a right to obtain a patent, would that help him? Or, if he should state that it had been so known and used only by his permission? The language of the act is plain and im-

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Argument for the defendant.

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perative. There is no scope for interpretation. The prescribed condition is express. And there is no doubt that it was the intention of Congress to refer to the "application," as the period before which the thing was not known or used; for in the subsequent act of 17th April, 1800, conferring the privileges of the Patent Law upon resident aliens, the same word is used for the same purpose. And it is declared that the patent shall be void if the thing patented was *known or used before the application*. Act of 17th April, 1800, section 1.

It is not contended, that if the invention should be pirated, the use or knowledge obtained by the piracy, or otherwise obtained without the knowledge or consent and without the fault of the inventor, would bar him from getting a patent. Nor is it contended that his own knowledge and use would be a bar. The latter is a necessary exception out of the generality of the terms of the law, because every inventor must know his invention, and must use it to the extent of ascertaining its usefulness, before he applies for a patent. The former is a case where there is no fault on the part of the inventor. But it is contended that the inventor who means to rely upon a patent must make his application within a reasonable time, and that if he permit his invention to be publicly known and used before he applies, he cannot obtain a patent. He abandons his right if he sell it for public use himself, and, *a fortiori*, if he permit another so to sell it.

There is a cautious intimation in the charge, that possibly there might be some saying efficacy in accompanying the use with an assertion of claim by the inventor. And it is also put as a circumstance against the plaintiffs (which was clearly in evidence) that there was no such assertion or notice. The charge is therefore applicable only to a case of unqualified public use, without notice or assertion of claim. That such a notice would be available, or that there can be any other assertion of claim than the legal assertion by applying for a patent, are propositions which it is not now necessary to examine. They were not affirmatively laid down by the court, nor otherwise adverted to than for the purpose of showing that the facts did not entitle the plaintiffs to the benefit of them. They cannot, therefore, complain. Whether such assertions or notice, contradicted by the acts of the inventor, will be available, is a question not decided below. Certain it is, that a secret permission, given to their own agent, can no more be an assertion or notice than a resolution blocked up in their own breasts.

The construction contended for is in accordance with the policy of the law. Patents are intended to be granted for a limited time, be-

## Argument for the defendant.

ginning with the invention. He who asks for one must describe his invention with such certainty as will insure to the public its use when the patent expires; and at the expiration of the time the thing invented is public property. The inventor, to enjoy its benefits, must place his whole reliance upon it. Is it competent for him, then, to secure to himself the advantages of his own peculiar knowledge and skill as long as these will avail him, and when they are exhausted to apply for a patent? There are many inventions the secret of which is not at once discoverable from an inspection of the thing invented. The inventor may keep that as long as he can. He may have extraordinary skill or methods of working which will enable him to keep the market to himself. May he enjoy these exclusive privileges for seven years, and then obtain a patent for fourteen more? He would then have the exclusive use for twenty-one years. If for seven, why not for fourteen, or twenty-one, or any other assignable time? The moment that his invention comes into the most common or public use, is the moment when he applies for a patent. When the public have fully got possession of it, he seeks to withdraw it from the common stock and appropriate it to himself. This is directly contrary to the design of the law. It extends the term and inverts the order of proceeding. The inconveniences would be very great. Those who were engaged in making the article must stop. Those who had arranged for making it must abandon their arrangements. Those who had employed their time in learning to make it must lose their time and their labor. And even a *bona fide* inventor, who had discovered the same thing by his own study and experiments, would be deprived of the fruits of his ingenuity and exertions. And why? Simply because the first inventor did not choose sooner to take out a patent, as he might have done. The conditions of the law being such as he can comply with, and ought to comply with, he postpones a compliance for his own profit, and leads the community into an injurious error. If it be designed, it is a wrong. If it be without design, it is negligence. Ought he to be benefited by his own wrong or negligence?

The authorities are against him. He cited 3 Inst., 184; *Wood v. Zimmer*, 1 Holt's N. P. Rep., 58; *Whittemore v. Cutter*, 1 Gall., 482; and referred to *Evans v. Eaton*, 1 Peters's C. C. Rep., 348; *Thompson v. Haight*, 1 U. S. Law Journal, 563.

He then examined the several points stated for the defendant, contending that some of them were unsupported by the facts and others by the law. Under the second, he argued that there had been an "unreasonable lapse of time" and "gross negligence." That seven

## Opinion of the court.

years—the period here unexplained—were beyond all reasonable bounds.

He contended also that due diligence, where there were no circumstances of explanation, was a question of law; and that it consisted in applying for a patent as soon after the invention was completed as could reasonably be done; and, finally, that due diligence required that the application should be made before the thing invented was publicly known and used with the consent of the inventor.

Mr. Justice STORY delivered the opinion of the court.

This is a writ of error to the Circuit Court of Pennsylvania. The original action was brought by the plaintiffs in error for an asserted violation of a patent granted to them on the 6th of July, 1818, for a new and useful improvement in the art of making leather tubes, or hose, for conveying air, water, and other fluids. The cause was tried upon the general issue, and a verdict was found for the defendant, upon which judgment passed in his favor; and the correctness of that judgment is now in controversy before this court.

At the trial, a bill of exceptions was taken to an opinion delivered by the court in the charge to the jury, as follows, namely: "That the law arising upon the case was, that if an inventor makes his discovery public, looks on and permits others freely to use it, without objection or assertion of claim to the invention of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention to which a patent would have entitled him, had it been applied for before such use; and that it makes no difference in the principle that the article so publicly used, and afterwards patented, was made by a particular individual, who did so by the private permission of the inventor. And thereupon did charge the jury *that, if the evidence brings the case within the principle which had been stated*, the court were of opinion that the plaintiffs were not entitled to a verdict."

The record contains, embodied in the bill of exceptions, the whole of the testimony and evidence offered at the trial by each party in support of the issue. It is very voluminous, and as no exception was taken to its competency or sufficiency, either generally or for any particular purpose, it is not properly before this court for consideration, and forms an expensive and unnecessary burden upon the record. This court has had occasion in many cases to express its regret on account of irregular proceedings of this nature. There was not the slightest necessity of putting any portion of the evidence in this case upon the record, since the opinion of the court, delivered to the

jury, presented a general principle of law, and the application of the evidence to it was left to the jury.

In the argument at the bar, much reliance has been placed upon this evidence by the counsel for both parties. It has been said, on behalf of the defendants in error, that it called for other and explanatory directions from the court, and that the omission of the court to give them in the charge furnishes a good ground for a reversal, as it would have furnished in the court below for a new trial. But it is no ground of reversal that the court below omitted to give directions to the jury upon any points of law which might arise in the cause, where it was not requested by either party at the trial. It is sufficient for us that the court has given no erroneous directions. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion from the court upon that point. If he does not, it is a waiver of it. The court cannot be presumed to do more in ordinary cases than to express its opinion upon the questions which the parties themselves have raised at the trial.

On the other hand, the counsel for the defendant in error has endeavored to extract from the same evidence strong confirmations of the charge of the court. But, for the reason already suggested, the evidence must be laid out of the case, and all the reasoning founded on it falls.

The single question, then, is, whether the charge of the court was correct in point of law. It has not been, and indeed cannot be, denied that an inventor may abandon his invention and surrender or dedicate it to the public. This inchoate right, thus once gone, cannot afterwards be resumed at his pleasure; for where gifts are once made to the public in this way, they become absolute. Thus, if a man dedicates a way or other easement to the public, it is supposed to carry with it a permanent right of user. The question which generally arises at trials is a question of fact rather than of law—whether the acts or acquiescence of the party furnish, in the given case, satisfactory proof of an abandonment or dedication of the invention to the public. But when all the facts are given, there does not seem any reason why the court may not state the legal conclusion deducible from them. In this view of the matter, the only question would be whether, upon general principles, the facts stated by the court would justify the conclusion.

In the case at bar, it is unnecessary to consider whether the facts stated in the charge of the court would, upon general principles, warrant the conclusion drawn by the court, independently of any



## Opinion of the court.

statutory provisions, because we are of opinion that the proper answer depends upon the true exposition of the act of Congress under which the present patent was obtained. The Constitution of the United States has declared that Congress shall have power "to promote the progress of science and useful arts by securing, *for limited times*, to authors and inventors, the exclusive right to their respective writings and discoveries." It contemplates, therefore, that this exclusive right shall exist but for a limited period, and that the period shall be subject to the discretion of Congress. The Patent Act of the 21st of February, 1793, ch. 11, prescribes the terms, and conditions, and manner of obtaining patents for inventions; and proof of a strict compliance with them lies at the foundation of the title acquired by the patentee. The first section provides: "That when any person or persons, being a citizen or citizens of the United States, shall allege that he or they have invented any new or useful art, machine, manufacture, or composition of matter, or any new or useful improvement on any art, machine, or composition of matter *not known or used before the application*, and shall present a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the same, and praying that a patent may be granted therefor, it shall and may be lawful for the said Secretary of State to cause letters patent to be made out in the name of the United States, bearing teste by the President of the United States, reciting the allegations and suggestions of the said petition, and giving a short description of the said invention or discovery, and thereupon granting to the said petitioner, &c., *for a term not exceeding fourteen years*, the full and exclusive right and liberty of *making, constructing, using, and vending to others to be used* the said invention or discovery, &c." The third section provides: "That every inventor, before he can receive a patent, shall swear or affirm that he does verily believe that he is the true inventor or discoverer of the art, machine, or improvement for which he solicits a patent." The sixth section provides that the defendant shall be permitted to give in defense to any action brought against him for an infringement of the patent, among other things, "that the thing thus secured by patent was not originally discovered by the patentee, *but had been in use*, or had been described in some public work, *anterior to the supposed discovery of the patentee*."

These are the only material clauses bearing upon the question now before the court; and upon the construction of them there has been no inconsiderable diversity of opinion entertained among the profession, in cases heretofore litigated.

It is obvious, to the careful inquirer, that many of the provisions of

our Patent Act are derived from the principles and practice which have prevailed in the construction of that of England. It is doubtless true, as has been suggested at the bar, that where English statutes—such, for instance, as the statute of frauds and the statute of limitations—have been adopted into our own legislation, the known and settled construction of those statutes by courts of law has been considered as silently incorporated into the acts, or has been received with all the weight of authority. Strictly speaking, that is not the case in respect to the English statute of monopolies, which contains an exception on which the grants of patents for inventions have issued in that country. The language of that clause of the statute is not, as we shall presently see, identical with ours, but the construction of it adopted by the English courts, and the principles and practice which have long regulated the grants of their patents, as they must have been known and are tacitly referred to in some of the provisions of our own statute, afford materials to illustrate it.

By the very terms of the first section of our statute, the Secretary of State is authorized to grant a patent to any citizen applying for the same, who shall allege that he has invented a new and useful art, machine, &c., “*not known or used before the application.*” The authority is a limited one, and a party must bring himself within the terms before he can derive any title to demand or to hold a patent. What, then, is the true meaning of the words “*not known or used before the application*”? They cannot mean that the thing invented was not known or used before the application by the inventor himself, for that would be to prohibit him from the only means of obtaining a patent. The use as well as the knowledge of his invention must be indispensable, to enable him to ascertain its competency to the end proposed, as well as to perfect its component parts. The words, then, to have any rational interpretation, must mean, not known or used by others before the application. But how known or used? If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor himself, or if, before his application for a patent, his invention should be pirated by another, or used without his consent, it can scarcely be supposed that the legislature had within its contemplation such knowledge or use.

We think, then, the true meaning must be, not known or used by the public before the application. And, thus construed, there is much reason for the limitation thus imposed by the act. While one great object was, by holding out a reasonable reward to inventors and giving them an exclusive right to their inventions for a limited period, to stimulate the efforts of genius, the main object was “to

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promote the progress of science and useful arts"; and this could be done best by giving the public at large a right to make, construct, use, and vend the thing invented at as early a period as possible, having a due regard to the rights of the inventor. If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should, for a long period of years, retain the monopoly and make and sell his invention publicly, and thus gather the whole profits of it, relying upon his superior skill and knowledge of the structure, and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any farther use than what should be derived under it during his fourteen years—it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries.

A provision, therefore, that should withhold from an inventor the privilege of an exclusive right, unless he should, as early as he should allow the public use, put the public in possession of his secret and commence the running of the period that should limit that right, would not be deemed unreasonable. It might be expected to find a place in a wise prospective legislation on such a subject. If it was already found in the jurisprudence of the mother country, and had not been considered inconvenient there, it would not be unnatural that it should find a place in our own.

Now, in point of fact, the statute of 21 Jac., ch. 3, commonly called the statute of monopolies, does contain exactly such a provision. That act, after prohibiting monopolies generally, contains, in the sixth section, an exception in favor of "letters patent and grants of privileges for *fourteen years or under*, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which *others at the time of making such letters patent and grants shall not use*." Lord COKE, in his commentary upon this clause or proviso, (3 Inst., 184,) says that the letters patent "must be of such manufactures which *any other at the time of making such letters patent did not use*; for albeit it were newly invented, yet if any other did use it at the making of the letters patent or grant of the privilege, it is declared and enacted to be void by this act." The use here referred to has always been understood to be a public use, and not a private or surreptitious use in fraud of the inventor.

In the case of *Wood v. Zimmer*, 1 Holt's N. P. Rep., 58, this doctrine was fully recognized by Lord Chief Justice GIBBS. There the

inventor had suffered the thing invented to be sold, and go into public use for four months before the grant of his patent; and it was held by the court that, on this account, the patent was utterly void. Lord Chief Justice GIBBS said: "To entitle a man to a patent, the *invention* must be *new to the world*. The *public* sale of that which is afterwards made the subject of a patent, *though sold by the inventor only*, makes the patent void." By "*invention*," the learned judge undoubtedly meant, as the context abundantly shows, not the abstract discovery, but the *thing* invented; not the new secret principle, but the manufacture resulting from it.

The words of our statute are not identical with those of the statute of James, but it can scarcely admit of doubt that they must have been within the contemplation of those by whom it was framed, as well as the construction which had been put upon them by Lord COKE. But if there were no such illustrative comment, it is difficult to conceive how any other interpretation could fairly be put upon these words. We are not at liberty to reject words which are sensible in the place where they occur, merely because they may be thought in some cases to import a hardship, or tie up beneficial rights within very close limits. If an invention is used by the public, with the consent of the inventor, at the time of his application for a patent, how can the court say that his case is nevertheless such as the act was intended to protect? If such a public use is not a use within the meaning of the statute, what other use is? If it be a use within the meaning of the statute, how can the court extract the case from its operation and support a patent, where the suggestions of the patentee are not true, and the conditions on which alone the grant was authorized to be made do not exist? In such a case, if the court could perceive no reason for the restrictions, the will of the legislature must still be obeyed. It cannot and ought not to be disregarded where it plainly applies to the case. But if the restriction may be perceived to have a foundation in sound policy, and be an effectual means of accomplishing the legislative objects by bringing inventions early into public and unrestricted use, and, above all, if such policy has been avowed and acted upon in like cases in laws having similar objects, there is very urgent reason to suppose that the act in those terms embodies the real legislative intent, and ought to receive that construction. It is not wholly insignificant, in this point of view, that the first Patent Act passed by Congress on this subject, (act of 1790, ch. 34, [ch. 7,]) which the present act repeals, uses the words "*not known or used before*," without adding the words "*the application*," and, in connection with the structure of the sentence in which they

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stand, might have referred either to the time of the invention or of the application. The addition of the latter words in the Patent Act of 1793 must, therefore, have been introduced *ex industria*, and with the cautious intention to clear away a doubt and fix the original and deliberate meaning of the legislature.

The act of the 17th of April, 1800, ch. 25, which extends the privileges of the act of 1793 to inventors who are *aliens*, contains a proviso declaring "that every patent which shall be obtained pursuant to the act for any invention, art, or discovery *which, it shall afterwards appear, had been known or used previous to such application for a patent,* shall be void." This proviso certainly certifies the construction of the act of 1793 already asserted, for there is not any reason to suppose that the legislature intended to confer on *aliens* privileges essentially different from those belonging to *citizens*. On the contrary, the enacting clause of the act of 1800 purports to put both on the same footing, and the proviso seems added as a gloss or explanation of the original act.

The only real doubt which has arisen upon this exposition of the statute, has been created by the words of the sixth section already quoted. That section admits the party sued to give in his defense, as a bar, that "the thing thus secured by patent was not originally discovered by the patentee, but had been in use *anterior to the supposed discovery* of the patentee." It has been asked, if the legislature intended to bar the party from a patent in consequence of a mere prior use, although he was the inventor, why were not the words "*anterior to the application*" substituted, instead of "*anterior to the supposed discovery*"? If a mere use of the thing invented before the application were sufficient to bar the right, then, although the party may have been the first and true inventor, if another person, either innocently as a second inventor or piratically, were to use it without the knowledge of the first inventor, his right would be gone. In respect to a use by piracy, it is not clear that any such fraudulent use is within the intent of the statute, and upon general principles it might well be held excluded. In respect to the case of a second invention, it is questionable at least whether if, by such second invention, a public use was already acquired, it could be deemed a case within the protection of the act. If the public were already in possession and common use of an invention fairly and without fraud, there might be sound reason for presuming that the legislature did not intend to grant an exclusive right to any one to monopolize that which was already common. There would be no *quid pro quo*—no price for the exclusive right or monopoly conferred upon the inventor for fourteen years.

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Be this as it may, it is certain that the sixth section is not necessarily repugnant to the construction which the words of the first section require and justify. The sixth section certainly does not enumerate all the defenses which a party may make in a suit brought against him for violating a patent. One obvious omission is where he uses it under a license or grant from the inventor. The sixth section in the clause under consideration may well be deemed merely affirmative of what would be the result from the general principles of law applicable to other parts of the statute. It gives the right to the *first* and true inventor, and to him only; if known or used before his supposed discovery, he is not the *first*, although he may be a *true* inventor, and that is the case to which the clause looks. But it is not inconsistent with this doctrine, that although he is the *first* as well as the *true* inventor, yet if he shall put it into public use, or sell it for public use, before he applies for a patent, that this should furnish another bar to his claim. In this view, an interpretation is given to every clause of the statute, without introducing any inconsistency or interfering with the ordinary meaning of its language. No public policy is overlooked, and no injury can ordinarily occur to the first inventor, which is not in some sort the result of his own laches or voluntary inaction.

It is admitted that the subject is not wholly free from difficulties; but, upon most deliberate consideration, we are all of opinion that the true construction of the act is that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent. His voluntary act or acquiescence in the public sale and use is an abandonment of his right, or rather creates a disability to comply with the terms and conditions on which alone the Secretary of State is authorized to grant him a patent.

The opinion of the Circuit Court was therefore perfectly correct, and the judgment is affirmed with costs.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Pennsylvania, and was argued by counsel; on consideration whereof, it is the opinion of this court that there is no error in the judgment of the said Circuit Court. Whereupon it is considered, ordered, and adjudged by this court that the said judgment of the said Circuit Court in this cause be, and the same is hereby,

**AFFIRMED WITH COSTS.**

## Syllabus.

## JOSEPH GRANT ET AL V. E. &amp; H. RAYMOND.

(6 Peters, 218.)

1. Action for damages for an infringement of a patent-right granted to the plaintiff in 1825. The plaintiff recited that a former patent had been issued in 1821 to the same person, for the same improvement, "which had been cancelled, owing to the defective specification on which the same was granted." The exclusive privilege given by the patent on which the suit was brought is to continue fourteen years from the day on which the original was issued. On the trial, the defendants objected that the Secretary of State had no power, by law, to accept a surrender of and to cancel the first letters patent, or to inquire into and decide upon the causes for so doing; or to grant the second patent for the same invention with an amended specification, for the unexpired portion of the term of fourteen years which had been granted by the first patent. The Circuit Court of the Southern District of New York decided, in conformity with its former decisions, that such surrender might be made when the defect arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee; and that the Secretary of State had authority to accept such surrender, and cancel the record of the patent; and to issue a new patent for the unexpired part of the fourteen years granted under the first patent. By the court: It will not be pretended that this question is free from difficulty. But the executive departments, it is understood, have acted on the construction adopted by the Circuit Court, and have considered it as settled. We would not willingly disregard the settled practice in a case where we are not satisfied it is contrary to law, and where we are satisfied it is required by justice and good faith.
2. To promote the progress of useful arts is the interest and policy of every enlightened government. It entered into the views of the framers of our Constitution, and the power "to promote the progress of science and useful arts by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries," is among those expressly given to Congress. It is the reward stipulated for advantages derived by the public for the exertions of individuals, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought to be construed in the spirit in which they have been made, and to execute the contract fairly on the part of the United States, where the full benefit has been received—if this can be done without transcending the intentions of the statutes, or countenancing acts which are fraudulent or may prove mischievous.
3. If a mistake should be committed in the Department of State, no one would say it ought not be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued; and yet the law does not, in terms, authorize a new patent, even in such a case. Its emanation is not founded on the words of the law, but it is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken, for the same purpose, if the mistake has been innocently committed by the inventor himself?
4. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals; and the means it em-

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plays are the compensation made to those individuals for the time and labor devoted to those discoveries, by the exclusive right to make up and sell the things discovered for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error which are directed in the first instance, cannot be a departure from the spirit and character of the act.

5. *Quære*, What would be the effect of a second patent, issued after an innocent mistake in the specification, on those who, skilled in the art for which it was granted, perceiving the variance between the specifications and the machine, had constructed, sold, and used the machine? This question is not before the court, and is not involved in the opinion given in the case. The defense, when true in fact, may be sufficient in law, notwithstanding the validity of the new patent.
6. The defendant in the Circuit Court, in his plea, assigned the particular defect supposed to exist in the specification, and then proceeded to answer, in the very words of the act, "that it does not contain a written description of the plaintiff's invention and improvement, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, so as to enable any person skilled in the art to make and use the same." The plea alleged, in the words of the act, that the prerequisites to issuing a patent had not been complied with. The plaintiffs denied the facts alleged in the plea, and on this issue was joined. At the trial, the counsel for the defendants, after the evidence was closed, asked the court to instruct the jury, that if they should be of opinion that the defendants had maintained and proved the facts alleged in their plea, they must find for the defendants. The court refused this instruction, and instructed the jury that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, or for the purpose of deceiving the public. By the court: The instruction was erroneous, and the judgment of the Circuit Court ought to be reversed.
7. This instruction was material, if the verdict ought to have been for the defendants; provided the allegations of the plea were sustained, and if such verdict would have supported a judgment in their favor, although the defect in the specification might not have arisen from design and for the purpose of deceiving the public. That such is the law, the court is entirely satisfied. The third section of the act requires, as preliminary to a patent, a correct specification and description of the thing discovered. This is necessary, in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue a patent. The necessary consequences of the ministerial character in which the Secretary acts, is that the performance of the prerequisites to a patent must be examinable in any suit brought upon it. If the case was of the first impression, the court would come to this conclusion; but it is understood to be settled.
8. Courts did not, perhaps, at first, distinguish clearly between a defense which would authorize a verdict and judgment in favor of a defendant in an action for the violation of a patent, leaving the plaintiff free to use his patent and to bring other suits for its infringement, and one which, if successful, would require the court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled.
9. If the party is content with defending himself, he may either plead specially or plead the general issue, and give the notice required by the sixth section of



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any special matter he means to use at the trial. If he shows that the patentee has failed in any of those prerequisites on which the authority to issue the patent is made to depend, his defense is complete. He is entitled to the verdict of the jury and the judgment of the court. But if, not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity with the sixth section. If he depends on evidence "tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the desired effect," it may avail him so far as respects himself, but will not justify a judgment declaring the patent void, unless such "concealment or addition shall fully appear to have been made for the purpose of deceiving the public," which purpose must be found by the jury to justify a judgment of *vacatur*.

10. The defendant is permitted to proceed according to the sixth section, but is not prohibited from proceeding in the usual manner, so far as respects his defense, except that special matter may not be given in evidence on the general issue, unaccompanied by the notice which the sixth section requires. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only in the particular case and for the particular purpose stated in the sixth section.

THIS case came before the court, in the first instance, on a certificate of division in opinion in the Circuit Court of the United States for the Southern District of New York.

On inspecting the record, it appeared that on the trial of the cause in the Circuit Court the counsel for the defendants had excepted to the decisions of the court on various matters which had been presented for the consideration of the court, and that a bill of exceptions had been sealed by the court on their motion.

The record proceeded to state that the cause afterwards came on for argument on a motion for a new trial, when the opinions of the two judges of the Circuit Court were opposed upon questions presented for the decision of the court, excepted to on the trial, as stated in the bill of exceptions: "That upon the questions thus occurring before the court, the opinions of the said two judges were opposed; and, upon request of the counsel of the plaintiffs, the points upon which the disagreement happened were stated under the direction of the judges, and certified under the seal of the court to the Supreme Court."

*Mr. Webster* stated that a question, preliminary to the argument of the case, was presented for the decision of the court. It was, whether the court would entertain the case as it came up from the Circuit Court, on a division in that court on a motion for a new trial. This court had exercised their right to decide in cases where the opinions of the judges of the Circuit Court on questions of law had been opposed, when a motion for a new trial was before the court.

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Mr. Justice STORY. In the cases referred to, the division of the court took place on the trial of the cause before the jury, as well as on the motion for a new trial.

Mr. Chief Justice MARSHALL suggested that the case might be brought on if the parties would agree that it should stand as if a judgment had been given by the Circuit Court on the exceptions. The case, he said, could not be heard on a difference in opinion of the judges of the court on a motion for a new trial.

The counsel for the plaintiffs and defendants having agreed that the case should stand as suggested by the Chief Justice, and an agreement in writing to that effect having been filed, the court made the following order:

It is now here by the court considered and ordered, that this cause shall now be heard and decided, as on a writ of error brought after verdict and judgment in the Circuit Court, on the exceptions which were taken in that court; that the cause shall now proceed, as if judgment had been actually entered in the Circuit Court for the plaintiffs there, and that the certificate in the case shall be taken, regarded, and treated as a writ of error sued out by the defendants below, on the judgment of the Circuit Court, and that the question shall be, as in other cases, whether the said judgment ought to be reversed or affirmed; but that this court will reserve its opinion and judgment in this cause till the defendants in the court below shall have sued out a writ of error in this cause to the said Circuit Court, and filed a return thereto, with a bill of exceptions in this cause, in the usual form, signed by the court below, in this court.

The case came on for argument after the defendants had sued out a writ of error on a judgment entered in the Circuit Court for the plaintiffs, in conformity with the suggestion and order of this court. The case was as follows:

The action was brought to recover damages for an alleged infringement of a patent-right, and came on for trial in the Circuit Court in November, 1828, when a verdict was rendered for the plaintiffs for three thousand two hundred and sixty-six dollars sixty-six cents.

The plaintiffs gave in evidence a patent from the United States, in the following terms, the same being the patent declared upon:

“Whereas Joseph Grant, a citizen of the United States, hath alleged that he hath invented a new and useful improvement in the mode of manufacturing hat-bodies by the combination of motions,

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namely, the rotary and revolving motion, with the vibrating or transverse motion, which forms the two hat-bodies by machinery, and crosses the wool from one extremity of the hat-bodies to the other at one operation, called Grant's improved winding machine for setting up hat-bodies,—his former patent for the same invention, dated the 11th day of August, 1821, having been cancelled, owing to the defective specification on which the same was granted, which improvement he states had not been known or used before his application,—hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement, hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose:

“These are, therefore, to grant, according to law, to the said Joseph Grant, his heirs, administrators, or assigns, for the term of fourteen years from the 11th day of August, 1821, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said Joseph Grant himself, in the schedule hereto annexed, and is made a part of these presents.

“In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed. Given under my hand, at the city of Washington, this 28th day of April, in the year of our Lord 1825, and of the independence of the United States of America the forty-ninth.

[L. S.]

“J. Q. ADAMS.

“By the President. H. CLAY, *Secretary of State*.”

City of Washington, to wit: I do hereby certify that the foregoing letters patent were delivered to me on the 28th day of April, in the year of our Lord 1825, to be examined; that I have examined the same and find them conformable to law, and I do hereby return the same to the Secretary of State within fifteen days from the date aforesaid, to wit, on this 28th day of April, in the year aforesaid.

WILLIAM WIRT,

*Attorney-General of the U. S.*

The schedule referred to in these letters patent, and making part of the same, contained a description, in the words of the said Joseph Grant himself, of his improvement in the mode of manufacturing hat-bodies by the combination of motions, namely, the rotary or revolving motion, with the vibrating or transverse motion, which forms the

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two hat-bodies by machinery, and crosses the wool from one extremity of the hat-bodies to the other at one operation, called Grant's improved winding machine for setting up hat-bodies, his former patent for the same invention, dated the 11th day of August, A. D. 1821, having been cancelled, owing to the defective specification on which the same was granted.

The schedule, which contained a full description of the invention, and of the mode of using it, was also given in evidence.

The counsel for the plaintiffs also produced and read in evidence a certificate of the Secretary of State, duly authenticated under his hand and official seal, and certain papers thereto annexed, in the words and figures following:

"To all to whom these presents shall come, greeting:

"I certify that the annexed is a true copy of the record of cancellation of a patent granted to Joseph Grant on the 11th of August, 1821, and cancelled on the 28th of April, A. D. 1825; also, that the annexed is a true copy of the petition praying for the cancellation, and the issuing of another patent for the same invention.

"In testimony whereof, I, Henry Clay, Secretary of State of the United States, have hereunto subscribed my name, and caused the seal of the Department of State to be affixed. Done at the city of Washington, this 19th day of May, A. D. 1828, and of the independence of the United States of America the fifty-second.

[L. S.]

"H. CLAY."

This patent was returned to the Patent Office, the seal broken, and now stands cancelled, owing to the defective specification on which it was issued, and another patent granted (with a corrected specification) on the 28th day of April, 1825, bearing date with the first, and for the same invention.

The petition of Joseph Grant, of Providence, in the county of Providence and State of Rhode Island, hatter, a citizen of the United States of America, respectfully represents, that your petitioner has invented a new and useful improvement in the mode of manufacturing hat-bodies by the combination of motions, namely, the rotary or revolving motion, with the vibrating or transverse motion, which forms the two hat-bodies by machinery, and crosses the wool from one extremity of the hat-bodies to the other at one operation, called "Grant's improved winding machine for setting up hat-bodies," according to the specification, explanations, and drawings, herewith presented, which the subscriber prays may be taken as a part of his petition—an improvement not used or known before his application,

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the advantages of which your petitioner is desirous of securing to himself and his legal representatives.

Your petitioner would further state, that he has heretofore, namely, on the 11th day of August, A. D. 1821, obtained letters patent from the President of the United States for his said improvement, but, owing to a defective specification on which the same were granted, he prays that the said patent may be cancelled, and a new and correct one granted, embracing the same improvements, so far as the same are set forth in the accompanying specification, drawing, and explanations. Your petitioner therefore prays that letters patent of the United States may be issued, granting to your petitioner, his heirs, administrators, or assigns, the full and exclusive right of making, constructing, using, and vending to others to be used his said improvement, according to the specification and drawings hereto annexed, agreeably to the act of Congress in such case made and provided, your petitioner having paid thirty dollars into the treasury of the United States, and complied with other provisions of the said act. As in duty bound, will ever pray.

JOSEPH GRANT.

To the Hon. Henry Clay, Secretary of State of the United States of America.

*Providence, April 20, 1825.*

As the assignee of David Curtis, who was the assignee of Joseph Grant, of one moiety of the original patent, I unite in the prayer of the above petitioner, that the original patent may be cancelled, and a new one granted to the said Joseph Grant, as above set forth.

SOLOMON TOWNSEND.

To the Hon. Henry Clay, Secretary of State of the United States of America.

*Providence, April 20, 1825.*

The counsel for the defendant objected that the Secretary of State had no power, by law, to accept a surrender of and to cancel said letters patent, or to inquire into or decide upon the causes for so doing, or to grant said second patent for the same invention, with an amended specification, for the unexpired portion of the term of fourteen years which had been granted by the first patent.

The court decided that such surrender might be made, when the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee; and that the Secretary of State had authority to accept such surrender, and cancel the record of the patent, and to issue a new patent for the unexpired part of the fourteen years granted under the old patent, in

manner aforesaid. To which decision the counsel for the defendant excepted.

The fourth plea, filed on the part of the defendant, after reciting the specification annexed to the patent of the plaintiffs, averred as follows: "And the defendants aver that said specification does not correctly or accurately describe the improvement claimed by the said Joseph Grant as his invention; but said specification, and the drawings thereto annexed, are altogether defective in this, among other things, namely: in said specification no proportions, sizes, or distances are given, and the bigness or size of none of the principal parts of said machine is given in said specification or drawings, but the same is wholly omitted; and, in other particulars, said specification and drawings are altogether defective. And the defendants aver that said specification, annexed to and making part of said letters patent, with the drawings thereto annexed, do not contain a written description of his, the said Joseph Grant's, invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art of which said machine or improvement is a branch, or with which it is most nearly connected, to make and use the same; and that, for the cause aforesaid, said letters patent are void. All which the defendants are ready to verify; wherefore they pray judgment if the said Joseph Grant and Solomon Townsend ought to have or maintain their aforesaid action against them, and for their costs." To which plea the following replication was filed:

"And as to the plea of the said Eliakim Raymond and Henry Raymond, by them fourthly above pleaded, the said Joseph Grant and Solomon Townsend say that, by reason of anything in the said last-mentioned plea alleged, they ought not to be barred from having and maintaining their aforesaid action thereof against them, the said Eliakim Raymond and Henry Raymond, because they say that the specification mentioned in the said last-mentioned plea does correctly and accurately describe the improvement claimed by the said Joseph Grant as his invention; and because they say, further, that neither the said specification nor the drawings thereto annexed are defective in any of the particulars in that behalf alleged in the said last-mentioned plea; and this they, the said Joseph Grant and Solomon Townsend, pray may be inquired of by the country, and the said Eliakim Raymond and Henry Raymond do the like," &c.

The counsel for the defendants on the said trial introduced sundry witnesses to prove the allegations traversed in the said fourth plea,

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Argument for the plaintiffs in error.

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and insisted that they had proved the same, and that the said specification of the said Joseph Grant did not describe the improvement which he claimed to have invented in such full, clear, and exact terms as to distinguish the same from all other things before known, nor so as to enable a person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make and use the same; and they requested the court to charge the jury, that if they found that the defendants had maintained and proved their averments in that respect, that they must find the same for the defendants—which instructions the court refused to give; but instructed the jury that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public—to which opinion the counsel for the defendants also excepted.

The case was argued by *Mr. Webster*, for the defendants in the Circuit Court, now before the court as plaintiffs in error; and by *Mr. Ogden*, for the defendants, plaintiffs in the Circuit Court.

*Mr. Webster* stated that the first question for the decision of the court was, whether the Secretary of State can accept the surrender of a patent, cancel it, and grant a new one for the unexpired term for which a patent had been granted, on a suggestion that the specification is defective through inadvertence or mistake?

It cannot but be doubted whether such cancellation can be made anywhere, so as to take out a new patent.

The whole system of patents rests on statute provision. There is no common-law power, or prerogative right, in the President to issue a patent. In this particular, our law is different from the English. *Ours* is a statute grant; theirs is an emanation out of a statute prohibition. With us, the fountain is statute; with them, *prerogative*. Our statute makes no provision for any surrender, and the issuing of a new patent thereon. Indeed, it seems impossible to reconcile such a proceeding to the requisitions of the act.

How can the patentee allege, or assign for his second patent, that *his improvement had not been known before that application*? That is a statute requisition. Here, in the case before the court, it had been in use three years. The party must claim, and in this case does claim, under his second patent, as a new and substantive patent; not under his first, with an amended specification.

On surrender or cancellation of the patent, the party comes for a new patent for the same invention. Now, in all such cases, it must be that the thing has been used or known before that application.

In this very case, it does not appear that his petition contained the *statute requisites*. It refers it to *his former application*.

But however this may be, the Secretary of State has no authority to make a record of cancellation, and to issue a new patent. The Secretary of State is a merely ministerial officer. All the laws relating to granting patents regard him as merely ministerial. His department is denominated an executive department. He has nowhere any particle of judicial power. On the subject of patents, as well as all others, he acts wholly ministerially.

By the first Patent Law, April 10, 1790, the Secretaries of State, War, and Attorney-General were invested with authority to grant or refuse patents. But this was repealed by the existing law of February 21, 1793. The power of granting or withholding patents was by this act taken away from everybody. The Secretary was to give the patent out, on certain requisitions being complied with, without exercising any judgment, or making any inquiry; and the patent was to avail the grantee what it might, according to the truth of the representations of the patentee. It is matter of right and matter of course to issue the patent if the requisites of the law be complied with. The Secretary has nothing to do but make out the patent.

He is applied to as keeper of the seal. And if a dispute arises between inventors, the Secretary cannot decide it; he is to appoint umpires. Section 9. He is not trusted to decide even whether the *form* of the letters patent be conformable to law; that belongs to the Attorney-General.

The general power of the Secretary is commented on in *Marbury v. Madison*, 1 Cranch, 159, 160. He is to record diplomatic transactions; but he cannot alter or cancel those records. He records treaties and acts of Congress; but those, of course, he cannot alter.

The Secretary has no power to record in his office any transaction not his own, except so far as authorized by statute.

In regard to patents, the statute declares what shall be recorded: 1. The patent itself. 2. The assignment of it, if requested. These are all. The Secretary has nothing more to do. As to cancelling a patent, he is *functus officio*.

The breaking the seal, or other cancellation by the patentee of his patent, is just as effectual if done anywhere else as if done at the State Department. It is not a transaction which the law has prescribed for recording anywhere. He can neither authorize this cancellation nor forbid it, nor make it matter of official record.

The vacating and cancelling the record of a patent is in its nature a judicial act. The act of 1793 treats it as such, and provides two



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*modes of such vacation.* Cited the sixth and tenth sections of the act.

The common law, also, provides a mode. *The court cannot add a new section to the act.*

In England, the repealing of patents is always regarded as a judicial act. Godson on Patents, 200.

The limitations under which the court below thought the Secretary could vacate one patent and issue another, show that the power he is expected to exercise is judicial. The defect must arise from inadvertence or mistake, without fraud or misconduct. The power of the Secretary to act, then, depends upon his having adjudged the case to be one of mistake, and not a case of fraud. This is judicial power. How can the Secretary make this judicial investigation?

1. He has no parties before him, and no power to bring persons before him. When done in court, this is done in the presence of *litigant parties*. 2. He cannot summon witnesses before him, and if they should come voluntarily, he cannot administer an oath to them. Such oaths would be extra-judicial and nugatory. He cannot require the party's own oath.

Now, whether the want of a proper specification be the effect of accident or of fraud, is a question of fact; and it is to be decided by the Secretary, without parties, oaths, or witnesses.

Besides, the surrender is to be accepted only when the specification is defective. Is not that very question a question of fact, or a mixed question of law and fact? Certainly it is. It is for the jury. Even a court cannot determine it without a jury.

By act of April 20, 1818, the Secretary of State appoints a *superintendent*. Does he delegate to him his judicial power?

There is but one way of answering this view of the subject. It must be contended, that in every case, on the mere suggestion of the patentee, a new patent is to be issued for the residue of the term, with an amended specification—leaving it to be decided, when suit should be brought, whether the defect was inadvertent or fraudulent.

This would change the whole patent system. Its effects would be monstrous. Patentees would try their claims under one specification; they might fail; and they would call it *inadvertence*, and try another experiment.

A man builds an expensive factory, puts in costly machinery, not patented, not described in any specification; he expends much money; by-and-by he is sued for violating a patent, and he finds that since he built, an old patent has come out with a new specification. A hearing, of which he knew nothing, has been had before the Secre-

tary, and a new patent has issued, and he is called on to stop his factory. Now, this supposed case is the very case before the court. The defendants erected their works in 1823, 1824. They knew of the plaintiff's patent of August 11, 1821, but it did not describe any machinery used by them. But in 1825 he surrendered his first patent, took out another, with a specification *describing their machinery*, and sued them. Under the direction of the court, he has recovered a verdict for three thousand two hundred and sixty-six dollars, and is entitled, of course, to have this *trebled*, and the defendants are ruined. *Is this legal?* A bill in equity is pending, also, to stop the defendants' factory.

Now, what reason is there for saying that defendants shall suffer these losses, even by the mistake or inadvertence of the patentee? The invention had become public, and, if not protected by the first patent, it was gone forever. A bad patent is no patent. 1 Barn. & Ald., 386. It may be well for Congress to give the courts or judges power to vacate patents on patentee's own motion; but then Congress would provide limitations and securities for innocent persons. On the doctrine of this case, there are no securities.

What are the consequences of such a principle? A man finds out that there are other machines made like his, which he would like to stop; he sets up inadvertence, gets a new patent, and stops them. *If he swears it, who can deny it? It is of younger date, and he swears he meant to describe it.* This would furnish irresistible temptation to perjury.

There is a deeper objection. A man makes an invention; he gets a patent; but his specification does not describe it, but describes something else. In the meantime, the public use, not what he has patented, but what he has not. Now, how is the public to be deprived of the use of this? It is denied that they can be prevented this use. The decision of this court, in *Pennock v. Dialogue*, proves this cannot be. The invention was used and known before it was patented. A patent not describing an invention is void as to that invention, and does not protect it. The invention, by a single month's use, unprotected by a patent, becomes public property and can never be resumed.

Whether the patent be void through fraud or inadvertence, if it does not describe the invention, then the invention is not protected, but *has become public property*. *Pennock v. Dialogue* so decides.

In England, a *scire facias* to repeal a patent is a criminal proceeding, and does not allow costs. 7 Term Rep., 367; Godson, 201.

This case was tried, in New York, before *Pennock v. Dialogue* was decided in this court.

The only case applicable to the one now before the court is *Morris v. Huntington*, 1 Paine, 348. That was decided in 1824. Its doctrine was materially changed by *Pennock v. Dialogue*. After all, that case only decides that a patent, while another is in existence, is void. The judge then goes on to say it may be surrendered.

It seems admitted that the new patent ought not to reach back so as to affect those who had already used the invention. But how can this distinction be made? Cited to this point, *Brooke v. Clarke*, 1 B. & A., 396, note.

The great and conclusive objection is this: the new patent is granted on the new application, and the invention had been public four years. This is fully settled in the case of *Pennock v. Dialogue*.

The second point is presented on the defendants' fourth plea. The court instructed the jury that the patent would not be void, unless the defective or imperfect specification arose from design or the purpose of deceiving the public.

This point presents two questions:

1. Whether the patent would be void or not for the reasons stated, the direction of the court was not pertinent to the issue. The parties were at issue on a question of fact; witnesses were examined, and counsel had summed up; but the court told the jury the issue was *immaterial*, and under this question the jury found a verdict for plaintiff.

It can require no argument to prove that this is an illegal direction. 2 Day's Reports, 519; 1 Starkie, 388; 9 Cranch, 339, 355.

2. If the question had legally arisen, the law was wrongly stated.

It is insisted that the plea was a good bar. If the specification was defective, as set forth in the plea, the plaintiff could not recover, whether that defect arose from accident or design. The very words of the third section of the statute require this. There are certain conditions precedent to be complied with *before an inventor can obtain a patent*. This is one of them. The language of this section is emphatic and absolute; it could not be stronger. Courts may just as well *dispense with the oath*.

Suppose he omit to deliver any written specification whatever, can he afterwards say that omission was owing to inadvertence? *Yet a defective specification, or bad specification, is no specification*. The same law that requires a written specification, requires a *full and accurate one*. A defective one is no better than none at all. Suppose he omit to sign the specification, can that be cured?

A party is to describe his invention so as to answer two purposes:

1. To distinguish it from all other things before known. 2. To

enable any person skilled in the art to make and use it. If he fail in either of these, he fails in a condition precedent.

This is all very clear, and there would be no doubt about it but for the sixth section. That section has been supposed to raise the doubt.

This section, as has been observed by most judges, is inartfully drawn. It speaks of the right of the defendant to *give this act in evidence in an action founded on the act itself*. It is not grammatical. It seems borrowed from the law of 1791.

The first important remark is, that the preceding sections have described the whole extent of the patentee's right. This section has for its object the giving of immunities and protection to those who may be sued by patentees. Therefore, its object was not to enlarge the right of patentees. Second, most of its provisions are only affirmative, and the right existed before. The action being case, all the material defenses are competent. Third, it gives some matters as a defense not mentioned in the first act, such as license or abandonment to the public. Fourth, it does not repeat *the same* objections to specification.

It allows the defendant to prove three things as fatal defects in his specification: 1. That it does not contain the whole truth relative to the discovery, with intent to deceive the public. This provision may stand with the first section. 2. That it contains more than is necessary to produce the described effect, with intent to deceive the public. This may stand with the third section. 3. That the thing had been used or described in a public work. This may also stand.

Now, the fraudulent intent is applied only to the first two. In these cases Congress may say that fraud shall be proved, because, even with these defects, it may be a patent, and a very useful patent.

It may be a valid patent, though the patentee take it but for part of his invention; yet if he fraudulently deceive the public, by keeping back part, it shall be void. So it may be a good and valuable patent, though it contain more than is necessary to produce the described effect. But if it be not so described as to be distinguished from other things before known, or so that skillful persons can use it, it is *no patent*, or *of no use at all*. These last objections go to its very existence, and are therefore made prerequisites. They are absolute conditions precedent.

But the main consideration yet is, that this sixth section has an object of its own. It looks not so much to the defense in its suits *as to the judicial vacation of the patent*. It does not look mainly to the defense of the suits, because it leaves out several known grounds of defense: 1. License. 2. Abandonment to the public. 3. That the

patent is broader than the invention. 4. That the machine is not well described. All these are defenses, and yet not mentioned here.

The object of the sixth section is, like that of the tenth, *to repeal for fraud proved*. All this may stand without contradicting the third section, or doing violence to its language.

Indeed, *Pennock v. Dialogue*, 2 Peters, 1, has apparently decided this. The sixth section speaks of inventions *known before the patentee's discovery*. This does not contradict the third section—“*known before application*.” The court has settled this, and it decides this case.

The plaintiff relied below on the following cases: *Park v. Little and Wood*, 3 Washington, 196, in April, 1813; *Gray et al. v. James*, 1 Peters, 401, 1817.

But it does not appear in this case whether the defendant was or was not proceeding with a view to vacate the patent. Most probably he was; for at that time such was the practice. This is rendered still more probable by a decision looking the other way, in 1820, by the same judge. *Kneass v. Schuylkill Bank*, 4 Wash. C. C. Rep., 13. *This case is clearly for the plaintiffs in error.*

The case of *Whittemore v. Cutter*, 1 Gallis., 419, decided in May, 1813, was probably a case to *vacate*; at any rate, the judges doubted, and would have divided if the case had turned on this point. The case of *Lowell v. Lewis*, 1 Mason, 193, in 1817, was probably a similar case; page 189 cited particularly.

How can the court dispense with the express words of the third section? Here they are put in the form of a *special plea*. *Can they be disregarded?* Suppose there be but one witness, though this is merely a *formal* requisite, can the court dispense with it?

Besides, why should the statute require a specification, unless *it was to be full and accurate?* For what purpose should an insufficient *specification be enjoined?* The court may as well say *there shall be none*. The statute says as imperatively what the specification shall contain, as that there shall be a specification at all. If an imperfect or defective specification does not render a patent void, *what harm does it do to it?* Let this question be answered.

Now, the patentee says his specification, in 1821, was *defective* not through fraud, but *defective*. But why was not that patent good, or this? If defective through fraud, he could not get another. It must be presumed to be defective through *inadvertence*. If so, what need of a new one?

Compare the two rules of law decided in this case together:

1. The judge held, that a party might surrender his patent and take a new one, when the specification in the first was defective through

mistake, and without fraud. 2. The court ruled, that though a specification be altogether defective, yet the patent is not void, unless such defect arise from design.

How can these things stand together? If the last proposition be true, all inquiry about the first is idle—unless the question be, whether a man having one good patent may surrender it and take out another good one for the same thing.

It is now matter of settled law, that if a patent be broader than the invention, it is void; and it is never inquired whether this arise from design or accident. In nine times out of ten, it arises from inadvertence. Now, on what principle is this? Not because the plaintiff's *invention* has not been invaded. It may have been exactly copied. It is because he has not rightly described what he *claimed*, and therefore his patent protects him in nothing. So, if a patent be for an improvement of an old machine, it must state the improvement accurately, and distinguish between what is old and what new. Finally, the English statute has always been construed the other way. Our sixth section is a substitute for the English *scire facias*.

Cited Davis's Patent Cases, 413; Godson, 124; Holroyd, 100, note. Cited, also, Dodson's Patents, 56; 1 Term Rep., 605; 1 Wash. C. C. Rep., 71; 3 Wash. C. C. Rep., 198; 1 Mason, 189, 190; 4 Ibid., 9, 10; 3 Wheat., 518; 2 Hen. Black., 478; 1 Ves. and Beames, 67; 8 Term Rep., 101; 2 Car. and Paine, 558, 565; 11 East, 107; 14 Ves., 131.

*Mr. Ogden, for the defendants in error.*

The first question is, whether the Secretary of State of the United States has a power by law to accept of the surrender of and to cancel a patent which had once been issued, and to grant a second patent for the same invention, with an amended specification, for the unexpired portion of the term of fourteen years which had been granted by the first patent?

Upon this question, there is not known a single case where the point has been expressly decided in the United States. The Patent Law is silent upon the subject; and the question must, then, be decided upon general principles.

A patent for a useful machine is a grant of the exclusive privilege of making and using the machine for a limited time. Now, it would seem that a *grantee* may surrender his grant. A man who has a privilege may *surrender* that privilege. If a man cancels his patent upon record, it amounts to a surrender of it.

The difficulty in question, if there be any, must be in the other branch of it. Has the Secretary of State the power, after the sur-

render of one patent, to grant a new one for the same invention, with an amended specification for the unexpired portion of the term of fourteen years which had been granted by the first patent? Why should he not? When the first patent is cancelled, the invention is unprotected. If a useful one, why should not the inventor have the benefit of it?

He certainly never intended to abandon the benefit of it to the public. His first patent is evidence of that.

A specification requires to be drawn with great accuracy. Mechanics, by whom machines are usually invented, it cannot be supposed are capable of drawing a proper specification. Can it be supposed that the law ever intended to punish their ignorance, in drawing a very special legal paper, by a forfeiture of all the advantages of their invention?

It is apprehended that the issuing a new patent in England, where there has been no sufficient specification to comply with the condition of the first patent, is pretty much a matter of course.

In the case *Ex parte Beck*, 1 Bro. Ch. Rep., 575, the Lord Chancellor says "that, perhaps, upon the petitioner's applying for a new patent, the officers might, under these circumstances, be induced to remit their fees, but that he could give no relief upon the present petition." Here the Lord Chancellor speaks of the issuing of a new patent as a matter of course.

In our Patent Law, the inventor must file his specification before he can procure his patent. In England, the patent contains upon its face a condition that if the patentee shall not make and file a specification within a limited time *after* the date of the patent, then the patent, and all the liberties and advantages under it, shall cease and be void.

One of the cases cited by the plaintiff in error shows that if the specification is not filed within the time mentioned in the patent, although the patent is void, a new one may be taken out by the inventor for the same invention.

This case, in principle, seems to support the proposition for which the defendant in error contends: that if a first patent is void for want of a specification, or for want of a sufficient specification, a new one may be issued for the same invention to the same inventor. In the case of *Morris v. Huntington*, 1 Paine's Rep. of Cases in the Second Circuit, 355, Mr. Justice Thompson says:

"I see no insuperable objection to entering a *vacatur* of the patent of record in the Department of State, if taken out inadvertently or by mistake. All the proceedings in that department on the subject

of patents are *ex parte*, except in the case of interfering applications. The department acts rather ministerially than judicially, and upon the representation of the applicant, without entering into an examination of the question of right; and there seems to be no good reason why, on a like *ex parte* application, the patent may not be surrendered and cancelled of record, if no misconduct be imputable to the patentee in taking it out." Cited, also, page 356.

So far, then, as this question has ever arisen in any of our courts, the right to surrender an old patent and procure a new one has been recognized. Cited, also, *Barrett et al. v. Hall*, 1 Mason, 475, as to the second point.

The second point is settled by the express terms of the Patent Law, and by the adjudications which have taken place under it.

1. By the express terms of the Patent Law.

The sixth section of the Patent Act declares "that the defendant shall be permitted to plead the general issue, and give this act and any special matter in evidence, of which notice in writing must have been given, &c., thirty days before the trial, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to the discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public," &c., &c.

So, therefore, if the specification does not contain the whole truth relative to the discovery, or if it contains more than is necessary to produce the described effect, the patent shall not, for these causes, or either of them, be evidence, unless "the concealment or addition shall fully appear to have been made for the purpose of deceiving the public."

2. By the adjudications which have taken place under the law.

The first case in which the question came up, was the case of *Whitney v. Carter*, in the Circuit Court of Georgia. That case is cited in Mr. Fessenden's *Essay on the Law of Patents*, 123.

His honor, Judge JOHNSON, in charging the jury in that case, said "he considered the defendants' second objection equally unsupported, and referred to the sixth section of the Patent Law, by which it is required that the concealment alleged (in order to defeat the patentee's recovery) must appear to have been made for the purpose of deceiving the public. That Mr. Whitney could have no motive for such concealment," &c., &c.

In the case of *Gray & Osgood v. James et al.*, 1 Peters's C. C. Rep., 394, this question came up before the Circuit Court in Pennsylvania,



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Judge WASHINGTON says: "But if the jury should be of opinion that the specification is materially defective, the objection will not be sufficient to invalidate the plaintiff's patent, unless they should also be satisfied that the concealment of the circumstances not described was intended to deceive the public."

In the case of *Whittemore v Cutter*, 1 Gallis., 429, Mr. Justice STORY says: "Any defect or concealment in a specification, to avoid a patent, must arise from an intention to deceive the public." In the case of *Lowell v. Lewis*, 1 Mason, 189, the same learned judge makes a similar declaration.

Mr. Chief Justice MARSHALL delivered the opinion of the court.

This action was brought by Grant & Townsend against E. & H. Raymond, to recover damages for an infringement of their right under a patent granted to the plaintiff, Joseph Grant, in April, 1825. It recited that a former patent had been issued in August, 1821, to the same person for the same improvement, "which had been cancelled, owing to the defective specification on which the same was granted." The exclusive privilege given by the patent, on which the suit is brought, is to continue fourteen years from the day on which the original was issued.

One of the pleas filed by the defendants contained the following averment: "And the defendants aver that the said specification does not correctly or accurately describe the improvement claimed by the said Joseph Grant as his invention; but said specification, and the drawings thereto annexed, are altogether defective in this, among other things, namely: in said specification no proportion, sizes, or distances are given, and the bigness or size of none of the principal parts of said machine is given in said specification or drawings, but the same is wholly omitted; and, in other particulars, said specifications and drawings are wholly defective. And the defendants aver that said specification, annexed to and making part of said letters patent, with the drawings thereto annexed, do not contain a written description of his, the said Joseph Grant's, invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art of which said machine or improvement is a branch, or with which it is most nearly connected, to make and use the same; and that, for the cause aforesaid, said letters patent are void."

The plaintiffs reply that they ought not to be barred, "because they say that the specification mentioned in the said last-mentioned

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plea does correctly and accurately describe the improvement claimed by the said Joseph Grant as his invention; and because they say, further, that neither the said specification nor the drawings thereto annexed are defective in any of the particulars in that behalf alleged in the said last-mentioned plea, and this, they pray, may be inquired of by the country." On this replication issue was joined.

At the trial, the counsel for the defendants objected that the Secretary of State had no power, by law, to accept a surrender of and to cancel the said letters patent, or to inquire into or decide upon the causes for so doing, or to grant said second patent for the same invention, with an amended specification, for the unexpired portion of the term of fourteen years which had been granted by the first patent.

The court decided that such surrender might be made when the defect arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee; and that the Secretary of State had authority to accept such surrender, and cancel the record of the patent, and to issue a new patent for the unexpired part of the fourteen years granted under the old patent, in manner aforesaid. To which decision the counsel for the defendants excepted.

After adducing the testimony on which they relied to support their plea hereinbefore stated, the counsel for the defendant moved the court to instruct the jury, that if they found that the defendants had maintained and proved their averments in that respect, that they must find the same for the defendants—which instructions the court refused to give; but instructed the jury that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public—to which opinion the counsel for the defendants also excepted.

The jury found a verdict for the plaintiffs, and assessed their damages to three thousand two hundred and sixty-six dollars sixty-six cents, the judgment on which is brought before this court by a writ of error.

The first question in the cause respects the power of the Secretary of State to receive a surrender of a patent, cancel the record thereof, and issue a new patent for the unexpired part of the fourteen years for which the original had been granted. The court was of opinion that this might be done "when the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee."

The right of the patentee to surrender his patent has not been denied, but the plaintiffs in error insist that no power exists to grant a

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new patent for the unexpired term. The words of the act, they say, do not confer this power. It cannot be exercised with its necessary guards by the Department of State, and inconvenience of no inconsiderable magnitude might result to the public from its exercise. The Secretary of State is, in the act of making out patents, a mere ministerial officer, and can exercise no power which is not expressly given.

It is undoubtedly true that the Secretary of State may be considered, in issuing patents, as a ministerial officer. If the prerequisites of the law be complied with, he can exercise no judgment on the question whether the patent shall be issued. It is equally true that the act of Congress contains no words which expressly authorize the Secretary to issue a corrected patent, if the original, from some mistake or inadvertence in the patentee, should be found incompetent to secure the reward which the law intended to confer on him for his invention. The force of this objection, and of the argument founded on it, is felt. If the new patent can be sustained, it must be on the general spirit and object of the law,—not on its letter.

To promote the progress of useful arts, is the interest and policy of every enlightened government. It entered into the views of the framers of our Constitution, and the power “to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries,” is among those expressly given to Congress. This subject was among the first which followed the organization of our government. It was taken up by the first Congress at its second session, and an act was passed authorizing a patent to be issued to the inventor of any useful art, &c., on his petition, “granting to such petitioner, his heirs, administrators, or assigns, for any term not exceeding fourteen years, the sole and exclusive right and liberty of making, using, and vending to others to be used the said invention or discovery.” The law farther declares that the patent “shall be good and available to the grantee or grantees, by force of this act, to all and every intent and purpose herein contained.” The amendatory act, of 1793, contains the same language, and it cannot be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws which are passed to give effect to this purpose ought, we think, to be construed in the spirit in which they have been made, and to execute the

contract fairly on the part of the United States, where the full benefit has been actually received,—if this can be done without transcending the intention of the statute, or countenancing acts which are fraudulent or may prove mischievous. The public yields nothing which it has not agreed to yield ;—it receives all which it has contracted to receive. The full benefit of the discovery, after its enjoyment by the discoverer for fourteen years, is preserved ; and for his exclusive enjoyment of it during that time the public faith is pledged. That sense of justice and of right which all feel pleads strongly against depriving the inventor of the compensation thus solemnly promised, because he has committed an inadvertent or innocent mistake.

If the mistake should be committed in the Department of State, no one would say that it ought not to be corrected. All would admit that a new patent, correcting the error, and which would secure to the patentee the benefits which the law intended to secure, ought to be issued. And yet the act does not in terms authorize a new patent, even in this case. Its emanation is not founded on the words of the law, but is indispensably necessary to the faithful execution of the solemn promise made by the United States. Why should not the same step be taken, for the same purpose, if the mistake has been innocently committed by the inventor himself ?

The counsel for the plaintiffs in error have shown very clearly that the question of inadvertence or mistake is a judicial question, which cannot be decided by the Secretary of State. Neither can he decide those judicial questions on which the validity of the first patent depends. Yet he issues it without inquiring into them. Why may he not, in like manner, issue the second patent also ? The correct performance of all those preliminaries on which the validity of the original depends are always examinable in the court in which a suit for its violation shall be brought. Why may not those points on which the validity of the amended patent depends be examined before the same tribunal ? In the case under consideration, those questions were not supposed by the Circuit Court to have been decided in the Department of State, but were expressly submitted to the jury. The rightfulness of issuing the new patent is declared to depend on the fact that “the defect in the specification arose from inadvertence or mistake, and without any fraud or misconduct on the part of the patentee.” The jury were, of course, to inquire into the fact. The condition on which the right to issue the patent depended, could be stated to them for no other purpose.

It has been said that this permission to issue a new patent on a reformed specification, when the first was defective through the mis-

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take of the patentee, would change the whole character of the act of Congress.

We are not convinced of this. The great object and intention of the act is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell the things discovered for a limited time. That which gives complete effect to this object and intention, by employing the same means for the correction of inadvertent error which are directed in the first instance, cannot, we think, be a departure from the spirit and character of the act.

An objection much relied on is, that after the invention has been brought into general use, those skilled in the art or science with which it is connected, perceiving the variance between the specification and the machine, and availing themselves of it, may have constructed, sold, and used the machine without infringing the legal rights of the patentee, or incurring the penalties of the law. The new patent would retroact on them, and expose them to penalties to which they were not liable when the act was committed.

This objection is more formidable in appearance than in reality. It is not probable that the defect in the specification can be so apparent as to be perceived by any but those who examine it for the purpose of pirating the invention. They are not entitled to much favor. But the answer to the objection is, that this defense is not made in this case; and the opinion of the Circuit Court does not go so far as to say that such a defense would not be successful. That question is not before the court, and is not involved in the opinion we are considering. The defense, when true in fact, may be sufficient in law, notwithstanding the validity of the new patent.

It has been also argued that the new patent must issue on the new specification, and on the application which accompanies it. Consequently, it will not be true that the machine was "not known or used before the application."

But the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application; and, if the new patent is valid, the law must be considered as satisfied if the machine was not known or used before that application.

It has been urged that the public was put into possession of the machine by the open sale and use of it under the defective specifica-

tion, and cannot be deprived of it by the grant of a new patent. The machine is no longer the subject of a patent.

This would be perfectly true if the second patent could be considered as independent of the first. But it is in no respect so considered. The communication of the discovery to the public has been made in pursuance of law, with the intent to exercise a privilege, which is the consideration paid by the public for the future use of the machine. If, by an innocent mistake, the instrument introduced to secure this privilege fails in its object, the public ought not to avail itself of this mistake, and to appropriate the discovery without paying the stipulated consideration. The attempt would be disreputable in an individual, and a court of equity might interpose to restrain him.

It will not be pretended that this question is free from difficulty. But the executive departments, it is understood, have acted on the construction adopted by the Circuit Court, and have considered it as settled. We would not willingly disregard this settled practice in a case where we are not satisfied it is contrary to law, and where we are satisfied that it is required by justice and good faith.

We will now proceed to the second exception.

The plea assigns the particular defect supposed to exist in the specification, and then proceeds to aver, in the very words of the act, that it "does not contain a written description of his, the said Joseph Grant's, invention and improvement aforesaid, and manner of using it, in such full, clear, and exact terms as to distinguish the same from all other things before known, and so as to enable any person skilled in the art, &c., to make and use the same," &c.

The plea alleges, in the words of the act, that the prerequisites to the issuing a patent had not been complied with.

If the matter alleged in this plea constituted no bar to the action, the plaintiffs might have demanded and have submitted the question of law to the court. But they have chosen to deny the facts alleged in the plea, and to aver in their replication "that neither the specification nor the drawings thereto annexed are defective in any of the particulars in that behalf alleged." Issue was joined upon this replication, and it is that issue which the jury were sworn to try.

At the trial, the counsel for the defendants, after the evidence was closed, asked the court, in substance, to instruct the jury, that if they should be of opinion that the defendants had maintained and proved the facts alleged in their plea, they must find for the defendants. The court refused this instruction. Ought it to have been refused? If, in the opinion of the jury, the defendants have proved and

maintained every fact alleged in the plea on which the issue they are sworn to try is joined, ought not the jury to find that issue for the defendants? Is not this required by their oaths? The conclusion, "and that for the cause aforesaid said letters patent are void," is an inference of law from the facts previously alleged,—not the allegation of a distinct fact, to be submitted to the jury.

The court proceeded to instruct the jury, "that the patent would not be void on this ground, unless such defective or imperfect specification or description arose from design, or for the purpose of deceiving the public."

Now, this "*design*," this "*purpose of deceiving the public*," constituted no part of the issue. The defendants had not alleged it, and could not be supposed to come prepared to prove it. A verdict for them, would not imply it. The instruction is understood to direct a verdict which finds in fact that the description or specification is not defective; and this verdict against the evidence is to be found because that defect "arose not from design, or for the purpose of deceiving the public."

But we must inquire whether the instruction, independent of its departure from the issue, be consistent with law. It is "that the patent would not be void unless," &c.

The fifth section of the act gives the party aggrieved an action for the infringement of his patent-right. The sixth provides "that the defendant in such action shall be permitted to plead the general issue, and give this act in evidence, and to give in evidence any special matter of which notice in writing may have been given to the plaintiff or his attorney thirty days before trial, tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing thus secured," &c., "in either of which cases judgment shall be rendered for the defendant with costs, and the patent shall be declared void."

Courts did not, perhaps, at first, distinguish clearly between a defense which would authorize a verdict and judgment in favor of the defendant in the particular action, leaving the plaintiff free to use his patent, and to bring other suits for its infringement, and one which, if successful, would require the court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. This distinction is now well settled.

If the party is content with defending himself, he may either plead

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Opinion of the court.

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specially or plead the general issue, and give the notice required by the sixth section of any special matter he means to use at the trial. If he shows that the patentee has failed in any of those prerequisites on which the authority to issue the patent is made to depend, his defense is complete;—he is entitled to the verdict of the jury and the judgment of the court. But if, not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to the sixth section. If he depends on evidence “tending to prove that the specification filed by the plaintiff does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the described effect,” it may avail him so far as respects himself, but will not justify a judgment declaring the patent void, unless such “concealment or addition shall fully appear to have been made for the purpose of deceiving the public,” which purpose must be found by the jury, to justify a judgment of *vacatur* by the court. The defendant is permitted to proceed according to the sixth section, but is not prohibited from proceeding in the usual manner, so far as respects his defense, except that special matter may not be given in evidence on the general issue unaccompanied by the notice which the sixth section requires. The sixth section is not understood to control the third. The evidence of fraudulent intent is required only in the particular case and for the particular purpose stated in the sixth section.

This instruction was material if the verdict ought to have been for the defendants, provided the allegations of the plea were sustained, and if such verdict would have supported a judgment in their favor, although the defect in the specification might not have arisen from design, and for the purpose of deceiving the public. That such is the law, we are entirely satisfied. The third section requires, as preliminary to a patent, a correct specification and description of the thing discovered. This is necessary, in order to give the public, after the privilege shall expire, the advantage for which the privilege is allowed, and is the foundation of the power to issue the patent. The necessary consequence of the ministerial character in which the Secretary acts is, that the performance of the prerequisites to a patent must be examinable in any suit brought upon it. If the case was of the first impression, we should come to this conclusion; but it is understood to be settled.

The act of Parliament concerning monopolies contains an exception on which the grants of patents for inventions have issued in that country. The construction of so much of that exception as connects the specification with the patent, and makes the validity of the latter



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dependent on the correctness of the former, is applicable, we think, to proceedings under the third section of the American act. The English books are full of cases in which it has been held that a defective specification is a good bar when pleaded to, or a sufficient defense when given in evidence on the general issue, on an action brought for the infringement of a patent-right. They are very well summed up in Godson's Law of Patents, title specification; and also in the chapter respecting the infringement of patents; also in Holroyd on Patents, where he treats of the specification, its form, and requisites. It is deemed unnecessary to go through the cases, because there is no contrariety in them, and because the question is supposed to be substantially settled in this country. *Pennock & Sellers v. Dialogue*, 1 Peters, 1, was not, it is true, a case of defect in the specification or description required by the third section, but one in which the applicant did not bring himself within the provision of the first section, which requires that before a patent shall issue the petitioner shall allege that he has invented a new and useful art, machine, &c., "*not known or used before the application.*"

This prerequisite of the first section, so far as a failure in it may affect the validity of the patent, is not distinguishable from a failure of the prerequisites of the third section.

On the trial, evidence was given to show that the patentee had permitted his invention to be used before he took out his patent. The court declared its opinion to the jury, that if an inventor makes his discovery public, he abandons the inchoate right to the exclusive use of the invention. "It is possible," added the court, "that the inventor may not have intended to give the benefit of his discovery to the public." "But it is not a question of intention," "but of legal inference, resulting from the conduct of the inventor, and affecting the interests of the public. It is for the jury to say whether the evidence brings this case within the principle which has been stated. If it does, the court is of opinion that the plaintiff is not entitled to a verdict."

The jury found a verdict for the defendants; an exception was taken to the opinion, and the judgment was affirmed by this court.

This case affirms the principle, that a failure on the part of the patentee in those prerequisites of the act which authorize a patent, is a bar to a recovery in an action for its infringement; and that the validity of this defense does not depend on the invention of the inventor, but is a legal inference upon his conduct.

Upon these authorities, and this reasoning, we are of opinion that the instruction was erroneous, and that the judgment ought to be reversed and the cause remanded. One of the judges composing the

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Syllabus.

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majority thinks that the direction would have been erroneous on a plea properly framed upon the third section of the act, and averring the facts of a defective specification and a non-compliance with the other requisitions of that section, for that such a plea would be a good bar and defense to the action; but, in his view, the plea relies upon the facts as avoiding the patent entirely, and avers it to be void. He thinks, however, that the replication puts the facts, and not the point whether void or not, in issue; and that the direction of the court was erroneous, since it was equivalent to a declaration that, if all the facts were proved, the issue ought not to be found for the defendants, unless the imperfection of the specification arose from a fraudulent design.

The judgment is reversed, and the cause remanded, with directions to issue a *venire facias de novo*.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District of New York, and was argued by counsel; on consideration whereof, it is the opinion of this court that the said Circuit Court erred in instructing the jury, "that the patent would not be void on this ground unless such defective or imperfect specification or description arose from design, and for the purpose of deceiving the public." Whereupon it is ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed, and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

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JOSEPH SHAW, PLAINTIFF IN ERROR, v. JOSEPH COOPER.

(7 Peters, 292.)

1. Action for an alleged violation of a patent for an improvement in guns and fire-arms.
2. The letters patent were obtained in 1822; and in 1829, the patentee having surrendered the same for an alleged defect in the specification, obtained another patent. This second patent is to be considered as having relation to the emanation of the patent of 1822, and not as having been issued on an original application.
3. The holder of a defective patent may surrender it to the Department of State, and obtain a new one, which shall have relation to the emanation of the first.
4. The case of *Grant et al. v. Raymond*, 6 Peters, 220, cited and affirmed.
5. A second patent, granted on the surrender of a prior one, being a continuation of the first, the rights of a patentee must be ascertained by the law under which the original application was made.

## Syllabus.

6. By the provisions of the act of Congress of 17th April, 1800, citizens and aliens, as to patent-rights, are placed substantially upon the same ground. In either case, if the invention was known or used by the public before it was patented, the patent is void. In both cases the right must be tested by the same rule.
7. What use by the public, before the application is made for a patent, shall make void the right of a patentee.
8. From an examination of the various provisions of the acts of Congress relative to patents for useful inventions, it clearly appears that it was the intention of the Legislature, by a compliance with the requisites of the law, to vest the exclusive right in the inventor only, and that on condition that his invention was neither known nor used by the public before his application for a patent. If such use or knowledge shall be proved to have existed prior to the application for the patent, the act of 1793 declares the patent void; and the right of an alien is vacated in the same manner, by proving a foreign use or knowledge of his invention. That knowledge or use which would be fatal to the patent-right of a citizen, would be equally so to the right of an alien.
9. The knowledge or use spoken of in the act of Congress of 1793, could have referred to the public only; for the provision would be nugatory if it were applied to the inventor himself. He must necessarily have a perfect knowledge of the thing invented, and of its use, before he can describe it, as by law he is required to do preparatory to the emanation of a patent.
10. There may be cases in which a knowledge of the invention may be surreptitiously obtained and communicated to the public, that do not affect the right of the inventor. Under such circumstances, no presumption can arise in favor of an abandonment of the right to the public by the inventor, though an acquiescence on his part will lay the foundation for such a presumption. It is undoubtedly just that every discoverer should realize the benefits resulting from his discovery, for the period contemplated by law. But those can only be reserved by a substantial compliance with every legal requisite. This exclusive right does not rest alone on his discovery, but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed.
11. No matter by what means an invention may have been communicated to the public before a patent is obtained, any acquiescence in the public use by the inventor will be an abandonment of the right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time could give it validity. But the public stand in an entirely different relation to the inventor. His right would be secured by giving public notice that he was the inventor of the thing used, and that he should apply for a patent.
12. The acquiescence of an inventor in the public use of his invention, can in no case be presumed, where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. This will, in general, be a fact for a jury; and if the inventor do not, immediately after this notice, assert his right, it is such evidence of acquiescence in the public use as forever afterwards to prevent him from asserting it. After his right shall be perfected by a patent, no presumption arises against it from a subsequent use by the public.
13. A strict construction of the act of Congress, as it regards the public use of an invention before it is patented, is not only required by its letter and spirit, but also by sound policy.
14. The question of abandonment to the public does not depend on the intention of the inventor. Whatever may be the intention, if he suffers his invention to

## Statement of the case.

go into public use, through any means whatsoever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent obtained under such circumstances protect his right.

IN error to the Circuit Court of the United States for the Southern District of New York.

At the October Term, 1829, of the Circuit Court for the Southern District of New York, the plaintiff in error, Joseph Shaw, instituted an action against the defendant, Joseph Cooper, for an alleged violation of a patent granted to him by the United States, dated the 7th of May, 1829, for "a new and useful improvement in guns and fire-arms, which improvement consisted in a priming head and case applied to arms and fire-arms, for the purpose of priming and giving them fire by the means or use of percussion, fulminating, or detonating powder," by which patent the plaintiff alleged that there was granted to him, &c., for the term of fourteen years, from the 19th of June, 1822, the exclusive right to the said invention, and by virtue of which he became entitled to the same for the residue of the term unexpired on the 7th day of May, 1829. The declaration averred that the defendant had violated the patent-right of the plaintiff, on the 1st day of August, 1829, and afterwards, between that day and the institution of the suit.

The defendant pleaded not guilty, and gave the following notice of the matters of defense:

"Please to take notice that, on the trial of the above cause, the above-named Joseph Cooper will, under the plea of the general issue aforesaid, insist upon and give in evidence that the pretended new and useful improvement in guns and fire-arms, mentioned and referred to in the several counts of the said Joshua Shaw's declaration, was not originally discovered or invented by the said Joshua Shaw; also, that the said pretended new and useful improvement, or the material or essential parts or portions thereof, or some or one of them, had been known and used in this country, namely, in the city of New York and in the city of Philadelphia, and in sundry other places in the United States, and in England, and in France, and in other foreign countries, before the said Joshua Shaw's application for a patent, as set forth in his said declaration; and also before the alleged invention or supposed discovery thereof by the said Joshua Shaw.

"And further, that the said alleged new and useful improvement, or the material or essential parts or portions thereof, or some one of them, or the principle thereof, was the invention or discovery of a gunmaker, or of some other person, residing in England. And fur-

## Statement of the case.

ther, that the said patent was void, because in and by the specification or description therein referred to, no distinction or discrimination is made between the parts and portions previously known and used as aforesaid, and any parts or portions of which the said Joshua Shaw may be the inventor or discoverer; the said Joseph Cooper, at the same time, protesting that he, the said Joshua Shaw, has not been the inventor or discoverer of any part or portion of the said alleged improvement.

“And further, that the said patent is void, because the said specification or description does not describe the improvement of which the said Joshua Shaw claims to be the inventor or discoverer, in such full, clear, and exact terms as to distinguish the same from all other things before known, nor so as to enable a person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make and use the same. And further, that the said patent is void, because it was not granted, issued, or obtained according to law. And further, that the said patent is void, because it was surreptitiously obtained by said Joshua Shaw.”

The cause was tried in January, 1832, and a verdict and judgment given for the defendant. The plaintiff prosecuted this writ of error.

The following bill of exceptions was tendered by the counsel for the plaintiff, and sealed by the court:

“The plaintiff, to maintain the issue on his part, gave in evidence the letters patent of the United States of America, as set forth in the declaration of the said plaintiff, issued on the 7th day of May, 1829; and also that the improvement for which the said letters patent were granted was invented or discovered by the said plaintiff in the year 1813 or 1814, and that the defendant had sold instruments which were infringements of the said letters patent. And thereupon the said defendant, to maintain the said issue above joined on his part, then and there proved, by the testimony of one witness, that he had used the said improvement in England, and had purchased a gun of the kind there, and had seen others use the said improvement, and had seen guns of the kind in the Duke of York’s armory, in 1819; and also proved, by the testimony of five other witnesses, that, in 1820 and 1821, they worked in England at the business of making and repairing guns, and that the said improvement was generally used in England in those years, but that they never had seen guns of the kind prior to those years; and also proved that, in 1820, it was known and used in France; and also that the said improvement was generally known and used in the United States of America after the 19th day June, 1822. Whereupon the said plaintiff, further to maintain the

said issue on his part, then and there gave in evidence that the said plaintiff, not being a worker in iron in 1813 or 1814, employed his brother, in England, under strict injunctions of secrecy, to execute or fabricate the said improvement, for the purpose of the said plaintiff's making experiments. And that the said plaintiff afterwards, in 1817, left England and came to reside in the United States of America; and that after the departure of the said plaintiff from England, namely, in 1817 or 1818, his said brother divulged the said secret for a certain reward to an eminent gunmaker in London. That the said plaintiff, on his arrival in this country, in 1817, disclosed his said improvement to a gunmaker, whom he consulted as to obtaining a patent for the same, and whom he wished to engage to join and assist him. That the plaintiff made said disclosures under injunctions of secrecy, claiming the improvement as his own, and declaring that he should patent it. That the said plaintiff treated his invention as a secret after his arrival in this country, often declaring that he should patent it; and that he assigned as a reason for delaying to patent it, that it was not so perfect as he wished to make it before he introduced it into public use; and that he did make alterations in his invention up to about the date of his patent, which some witnesses considered as improvements, and others did not. That in this country the said invention was never known or used prior to the said 19th day of June, 1822; that on that day letters patent were issued to the said plaintiff, being then an alien, for his said invention; and that the said plaintiff immediately brought the said invention into public use under the said letters patent. That afterwards, and after suits had been brought for violation of the said letters patent, the said plaintiff was advised to surrender them, on account of the specification being defective; and that he did accordingly, on the 7th day of May, 1829, surrender the same into the Department of the Secretary of State of the United States of America; and that thereupon the letters patent first above mentioned were issued to the said plaintiff. And the said plaintiff also gave in evidence, that prior to the said 19th day of June, 1822, the principal importers of guns, from England, in New York and Philadelphia, at the latter of which cities the plaintiff resided, had never heard anything of the said invention, or that the same was known or used in England, and that no guns of the kind were imported into this country until the years 1824 or 1825. And that letters patent were granted in England, on the 11th day of April, 1807, to one Alexander J. Forsyth, for a method of discharging or giving fire to artillery and all other fire-arms, which method he describes in his specification as consisting in 'the use or

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application as a priming, in any mode, of some or one of those chemical compounds which are so easily inflammable as to be capable of taking fire and exploding without any actual fire being applied thereto, and merely by a blow, or by any sudden or strong pressure or friction, given or applied thereto, without extraordinary violence—that is to say, some one of the compounds of combustible matter, such as sulphur or sulphur and charcoal, with oxmuriatic salt; for example, the salt formed of dephlogisticated marine acid and potash, (or potasse,) which salt is otherwise called oxmuriate of potash, or such of the fulminating metallic compounds as may be used with safety; for example, fulminating mercury, or of common gunpowder mixed in due quantity with any of the above-mentioned substances, or with any oxmuriatic salt, as aforesaid, or of suitable mixtures of any of the above-mentioned compounds;’ and that the said letters patent continued in force for the period of fourteen years from and after granting of the same. (It is understood that the patent and specification of Forsyth may be at any time referred to on the argument for correction or explanation of the bill of exceptions.) And thereupon the defendant, further to maintain the said issue on his part, gave in evidence a certain letter from the plaintiff to the defendant, dated in December, 1824, from which the following is an extract: ‘Some time since I stated that I had employed counsel respecting regular prosecutions for any trespasses against my rights to the patent. I have at length obtained the opinion of Mr. Sergeant of this city, together with others eminent in law, and that is, that I ought (with a view to insure success) to visit England, and procure the affidavits of Manton and others to whom I made my invention known, and also of the person whom I employed to make the lock at the time of invention; for it appears very essential that I should also prove that I did actually reduce the principle to practice, otherwise a verdict might be doubtful. It is, therefore, my intention to visit England in May next for this purpose. In the meantime, proceedings which have commenced here are suspended for the necessary time.’

“And the said judges of the said court did thereupon charge and direct the said jury that the patent of the 7th day of May, 1829, having been issued, as appeared by its recital, on the surrender and cancellation of the patent of the 19th day of June, 1822; and being intended to correct a mistake or remedy a defect in the latter, it must be considered as a continuation of the said patent, and the rights of the plaintiff were to be determined by the state of things which existed in 1822, when the patent was obtained.

“That the plaintiff’s case, therefore, came under the act passed

the 17th day of April, 1800, extending the right of obtaining patents to aliens, by the first section of which the applicant is required to make oath that his invention has not, to the best of his knowledge or belief, been known or used in this or any foreign country. That the plaintiff most probably did not know, in 1822, that the invention for which he was taking out a patent had, before that time, been in use in a foreign country, but that his knowledge or ignorance on that subject was rendered immaterial by the concluding part of the section, which expressly declares that every patent obtained pursuant to that act for any invention which, it should afterwards appear, had been known or used previous to such application for a patent, should be utterly void. That there was nothing in the act confining such use to the United States; and that, if the invention was previously known in England or France, it was sufficient to avoid the patent under that act. That the evidence would lead to the conclusion that the plaintiff was the inventor in this case; but the court were of opinion that he had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent. That the use of the invention by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's rights, but that the law was made for the benefit of the public as well as of the inventor; and if, as appeared from the evidence in this case, the public had become fairly possessed of the invention before the plaintiff applied for his patent, it was sufficient, in the opinion of the court, to invalidate his patent, even though the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he intrusted the knowledge of it."

The case was submitted to the court, on printed arguments, by *Mr. Paine*, for the plaintiff in error, and *Mr. Emmet*, for the defendant.

For the plaintiff in error, it was contended that the case fell within the principles which had been uniformly acknowledged and supported in the Circuit Court of the United States; and which were not intended to be disavowed, but sanctioned by this court, in *Pennock v. Dialogue*, 2 Peters, 1.

In this country, many strong cases of public use, prior to the application for a patent, have been brought before the courts, where the public had been long in possession; and the courts have allowed the inventor to show in different ways that he had not thereby abandoned his use to the public. How much more favorable to us are the cir-



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Argument for the plaintiff in error.

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cumstances of our case, as respects a prior use. Before we took out our first patent, the invention had never been seen or heard of in this country. It was not then known to ourselves, nor to any others in this country, that it had been used in England; and it had been so used only one or two years—a short period, compared with the many cases which have been sustained by the courts. Even if this use had been an American use, it would not have been an extraordinary one. But it was not an American, but a foreign use; and, therefore, not a use by the public who contest our exclusive right by saying that they had become the innocent possessors of our invention. Not one of that public had gotten possession of it.

The case does not seem to be fairly stated, when it is said that, although the invention was disclosed by piracy, yet the public have innocently got possession of it by that means. The only public who can set up the innocence of their possession as against us, did not get their possession by the piracy, but under the invalid patent. And if this be so, what difference does it make that afterwards guns were brought from England? Does such a circumstance bear, can it be made to bear, at all upon the merits of the case?

The parts of the charge to the jury of the Circuit Court which are objected to, as understood by the counsel for the plaintiff, may be stated thus:

That the use of the invention abroad, acquired through a fraudulent or piratical disclosure of the secret, for a period of only one or two years before the application for the patent, and that use entirely unknown to the inventor here, avoids the patent, because it was obtained under the alien act.

That our patent of 1829, obtained under the citizen's act, is, in respect to the prior foreign use, to be construed as if obtained under the alien act, because it was obtained on the surrender of the patent of 1822, which was obtained under the alien act, the one being only a continuation of the other.

That the inventor (the court are understood to have been speaking, in this part of the charge, without reference to the question as to whether the patent was obtained under the alien or citizen's act, but to have designed their remarks to apply to patents generally) had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent; that the use of the invention by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's right, but that the law was made for the benefit of the public as well as of the inventor; and if, as appeared from the evidence in this case, the public had

fairly become possessed of the invention before the plaintiff applied for his patent, it was sufficient to invalidate his patent, even though the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he intrusted the knowledge of it.

The following points comprehend these objections to the charge of the court :

1. The second patent is original and independent, and not a continuation of the first patent.

When patents are surrendered and cancelled in England, they are entirely vacated and gone, and as if they had never existed ; and the king can grant out the right, *de novo*. either to the same or to any other person. 17 Vin. Abridg., 114, Prerogative of the King, R. b. paragraph 9 ; 17 Vin. Abridg., 151, Prerogative, &c., M. C. paragraphs 2, 3, 4, 6, 10, 14 ; Godson on Patents, 200 ; Com. Dig., Patent, G.

If this is the effect of a surrender there, it must be the same here.

Not a *dictum* can be found in the English books that a second patent is a continuation of the first. No such idea can be found in our own books, although cases of surrender have come before our courts.

The right of an inventor to surrender an invalid patent and take out a new one being admitted, it follows that, if between the two patents he has been naturalized, he must, of necessity, take out a patent under the citizen's act, because he is no longer an alien. If he rightfully takes a patent under the citizen's act, he is entitled to all the advantages that act confers, and, among them, to have his patent construed and adjudicated upon under the provisions of that act, and of no other.

2. A fraudulent or piratical use of the invention, either at home or abroad, before the application for a patent, cannot have any other or greater effect to invalidate a patent obtained under the alien act than one obtained under the citizen's act.

On general principles, it cannot ; for, as to all kinds of property, no one can acquire a right to it, except by the consent of the owner. Theft or fraud can never enable one who gets possession by those means to transfer the property. See authorities cited under next point.

It is on this principle that the courts first began to construe the citizen's act, by arraying the sixth section against the first. They said the legislature meant to provide by the sixth section for the exception of cases of fraud, &c., out of the too rigid and literal opera-

## Argument for the plaintiff in error.

tion of the first section. Afterwards, the courts took a more liberal view of the act, and held that, even without the sixth section, the legislative intention to except such cases from the first section would be presumed; and this is the doctrine finally settled in *Pennock v. Dialogue*.

The construction given by this court in the case of *Pennock v. Dialogue*, 2 Peters, 22, is entirely in favor of the plaintiff in error.

The court there say, in that case: "The act of 17th April, 1800, ch. 25, which extends the privileges of the act of 1793 to inventors who are aliens, contains a proviso declaring that 'every patent which shall be obtained pursuant to the act for any invention, art, or discovery which, it shall afterwards appear, had been known or used previous to such application for a patent, shall be void.' This proviso certainly certifies the construction of the act of 1793, already asserted, for there is not any reason to suppose that the legislature intended to confer on aliens privileges essentially different from those belonging to citizens; on the contrary, the enacting clause of the act of 1800 purports to put both on the same footing, and the proviso seems added as a gloss or explanation of the original act."

Now, the proviso is the only thing in the alien act which can make it at all different in this particular from the citizen's act; and the courts say that it does not make any difference, but merely expresses more fully what was the meaning of the citizen's act.

3. If an invention has been pirated or fraudulently divulged, the inventor cannot thereby lose his right to his own invention and property; and it makes no difference that the public have acquired the use of the invention without any participation in the fraud, unless the inventor has acquiesced in such use, the only principle to be found in the American decisions on this subject being, that a public use does not affect the inventor's right, unless it proves that he has dedicated or abandoned his invention to the public. And in this case there is no evidence of such delay or neglect as would amount to an abandonment, nor of any intention to dedicate the invention to the public.

It is a general principle, as to all kinds of personal property, that even a *bona fide* purchaser for a valuable consideration can never acquire property of which another has been deprived by fraud, theft, or violence, or even by a bailment. 1 Wils. Rep., 8; 2 Str. Rep., 1187; 3 Atk. Rep., 44; Salk. Rep., 283.

In this respect, no difference has ever yet been made between a man's property in his inventions and his other property; and there seems to be no reason or principle making a distinction.

The statute of Massachusetts securing copyrights (before the Fede-

ral Union) begins with a preamble declaring that "no property is more peculiarly a man's own than that which is produced by the labor of his mind." Cited 1 Dane's Abridg., 527.

In *Miller v. T aylor*, 4 Burr., 2303, seven judges against four held that at common law the author of a literary composition did not lose his right by publishing it.

So far, then, as the natural rights of men to this species of property, (copyright,) independently of statutory provisions, are in question, they retain all their rights to such property, notwithstanding the public have innocently got possession of it, and even with the author's consent; and there surely can be no difference, when we go back to natural rights at common law, whether the property is the subject of a copyright or of a patent—whether it be a book or a machine; the public, having got the use or possession, must have as much right to make copies of the book as of the machine: both are the produce of the mind. This view is taken merely to show that this species of property has been treated as subject to the same rules of law as other kinds of property—that is, except so far as the statute makes a difference. Now, it is admitted that, under the statute, neither the pirate, nor any one participating in his piracy, can acquire any rights against the inventor. And why? Because the same rules of justice which apply to all other kinds of property are applied by the courts to this, as being the intention of the statute, although against its letter. But why stop at the pirate, and say that you will not extend the rule to the public, when they have innocently got the possession? Do you stop thus as to other kinds of property? No. You say, no one, however innocent of fraud, can become the lawful proprietor. Why, then, not carry the principle to its full extent? How can it be inferred that the statute intends to go a part of the way of a general principle, and there stop? The principle is a rule drawn by analogy from other kinds of property, on the ground that the analogy being general, the rule should be so, too. But the analogy is also complete between this and other kinds of property, and the rule ought therefore to be complete, and applied in its full extent.

But there is even a stronger reason why this principle of law should be applied to this species of property in its full extent, rather than to the case of a *bona fide* purchaser of any other kind. There he has paid a consideration, an equivalent. It is a hard case: one of two innocent persons must suffer. Not so here. What does the public lose? That which has cost it nothing, for which it has given no equivalent; and all we seek of them is the consideration, the equivalent, which they have never yet paid to any one.

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Argument for the plaintiff in error.

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But if we examine the American cases on this subject prior to *Pennock v. Dialogue*, we shall find that the principle has always been applied to inventions in its full extent.

The counsel then proceeded to examine the following cases, and argued that they fully sustained the principles claimed for the plaintiff in error: *Whittemore v. Cutter*, 1 Gall., 482; *Goodyear v. Mathews*, 1 Paine's Rep., 301; *Morris v. Huntington*, 1 Paine, 354; *Mellus v. Silsbee*, 4 Mason's Rep., 108; *Treadwell v. Bladen*, 4 Wash. C. C. R., 703.

The bill of exceptions says "that the plaintiff assigned as a reason for delaying to patent it, (the invention,) that it was not so perfect as he wished to make it before he introduced it to public use; and that he did make alterations in his invention up to about the date of his patent, which some witnesses considered as improvements, and others did not."

This was sufficient to account for the delay; and it is unimportant whether the alterations were improvements or not, for he was trying to make them, and said that was his motive for the delay; and the motive for the delay is the only question. 1 Paine's Rep., 354.

The patent granted to Forsyth, in England, which gave him the exclusive right to use the percussion powders in any mode, down to April, 1821, accounts for not taking out a patent in England.

Finally, the counsel for the plaintiff in error contended:

1. That if the rights of the patentee were the same as under an ordinary citizen's patent, then he had never dedicated or abandoned his invention to the public, and that there has been no use of it which invalidates his patent.

2. That his rights are the same as those under an ordinary citizen's patent, the patent having been granted under the citizen's act, and not being affected by the previous vacated patent.

3. That even if he is to be considered as having a patent under the alien act, his rights, under the circumstances of this case, are the same as if it was a citizen's patent.

In conclusion, he remarked that the jury found their verdict entirely under the charge of the court, considering that the charge, as to the points of law, precluded them from finding a verdict for the plaintiff, however well they might be satisfied upon every matter of fact. It was believed the jury, as well as the court, were entirely satisfied that the plaintiff was the inventor, and that his invention had been used without his knowledge or suspicion; and that he had never disclosed it, except in confidence, and under the strictest injunctions of secrecy.

The letter from plaintiff to defendant should not have been put in the bill of exceptions, because it only presented questions of fact purely, not affecting any of the points of law on which the court charged the jury. This court will not regard a mere isolated fact, when it is apparent that all the facts of the case are not given, but only such as are essential to show how the jury were charged as to the law. It is impossible for this court to say how the jury would have found upon the whole evidence. It is sufficient to add that the meaning of that letter was satisfactorily explained to the jury by the plaintiff's counsel. It was explained that the knowledge of his invention, which the plaintiff in that letter says he communicated to "Manton and others," was simply the knowledge of the fact that he had made *an* important invention, *without disclosing what it was*. On any other supposition, this letter was contradicted by all the rest of the evidence in the case and the uniform conduct of the plaintiff.

*Mr. Emmet, for the defendant in error.*

The bill of exceptions in this cause discloses, in substance, the following case :

In 1813 or 1814, the plaintiff, residing in England, invented what he claims to be secured to him by his patent. Between that time and his coming to the United States he made his invention known to his brother, also to Mr. Manton, a gunmaker in London, and others, as is shown by his letter to defendant.

In 1817, the plaintiff came to the United States, and shortly afterwards disclosed his secret to a gunmaker in Philadelphia.

In 1817 or 1818, plaintiff's brother sold the secret to a gunmaker in London.

In 1819, the invention was sold and used in England.

In 1820 or 1821, it was in general use by the public there.

In 1821, it was in general use in France.

In 1822, (19th June,) plaintiff took out his first patent as an alien, under the act of 1800.

In 1829, (7th May,) he surrendered that patent as defective and took out a new one, with an amended specification, as a citizen, under the act of 1793, upon which patent his suit is brought.

The case also sets forth that, in April, 1807, a patent had been granted in England to one Forsyth for an invention on the same subject, and that such patent continued in force for fourteen years, or until April, 1821. This was offered by the plaintiff and made a part of the case, for the purpose, doubtless, of accounting for his not having taken out a patent for his invention in England previous to

## Argument for the defendant in error.

1817, the terms of Forsyth's patent being, as he supposed, sufficiently comprehensive to embrace his discovery and to tie up his hands during its continuance.

From these facts, it would at least appear that the public had *somewhere* become fully possessed of the use of the invention, and that they had enjoyed such use for not less than about two years before the plaintiff took any steps to obtain his first patent.

Without stopping now to inquire what should be considered as *the public* in respect to a case of this kind, let us examine how far the acts of the plaintiff himself have precluded him from ever controverting the right of that public to the use of the thing in question.

The principle upon which *previous public use* of an invention invalidates a patent, undoubtedly, is, that the inventor can no longer give any *consideration* or *equivalent* for the exclusive privilege claimed by him; and the law, to sustain a principle so necessary and just in itself, presumes an *abandonment* by the inventor. This abandonment may be either *actual*, as by *voluntary dedication*, or *constructive*, as by *negligence* or *unreasonable delay*. Paine's Rep., 300.

In the present case, can it be pretended that there was neither *negligence* nor *unreasonable delay*? The plaintiff would have it appear that, up to 1822, he was *maturing* his invention, and yet what he then took out a patent for was the *very thing*, and no improvement upon that, which for two or three years previous had been generally known and used in England and France. But admitting this explanation to stand for what it is worth, how does it tally with his other ground of excuse. He says Forsyth's patent restrained him in England. Be it so—and what is the fair inference? Why, that if it had not been for Forsyth's patent *he* would have applied there for one before 1817; and if he would, his invention *was matured* before he came to the United States; and nothing but his alienism stood in the way of his applying for a patent immediately after his arrival. Being an alien, the law required him to delay two years. In 1819, therefore, he might and ought to have taken out his patent; and if he had done so, he would have anticipated the *public use* of the invention in England and France. But he delayed until 1822, a period of three years. His own story shows that such delay was without sufficient cause. It was, therefore, *unreasonable*; and the law, in protection of the right acquired in the meantime by the public, construes his acts into an *abandonment*.

It would appear that, even to the mind of the plaintiff's counsel, this view of the case is conclusive, unless the fact of the invention having got into *public use* before the first patent was taken out, can

be shaken; for they say that the use, in this case, was not an *American*, but a foreign use, and therefore not a use by the public who contest their exclusive right. This distinction is directly opposed to the act of 1800, which uses the language "known or used, in this or *any foreign country*"; and it is equally opposed to the intent and meaning of the act of 1793. We are perfectly willing to admit that, in this respect, the construction of both acts should be the same; and that the proviso at the end of the first section of the act of 1800 applies to *every patent*, whether obtained under *that* act or the act of 1793. In the words of Mr. Justice STORY, the act of 1800 affords, in this respect, a gloss or explanation of the original act. *Pennock v. Dialogue*, 2 Peters's S. C. Rep., 22. This only tends to show, that if the plaintiff had been a citizen in 1822, and had taken out his first patent under the act of 1793, his case would have been just as objectionable as it is now. But where do the plaintiff's counsel find any law for such a distinction between American and foreign *public use*, or how could it be sustained on principle? If the doctrine be a sound one, it would go to this extent: I dedicate my invention to the public in Europe; the European public being thus legally possessed of it, the article is manufactured and exported in large quantities; I immediately come over here, take out a patent, and prevent the use of the article in the United States, thereby prohibiting the European public from engaging in a traffic or commerce which was an immediate incident to my own grant or dedication to them.

The impolicy of recognizing such a distinction would afford a sufficient argument against it, even if the terms of the statute were not explicit, and if nothing had ever fallen from the bench to give a construction to the expression "public use." But there is positive and high authority on this subject. Lord Chief Justice GIBBS says, "to entitle a man to a patent, the invention must be *new to the world*." 1 Holt's N. P. Rep., 58. And such, we submit, is the settled law on this point.

It would seem to be of little importance in this cause to discuss the plaintiff's position "that the second patent is original and independent, and not a continuation of the first patent," because the only object of disconnecting the two patents in this case would be to rescue the second patent from the operation of the act of 1800, under which the first patent was taken (the judge having charged the jury that the act of 1800 was sufficient to control the case). Now, we not only admit that the act of 1793 should receive a similar construction with that of 1800, as to *previous knowledge or use* of an invention, but the plaintiff's counsel labor to establish this very ground. Their posi-



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tion, however, is not a correct one. The object of cancelling a first patent, and taking out a second, is not to take a fresh start for the term of years during which the law allows the exclusive right to be conferred. It is to enable the inventor to enjoy, for the *remainder of that term*, the privilege which was *originally intended* to be granted. And in this view, even if the construction of the two acts was different, we apprehend that the judge laid down the law correctly, namely, that the plaintiff's rights depended upon the state of things in 1822, and upon the act of 1800.

It is only necessary to follow the plaintiff's argument on his third point, to perceive the impediment which the first section of the act of 1800, taken either in reference to that act only or as explanatory of the act of 1793, offers to his case. To get rid of this difficulty, it is, in substance, contended by his counsel that the legislature did not mean what they have said in this section, when certain cases came to be considered; and that the positive and unequivocal language used by them is, in this respect, unimportant. Now, the very fact that this section was intended to be *declaratory* of the law in all cases, whether arising under that or the former act of 1793, shows that the explicit language used was considered to be all-important by the legislature; and it certainly was not contemplated that this explicit language should be frittered away to suit particular cases.

If the facts of this case, as we have endeavored to show, make out a *negligence* or *unreasonable delay* on the part of the plaintiff in taking out his patent, and that such negligence or unreasonable delay amounts *in law* to an *abandonment*, the case is disposed of. We contend also that the delay was not accounted for, the alleged reason for it being virtually contradicted by the testimony offered to make out his case; and further, that the finding of the jury is conclusive as to this point.

The intent of the delay of the patent, and whether the allowing the invention to be used without a patent, should not be considered an abandonment, or a present of it to the public, are questions for the jury. *Morris v. Huntington*, 1 Paine's Rep., 22.

The principles which we contend for, being recognized in many of the cases cited on the part of the plaintiff, (particularly the case of *Pennock v. Dialogue*,) it has been deemed unnecessary to refer to those cases more particularly. If the charge of the judge was not erroneous as to the law, there can be no ground for granting a new trial.

Mr. Justice M'LEAN delivered the opinion of the court.

This writ of error brings before this court, for its revision, a judg-

ment of the Circuit Court of the United States for the Southern District of New York.

An action was brought in the Circuit Court by Shaw against the defendant Cooper, for the violation of a certain patent-right claimed by the plaintiff. The defendant pleaded the general issue, and gave notice that on the trial he would prove "that the pretended new and useful improvement in guns and fire-arms mentioned and referred to in the several counts in the declaration, also that the said pretended new and useful improvement, or the essential parts or portions thereof, or some or one of them, had been known and used in this country, namely, in the city of New York and in the city of Philadelphia, and in sundry other places in the United States, and in England, in France, and in other foreign countries, before the plaintiff's application for a patent, as set forth in his declaration," &c.

On the trial, the following bill of exceptions was taken: "To maintain the issue joined, the plaintiff gave in evidence certain letters patent of the United States, as set forth in the declaration, issued on the 7th day of May, 1829; and also that the improvement for which the letters were granted was invented or discovered by the plaintiffs in 1813 or 1814, and that the defendant had sold instruments which were infringements of the said letters patent.

"And the defendant then proved, by the testimony of one witness, that he had used the said improvement in England, and had purchased a gun of the kind there, and had seen others use the said improvement, and had seen guns of the kind in the Duke of York's armory in 1819; and also proved, by the testimony of five other witnesses, that, in 1820 and 1821, they worked in England at the business of making and repairing guns, and that the said improvement was generally used in England in those years, but that they had never seen guns of the kind prior to those years; and also proved that, in the year 1821, it was used and known in France; and also that the said improvement was generally known and used in the United States after the 19th day of June, 1822.

"And the plaintiff, further to maintain the issue on his part, then gave in evidence that he, not being a worker in iron, in 1813 or 1814, employed his brother, in England, under strict injunctions of secrecy, to execute or fabricate the said improvement, for the purpose of making experiments; and that the plaintiff afterwards, in 1817, left England and came to reside in the United States; and that after his departure from England, in 1817 or 1818, his said brother divulged the secret for a certain reward to an eminent gunmaker in London. That on the arrival of the plaintiff in this country, in 1817, he disclosed his

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said improvement to a gunmaker, whom he consulted as to obtaining a patent for the same, and whom he wished to engage to join and assist him. That the plaintiff made this disclosure under injunctions of secrecy, claiming the improvement as his own, declaring that he should patent it. That the plaintiff treated his invention as a secret after his arrival in this country, often declaring that he should patent it; and that this step was only delayed that he might make it more perfect before it was introduced into public use; and that he did make alterations, which some witnesses considered improvements in his invention, and others did not. That in this country the invention was never known or used prior to the said 19th day of June, 1822; that on that day letters patent were issued to the plaintiff, being then an alien, and that he immediately brought his invention into public use. That afterwards, and after suits had been brought for a violation of the said letters patent, the plaintiff was advised to surrender them, on account of the specification being defective; and that he did accordingly, on the 7th day of May, in the year 1829, surrender the same into the Department of the Secretary of State, and received the letters patent first above named.

“And the plaintiff also gave in evidence, that prior to the 19th day of June, 1822, the principal importers of guns, from England, in New York and Philadelphia, at the latter of which cities the plaintiff resided, had never heard anything of the said invention, or that the same was used or known in England, and that no guns of the kind were imported into this country until the years 1824 or 1825. And that letters patent were granted in England on the 11th day of April, 1807, to one Alexander J. Forsyth, for a method of discharging or giving fire to artillery and all other fire-arms, which method he describes in his specification as consisting in the ‘use or application as a priming, in any mode, of some or one of those chemical compounds which are so easily inflammable as to be capable of taking fire and exploding without any actual fire being applied thereto, and merely by a blow, or by any sudden or strong pressure or friction, given or applied thereto, without extraordinary violence—that is to say, some one of the compounds of combustible matter, such as sulphur or sulphur and charcoal, with an oxmuriatic salt; for example, the salt formed of dephlogisticated marine acid and potash, (or potasse,) which salt is otherwise called oxmuriate of potash, or such of the fulminating metallic compounds as may be used with safety; for example, fulminating mercury, or of common gunpowder mixed in due quantity with any of the above-mentioned substances, or with any oxmuriatic salt, as aforesaid, or of suitable mixtures of any of the before-mentioned

compounds;’ and that the said letters patent continued in force for the period of fourteen years from the time of granting the same.”

And the defendant, further to maintain the issue on his part, gave in evidence a certain letter from the plaintiff to the defendant, dated in December, in the year 1824, from which the following is an extract:

“Some time since I stated that I had employed counsel respecting regular prosecutions for any trespass against my rights to the patent. I have at length obtained the opinion of Mr. Sergeant of this city, together with others eminent in the law, and that is, that I ought (with a view to insure success) to visit England, and procure the affidavits of Manton and others, to whom I made my invention known, and also of the person whom I employed to make the lock at the time of invention; for it appears very essential that I should prove that I did actually reduce the principle to practice, otherwise a verdict might be doubtful. It is, therefore, my intention to visit England in May next for this purpose. In the meantime, proceedings which have commenced here are suspended for the necessary time.”

And the court, on these facts, charged the jury that the patent of the 7th of May, 1829, having been issued, as appears by its recital, on the surrender and cancelment of the patent of the 19th day of June, in the year 1822, and being intended to correct a mistake or remedy a defect in the latter, it must be considered as a continuation of the said patent, and the rights of the plaintiff were to be determined by the state of things which existed in the year 1822, when the patent was first obtained.

That the plaintiff’s case, therefore, came under the act passed the 17th day of April, 1800, extending the right of obtaining patents to aliens, by the first section of which the applicant is required to make oath that his invention has not, to the best of his knowledge or belief, been known or used in this or any foreign country. That the plaintiff most probably did not know, in the year 1822, that the invention for which he was taking out a patent had, before that time, been in use in a foreign country; but that his knowledge or ignorance on that subject was rendered immaterial by the concluding part of the section, which expressly declares that every patent obtained pursuant to that act for any invention which, it should afterward appear, had been known or used previous to such application for a patent, should be utterly void. That there was nothing in the act confining such use to the United States, and that if the invention was previously known in England or France it was sufficient to avoid the patent under that act. That the evidence would lead to the conclusion that the plaintiff was the inventor in this case, but the court were of opinion that

he had slept too long on his rights, and not followed them up as the law requires, to entitle him to any benefit from his patent. That the use of the invention by a person who had pirated it, or by others who knew of the piracy, would not affect the inventor's rights, but that the law was made for the benefit of the public as well as of the inventor; and if, as appears from the evidence in this case, the public had fairly become possessed of the invention before the plaintiff applied for his patent, it was sufficient, in the opinion of the court, to invalidate the patent, even though the invention may have originally got into public use through the fraud or misconduct of his brother, to whom he intrusted the knowledge of it.

Under this charge, the jury found a verdict for the defendant, on which a judgment was entered.

There is a general assignment of errors, which brings to the consideration of the court the principles of law which arise out of the facts of the case, as stated in the bill of exceptions.

It may be proper, in the first place, to inquire whether the letters patent which were obtained in 1829, on a surrender of the first patent, have relation to the emanation of the patent in 1822, or shall be considered as having been issued on an original application.

On the part of the plaintiff, it is contended that "the second patent is original and independent, and not a continuation of the first patent"; that in adopting the policy of giving, for a term of years, exclusive rights to inventors in this country, we adopted at the same time the rules of the common law as applied to patents in England; and that, by the rules of the common law, a patent, when defective, may be surrendered to the granting power, which vacates the right under it, and the king may grant the right *de novo*, either to the same or to any other person.

This being the effect of the surrender of a patent in England, it is insisted that the same consequence should follow a surrender in this country. On this subject, it is said that the decisions of the English courts are uniform, and that not even a *dictum* can be found that a second patent is a continuation of the first.

The counsel seems to consider this point of great importance, as the plaintiff was an alien when the first patent was obtained, but had become naturalized before the date of the second, and, consequently, that his rights under the second patent cannot be governed by the law applicable to aliens. As the inquiry on this head is whether the second patent has relation to the first, it is not necessary to look into the laws to ascertain the respective rights of aliens and citizens on this subject. In regard to the right of the patentee to surrender a

defective patent and take out a new one, there can be no difference between a citizen and an alien.

That the holder of a defective patent may surrender it to the Department of State and obtain a new one which shall have relation to the emanation of the first, was decided by this court, at the last term, in the case of *Grant et al. v. Raymond*, 6 Peters, 220. The Chief Justice, in giving the opinion of the court, says: "But the new patent and the proceedings on which it issues have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application; and, if the new application is valid, the law must be considered as satisfied, if the machine was not known or used before that application."

As this decision must be considered as settling the construction of the patent laws on this point, it is conclusive in the present case; and it is, therefore, unnecessary to examine the argument of the plaintiff's counsel, which was designed to lead to a different conclusion.

The second patent being a continuation of the first one, the rights of the plaintiff must be ascertained by the law under which the original application was made.

This law was passed on the 17th of April, 1800, and provides: "that all and singular the rights and privileges given to citizens of the United States respecting patents for new inventions, &c., shall be extended to aliens, who, at the time of petitioning, shall have resided for two years within the United States, &c.: *Provided*, That every person petitioning for a patent for any invention, art, or discovery, pursuant to this act, shall make oath or affirmation, before some person duly authorized to administer oaths, before such patent shall be granted, that such invention, art, or discovery hath not, to the best of his or her knowledge or belief, been known or used, either in this or any foreign country; and that every patent which shall be obtained pursuant to this act for any invention, art, or discovery which, it shall afterwards appear, had been known or used previous to such application for a patent, shall be utterly void."

By the act of the 21st of February, 1793, which limits patent-rights to citizens, it is provided "that every person or persons, in his or their application for a patent, shall state that the machine, &c., was *not known or used* before such application."

The sixth section of this act provides that a defendant, when prosecuted for a violation of a patent-right, may give in evidence, under a notice, among other matters, "that the thing secured by patent was not originally discovered by the patentee, but had been in use, or had

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been described in some public work, anterior to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person—in either of which cases, judgment shall be rendered for the defendant, with costs, and the patent shall be declared void.”

It would seem, from the above provisions, that citizens and aliens, as to patent-rights, are placed substantially upon the same ground. In either case, if the invention was known or used by the public before it was patented, the patent is void. In both cases the right must be tested by the same rule.

From the facts in the case, it appears that the plaintiff, while residing in England, in 1813 or 1814, invented the instrument secured by his patent; that, before he came to the United States, he made known his invention to his brother, to Mr. Manton, a gunmaker in London, and to others; that, shortly after he came to the United States, in 1817, he disclosed his invention to a gunmaker in Philadelphia, and that, in 1817 or 1818, the plaintiff's brother sold the invention to a gunmaker in London; that in 1819 the invention was sold and used in England; and that, in the two following years, it was in public use there, and in the latter year also in France; that on the 19th of June, 1822, his first patent was obtained.

It also appears that in April, 1807, a patent was granted in England to one Forsyth, for fourteen years, for an invention on the same subject. This fact was shown by the plaintiff, it is presumed, as a reason why he did not take out a patent in England.

The question arises, from these facts and others which belong to the case, whether there was such a use in the public, of this invention, at the date of the plaintiff's first patent, as to render it void.

By the plaintiff's counsel, it is insisted that if an invention has been pirated, or fraudulently divulged, the inventor cannot thereby lose his right to his own invention and property; and it makes no difference that the public have acquired the use of the invention without any participation in the fraud, unless the inventor has acquiesced in such use.

The right of the plaintiff to his invention is compared to his right to other property, which cannot be divested by fraud or violence; and the case of *Miller v. Taylor*, 4 Burr., 2303,—where seven judges against four held that, at common law, an author by publishing a literary composition does not abandon his right,—is referred to as illustrative of the principle.

Several decisions by the Circuit Courts of the United States are cited to sustain the right of the plaintiff. In the case of *Whittemore*

v. *Cutter*, 1 Gall., 482, the court say: "It will not protect the plaintiff's patent, that he was the inventor of the improvements, if he suffered them to be used freely and fully by the public at large for so many years, combined with all the usual machinery; for, in such case, he must be deemed to have made a gift of them to the public, as much as a person who voluntarily opens his land as a highway and suffers it to remain for a length of time devoted to public use."

In the case of *Goodyear v. Mathews*, 1 Paine's Rep., 301, the court, in substance, say "that if the plaintiff be the inventor, it is immaterial that the invention has been known and used for years before the application." And in the case of *Morris v. Huntington*, 1 Paine, 354, the court say that "no man is to be permitted to lie by for years, and then take out a patent. If he has been practicing his invention with a view of improving it, and thereby rendering it a greater benefit to the public, before taking out a patent, that ought not to prejudice him. But it should always be a question submitted to the jury, what was the intent of the delay of the patent, and whether the allowing the invention to be used without a patent should not be considered an abandonment or present of it to the public."

This was a case where a second patent had been obtained, the first being defective, and this, it would seem, was deemed sufficient to protect the right of the plaintiff, though the public had been in possession of the invention for six years before the emanation of the second patent.

Of the same import, are the cases cited from 4 Mason, 108, and 4 Washington, 438, 703.

The question, what use in the public, before the application is made for a patent, shall make void the right of the patentee, was brought before this court by the case of *Pennock & Sellers v. Dialogue*, reported in 2 Peters, 1. In this case, the court say that "it has not been, and indeed cannot be, denied that an inventor may abandon his invention and surrender or dedicate it to the public. This inchoate right thus gone, cannot afterwards be resumed at his pleasure; for when gifts are once made to the public in this way, they become absolute." And again, "if an invention is used by the public, with the consent of the inventor, at the time of his application for a patent, how can the court say that his case is nevertheless such as the act was intended to protect? If such a public use is not a use within the meaning of the statute, how can the court extract the case from its operation, and support a patent, when the suggestions



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Opinion of the court.

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of the patentee were not true, and the conditions on which alone the grant was authorized do not exist?"

"The true construction of the Patent Law is," the court say, "that the first inventor cannot acquire a good title to a patent, if he suffers the thing invented to go into public use, or to be publicly sold for use, before he makes application for a patent."

In this case, it appeared that the thing invented had been in use by the public, with the consent of the inventors, and through which they derived a profit, for seven years before the emanation of a patent. And this use was held by the court to be an abandonment of the right by the patentees.

The policy of granting exclusive privileges in certain cases was deemed of so much importance, in a national point of view, that power was given to Congress in the Federal Constitution "to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries."

This power was exercised by Congress in the passage of the acts which have been referred to; and, from an examination of their various provisions, it clearly appears that it was the intention of the legislature, by a compliance with the requisites of the law, to vest the exclusive right in the inventor only; and that, on condition that his invention was neither known nor used by the public before his application for a patent. If such use or knowledge shall be proved to have existed prior to the application for the patent, the act of 1793 declares the patent void; and, as has been already stated, the right of an alien is vacated in the same manner, by proving a foreign use or knowledge of his invention. That knowledge or use which would be fatal to the patent-right of a citizen, would be equally so to the right of an alien.

The knowledge or use spoken of in the act of 1793 could have referred to the public only, for the provision would be nugatory if it were applied to the inventor himself. He must necessarily have a perfect knowledge of the thing invented, and its use, before he can describe it, as by law he is required to do preparatory to the emanation of a patent. But there may be cases in which a knowledge of the invention may be surreptitiously obtained and communicated to the public, that do not affect the right of the inventor. Under such circumstances, no presumption can arise in favor of an abandonment of the right to the public by the inventor, though an acquiescence on his part will lay the foundation for such a presumption.

In England, it has been decided that if an inventor shall suffer

the thing invented to be sold and go into public use for four months, and, in a later case, for any period of time, before the date of his patent, it is utterly void.

In that country, the right emanates from the royal prerogative; in this, it is founded exclusively on statutory provisions. But the policy in both governments is the same in granting the right and in fixing its limits.

Vigilance is necessary to entitle an individual to the privileges secured under the Patent Law. It is not enough that he should show his right by invention, but he must secure it in the mode required by law. And if the invention, through fraudulent means, shall be made known to the public, he should assert his right immediately, and take the necessary steps to legalize it.

The Patent Law was designed for the public benefit as well as for the benefit of inventors. For a valuable invention, the public, on the inventor's complying with certain conditions, give him, for a limited period, the profits arising from the sale of the thing invented. This holds out an inducement for the exercise of genius and skill in making discoveries which may be useful to society and profitable to the discoverer. But it was not the intention of this law to take from the public that of which they were fairly in possession.

In the progress of society, the range of discoveries in the mechanic arts, in science, and in all things which promote the public convenience, as a matter of course, will be enlarged. This results from the aggregation of mind and the diversity of talents and pursuits which exist in every intelligent community. And it would be extremely impolitic to retard or embarrass this advance, by withdrawing from the public any useful invention or art, and making it a subject of private monopoly. Against this consequence, the legislature have carefully guarded, in the laws they have passed on the subject.

It is undoubtedly just that every discoverer should realize the benefits resulting from his discovery, for the period contemplated by law. But these can only be secured by a substantial compliance with every legal requisite. His exclusive right does not rest alone upon his discovery, but also upon the legal sanctions which have been given to it, and the forms of law with which it has been clothed.

No matter by what means an invention may be communicated to the public before a patent is obtained, any acquiescence in the public use, by the inventor, will be an abandonment of his right. If the right were asserted by him who fraudulently obtained it, perhaps no lapse of time could give it validity. But the public stand in an entirely different relation to the inventor.

## Opinion of the court.

The invention passes into the possession of innocent persons who have no knowledge of the fraud, and, at a considerable expense, perhaps, they appropriate it to their own use. The inventor, or his agent, has full knowledge of these facts, but fails to assert his right. Shall he afterwards be permitted to assert it with effect? Is not this such evidence of acquiescence in the public use, on his part, as justly forfeits his right?

If an individual witness a sale and transfer of real estate, under certain circumstances, in which he has an equitable lien or interest, and does not make known this interest, he shall not afterwards be permitted to assert it. On this principle it is that a discoverer abandons his right if, before the obtainment of his patent, his discovery goes into public use. His right would be secured by giving public notice that he was the inventor of the thing used, and that he should apply for a patent. Does this impose anything more than reasonable diligence on the inventor? And would anything short of this be just to the public?

The acquiescence of an inventor in the public use of his invention, can in no case be presumed where he has no knowledge of such use. But this knowledge may be presumed from the circumstances of the case. This will, in general, be a fact for the jury. And if the inventor do not, immediately after this notice, assert his right, it is such evidence of acquiescence in the public use as forever afterwards to prevent him from asserting it. After his right shall be perfected by a patent, no presumption arises against it from a subsequent use by the public.

When an inventor applies to the Department of State for a patent, he should state the facts truly; and, indeed, he is required to do so, under the solemn obligations of an oath. If his invention has been carried into public use by fraud, but for a series of months or years he has taken no steps to assert his right, would not this afford such evidence of acquiescence as to defeat his application, as effectually as if he failed to state that he was the original inventor? And the same evidence which should defeat his application for a patent would, at any subsequent period, be fatal to his right. The evidence he exhibits to the Department of State is not only *ex parte*, but interested; and the questions of fact are left open, to be controverted by any one who shall think proper to contest the right under the patent.

A strict construction of the act, as it regards the public use of an invention, before it is patented, is not only required by its letter and spirit, but also by sound policy. A term of fourteen years was deemed sufficient for the enjoyment of an exclusive right of an in-

vention by the inventor; but if he may delay an application for his patent at pleasure, although his invention be carried into public use, he may extend the period beyond what the law intended to give him. A pretense of fraud would afford no adequate security to the public in this respect, as artifice might be used to cover the transaction. The doctrine of presumed acquiescence, where the public use is known, or might be known, to the inventor, is the only safe rule which can be adopted on this subject.

In the case under consideration, it appears the plaintiff came to this country, from England, in the year 1817, and, being an alien, he could not apply for a patent until he had remained in the country two years. There was no legal obstruction to his obtaining a patent in the year 1819; but it seems that he failed to apply for one until three years after he might have done so. Had he used proper diligence in this respect, his right might have been secured, as his invention was not sold in England until the year 1819. But in the two following years it is proved to have been in public use there, and in the latter year also in France.

Under such circumstances, can the plaintiff's right be sustained?

His counsel assigns as a reason for not making an earlier application, that he was endeavoring to make his invention more perfect; but it seems by this delay he was not enabled, essentially, to vary or improve it. The plan is substantially the same as was carried into public use, through the brother of the plaintiff, in England. Such an excuse, therefore, cannot avail the plaintiff. For three years, before the emanation of his patent, his invention was in public use, and he appears to have taken no step to assert his right. Indeed, he sets up, as a part of his case, the patent to Forsyth, as a reason why he did not apply for a patent in England.

The Forsyth patent was dated six years before. Some of the decisions of the Circuit Courts which are referred to were overruled in the case of *Pennock & Sellers v. Dialogue*. They made the question of abandonment to turn upon the intention of the inventor. But such is not considered to be the true ground. Whatever may be the intention of the inventor, if he suffers his invention to go into public use, through any means whatsoever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent obtained under such circumstances protect his right.

The judgment of the Circuit Court must be affirmed with costs.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District:

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Syllabus.

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of New York, and was argued by counsel; on consideration whereof, it is adjudged and ordered by this court that the judgment of the said Circuit Court in this cause be, and the same is hereby,

**AFFIRMED WITH COSTS.**

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**HENRY WHEATON AND ROBERT DONALDSON, APPELLANTS, v. RICHARD PETERS AND JOHN GRIGG.**

(8 Peters, 591.)

1. Copyright. From the authorities cited in the opinion of the court, and others which might be referred to, the law appears to be well settled, in England, that, since the statute of 8 Anne, the literary property of an author in his works can only be asserted under the statute; and that notwithstanding the opinion of a majority of the judges in the case of *Miller v. Taylor* was in favor of the common-law right before the statute, it is still considered, in England, as a question by no means free from doubt.
2. That an author at common law has a property in *his manuscript*, and may obtain redress against any one who deprives him of it, or by obtaining a copy endeavors to realize a profit by its publication, cannot be doubted; but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world.
3. The argument that a literary man is as much entitled to the product of his labor as any other member of society, cannot be controverted. And the answer is, that he realizes this product in the sale of his works, when first published.
4. In what respect does the right of an author differ from that of an individual who has invented a most useful and valuable machine? In the production of this, his mind has been as intensely engaged, as long and perhaps as usefully to the public as any distinguished author in the composition of his book. The result of their labors may be equally beneficial to society, and, in their respective spheres, they may be alike distinguished for mental vigor. Does the common law give a perpetual right to the author, and withhold it from the inventor? And yet it has never been pretended that the latter could hold, by common law, any property in his invention after he shall have sold it publicly. It would seem, therefore, that the existence of a principle which operates so unequally may well be doubted. This is not a characteristic of the common law. It is said to be founded on principles of justice, and that all its rules must conform to sound reason.
5. That a man is entitled to the fruits of his own labors, must be admitted; but he can enjoy them only, except by statutory provision, under the rules of property which regulate society, and which define the rights of things in general.
6. It is clear there can be no common law of the United States. The Federal government is composed of twenty-four sovereign and independent States, each of which may have its local usages, customs, and common law. There is no principle which pervades the Union, and has the authority of law, that is not embodied in the Constitution or laws of the Union. The common law could be made a part of our system by legislative adoption.

## Syllabus.

7. When a common-law right is asserted, we look to the State in which the controversy originated.
8. When the ancestors of the citizens of the United States emigrated to this country, they brought with them, to a limited extent, the English common law as part of their heritage. No one will contend that the common law, as it existed in England, has ever been in force in all its provisions in any State in this Union. It was adopted only so far as its principles were suited to the condition of the colonies, and from this circumstance we see what is the common law in one State is not so considered in another. The judicial decisions, the usages and customs of the respective States, must determine how far the common law has been introduced and sanctioned in each.
9. If the common law, in all its provisions, has not been introduced into Pennsylvania, to what extent has it been adopted? Must not this court have some evidence on the subject? If no copyright of an author, in his work, has been heretofore asserted there, no custom or usage established, no judicial decisions been given, can the conclusion be justified that, by the common law of Pennsylvania, an author has a perpetual property in the copyright of his works? These considerations might well lead the court to doubt the existence of this law; but there are others of a more conclusive character.
10. In the eighth section of the first article of the Constitution of the United States, it is declared that Congress shall have power "to promote the progress of science and the useful arts, by securing, for a limited time, to authors and inventors, the exclusive right to their respective writings and inventions." The word "secure," as used in the Constitution, could not mean the protection of an acknowledged legal right. It refers to inventors as well as authors, and it has never been pretended by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented.
11. It is presumed that the copyright recognized in the act of Congress, and which was intended to be protected by its provisions, was the property which an author has, by the common law, *in his manuscript*, which would be protected by a court of chancery; and this protection was given as well to books published under the provisions of the law as to manuscript copies.
12. Congress, by the act of 1790, instead of sanctioning an existing perpetual right in an author in his works, created the right secured for a limited time by the provisions of that law.
13. The right of an author to a perpetual copyright does not exist by the common law of Pennsylvania.
14. No one can deny that where the legislature are about to vest an exclusive right in an author or in an inventor, they have the power to provide the conditions on which such right shall be enjoyed; and that no one can avail himself of such right, who does not substantially comply with the requisites of the law. This principle is familiar as it regards patent-rights; and it is the same in relation to the copyright of a book. If any difference should be made, as respects a strict conformity to the law, it would seem to be more reasonable to make the requirement of the author rather than of the inventor.
15. The acts required by the laws of the United States to be done by an author to secure his copyright, are in the order in which they must naturally transpire. First, the title of the book is to be deposited with the clerk, and the record he makes must be inserted in the first or second page; *then the public notice in the newspapers is to be given; and within six months after the publication of the book a copy must be deposited in the Department of State.*

## Statement of the case.

16. It has been said these are unimportant acts. If they are, indeed, wholly unimportant, Congress acted unwisely in requiring them to be done. But whether they are unimportant or not, is not for the court to determine, but the legislature; and in what light they were considered by the legislature, the court can only know by their official acts. Judging of those acts by this rule, the court are not at liberty to say they are unimportant, and may be dispensed with. They are acts which the law requires to be done; and may this court dispense with their performance?
17. The security of a copyright to an author, by the acts of Congress, is not a technical grant of precedent and subsequent conditions. All the conditions are important; the law requires them to be performed; and, consequently, their performance is essential to a perfect title. On the performance of a part of them, the right vests; and this was essential to its protection under the statute, but other acts were to be done, unless Congress have legislated in vain, to render his right perfect. The notice could not be published until after the entry with the clerk; nor could the book be deposited with the Secretary of State until it was published. But they are acts not less important than those which are required to be done previously. They form a part of the title; and until they are performed the title is not perfect.
18. Every requisite, under both the acts of Congress relative to copyrights, is essential to the title.
19. The acts of Congress authorizing the appointment of a reporter of the decisions of the Supreme Court of the United States, require the delivery of eighty copies of each volume of the reports to the Department of State. The delivery of these copies does not exonerate the reporter from the deposit of a copy in the Department of State, required under the copyright act of Congress of 1790. The eighty copies delivered under the reporter's act are delivered for a different purpose, and cannot excuse the deposit of one volume as especially required by the copyright acts.
20. No reporter of the decisions of the Supreme Court has, nor can he have, any copyright in the written opinions delivered by the court, and the judges of the court cannot confer on any reporter any such right.

APPEAL from the Circuit Court of the United States for the Eastern District of Pennsylvania.

The case, as stated in the opinion of the court, was as follows:

“The complainants, in their bill, state that Henry Wheaton is the author of twelve books or volumes of the reports of cases argued and adjudged in the Supreme Court of the United States, and commonly known as ‘Wheaton’s Reports,’ which contain a connected and complete series of the decisions of said court from the year 1816 until the year 1827. That before the first volume was published, the said Wheaton sold and transferred his copyright in the said volume to Mathew Carey, of Philadelphia, who, before the publication, deposited a printed copy of the title-page of the volume in the clerk’s office of the District Court of the Eastern District of Pennsylvania, where he resided. That the same was recorded by the said clerk according to law, and that a copy of the said record was caused by said Carey to

## Statement of the case.

be inserted at full length in the page immediately following the title of said book. And the complainants further state, that they have been informed and believe that all things which are necessary and requisite to be done in and by the provisions of the acts of Congress of the United States passed the 31st day of May, 1790, and the 29th day of April, 1802, for the purpose of securing to authors and proprietors the copyrights of books, and for other purposes, in order to entitle the said Carey to the benefit of said acts, have been done.

“It is further stated, that said Carey afterwards conveyed the copyright in said volume to Mathew Carey, Henry C. Carey, and Isaac Lea, trading under the firm of Mathew Carey & Sons; and that said firm, in the year 1821, transferred the said copyright to the complainant, Robert Donaldson. That this purchase was made by an arrangement with the said Henry Wheaton, with the expectation of a renewal of the right of the said Henry Wheaton under the provisions of the said acts of Congress, of which renewal he, the said Robert Donaldson, was to have the benefit until the first and second editions of the said volume which he, the said Donaldson, was to publish, should be sold. That at the time the purchase was made from Carey & Sons, a purchase was also made of the residue of the first edition of the first volume which they had on hand; and in the year 1827 he published another edition of said volume, a part of which still remains unsold.

“The bill further states, that, for the purpose of continuing to the said Henry Wheaton the exclusive right, under the provisions of the said acts of Congress, to the copy of the said volume for the further term of fourteen years, after the expiration of the term of fourteen years from the recording of the title of the said volume in the clerk's office as aforesaid, the said Robert Donaldson, as the agent of Wheaton, within six months before the expiration of the said first term of fourteen years, deposited a printed copy of the title of the said volume in the clerk's office of the District Court of the Southern District of New York, where the said Wheaton then resided, and caused the said title to be a second time recorded in the said clerk's office; and also caused a copy of the said record to be a second time published in a newspaper printed in the said city of New York, for the space of four weeks, and delivered a copy of the said book to the Secretary of State of the United States; and that all things were done agreeably to the provisions of the said act of Congress of May 31, 1790, and within six months before the expiration of the said term of fourteen years.

“The same allegations are made as to all the other volumes which



have been published: that the entry was made in the clerk's office, and notice given by publication in a newspaper, before the publication of each volume; and that a copy of each volume was deposited in the Department of State.

"The complainants charge that the defendants have lately published and sold, or caused to be sold, a volume called 'Condensed Reports of Cases in the Supreme Court of the United States,' containing the whole series of the decisions of the court, from its organization to the commencement of Peters's Reports at January Term, 1827. That this volume contains, without any material abbreviation or alteration, all the reports of cases in the said first volume of Wheaton's Reports, and that the publication and sale thereof is a direct violation of the complainants' rights, and an injunction, &c., is prayed.

"The defendants, in their answer, deny that their publication was an infringement of the complainants' copyright, if any they had; and further deny that they had any such right, they not having complied with all the requisites to the vesting of such right under the acts of Congress."

The bill of the complainants was dismissed by the decree of the Circuit Court, and they appealed to this court.\*

The case was argued by *Mr. Paine* and *Mr. Webster*, for the appellants; and by *Mr. Ingersoll*, by a printed argument, and *Mr. Sergeant*, for the defendants.

*Mr. Paine, for the appellants, contended:*

1. An author was entitled, at common law, to a perpetual property in the copy of his works, and in the profits of their publication; and to recover damages for its injury, by an action on the case; and to the protection of a court of equity.

The laws of all countries recognize an author's property in his productions. In England, beyond all question, an author had, at common law, the sole and exclusive property in his copy. This was decided in *Miller v. Taylor*, 4 Burr., 2303. This property was placed by its defenders, and they finally prevailed, upon the foundation of natural right—recognized by the laws, ordinances, usages, and judicial decisions of the kingdom, from the first introduction of printing.

The opponents of literary property insisted that an author had no

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\*The case was decided in the Circuit Court by Judge HOPKINSON, Mr. Justice BALDWIN having been absent on the argument and decision thereof.

The opinion of Judge Hopkinson is inserted in the Appendix, No. 11.

natural right to his copy; and, resorting to those laws which are supposed to have governed property before the social compact, they maintained that because the copy was incapable of possession it was impossible to have property in it. Mr. Justice Yates, the great opponent of literary property, and who has probably said all that ever was or can be said against it, urges that it is impossible to appropriate ideas more than the light or air, (4 Burr., 2357, 2365,) forgetting that books are not made up of ideas alone, but are, and necessarily must be, clothed in a language and embodied in a form which give them an individuality and identity that make them more distinguishable than any other personal property can be. A watch, a table, a guinea, it might be difficult to identify; but a book, never. Cited Blackstone's Commentary and Christian's notes, to show the nature of literary property.

The court are referred to the able opinions of Willis, J., Aston, J., and Lord Mansfield, in *Miller v. Taylor*, 4 Burr., 2310, 2335, 2395. They agreed not only that an author had a property at common law, but that it was perpetual, notwithstanding the statute of Anne.

Not long after that decision, however, the question as to the perpetuity of an author's property was brought before the House of Lords; and it was there decided that it was not perpetual, its duration being limited by the statute of Anne. Yet, even upon this point the twelve judges were equally divided, (if we include Lord Mansfield, who did not vote, as he was a peer,) and there were eleven out of twelve who maintained that an author had a property at common law in his copy. See *Donaldson v. Beckett*, 4 Burr., 2408; 2 Br. P. C., 129.

The decrees of the star chamber show that that court admitted and protected authors, as early as 1556. Maugham, 12, 13. Ordinances of Parliament, as early as 1641, recognize and protect the owner's property in his copy. These ordinances were several times repealed. Maugham, 13, 14. In 1662 and 1679, acts of Parliament were passed, prohibiting any person from printing, without the consent of the owner of the copy. Maugham, 15, 16.

In the reign of Charles II, there were several cases in the courts in which the ownership of the copy by authors is treated as the ancient common law, and in one case (the case in Croke's Reports) the right of the author was sustained even against the claim of the king's prerogative to publish all law-books. Chief Justice Hale presided. Maugham, 19; 4 Burr., 2316.

Notwithstanding the strong and explicit terms of the statute of Anne, both as to vesting the author with his right, and limiting its duration, (terms not to be found in our act,) the courts, by an unin-

## Argument for the appellants.

interrupted series of decisions, from the passing of the statute down to the case of *Donaldson v. Beckett*, maintained that an author still had his original perpetual common-law right and property; and we have seen that had Lord Mansfield voted in that case the twelve judges would have been equally divided.

For a review of the common-law property of an author, and of the legislation upon the subject, in England and the United States, cited *The American Jurist*, vol. 10, p. 61, &c., No. for July, 1833.

2. The common-law property of an author is not taken away by the Constitution of the United States. The States have not surrendered to the Union their whole power over copyrights, but retain a power concurrent with the power of Congress; so far that an author may enjoy his common-law property, and be entitled to common-law remedies, independently of the acts of Congress. It is one of those concurrent powers, where the power of the State ceases only when it actually conflicts with the exercise of the powers of Congress.

In the constitutional clause relating to the rights of authors and inventors, there are two subjects, distinct enough in themselves, and only united by the form of expression. This comprehensiveness of expression, we know, belongs to the Constitution, and that the aim of its framers was brevity. The expression is not so important, for in that instrument we are to look for substance and intention.

Although united in this clause, and for the same purpose of being secured by Congress, the subjects of patents and of copyrights have little analogy. They are so widely different that the one is property; the other a legalized monopoly. The one may be held and enjoyed without injury to others; the other cannot, without great prejudice. The one is a natural right; the other in some measure against natural right.

But because they both come from invention or mental labor, and, in addition, because they are so joined in the Constitution, we have become accustomed to regard them as in all respects alike, and equally dependent on the legislative favor for existence and protection.

Upon this point, the counsel for the appellants argued at large that the principles which applied to copyrights were different from those which regulated the property of inventions secured by a patent; that they were inserted in the clause of the Constitution for brevity and comprehensiveness; that the framers of the Constitution probably designed to give Congress the complete and exclusive power over patents; but it did not follow, from this, that the same was introduced in relation to copyrights.

It is important to examine the true rules of construction which are applicable to this clause in the Constitution.

This is the first instance in which this court has been called upon to pronounce whether the power given in this clause is an exclusive or a concurrent power, or as to the extent of the power conferred by it on Congress. Consequently, the rules established as to the construction of that instrument have all been in relation to other powers, and powers of a very different character.

All the other powers in the Constitution conferred on Congress, or yielded by the States, are national or political, and for national and political purposes. This is the only instance of a power being conferred, unless incidentally, over private property. This is a power over private property, not incidental to a national power, but with an immediate, primary, and single reference to the property. The rule of construction as to the grant of the political and national powers may not be suited to this. It has been held, as to them, that a rule of strict construction was not to be adopted.

But the question here is as to private right. And the question is whether the Constitution takes away a private right, or property, at common law. And why should we not apply the same rule of construction to such a constitutional provision as we do to a statute in derogation of common-law right? The rule is, that such statutes are to be construed strictly, because they abridge the right. The reason of the rule extends to the Constitution, whenever it is in derogation of common right. For this rule, see 10 Mod., 282; 4 Bac. Ab., 550, 650.

Other common-law rules in relation to statutes affecting private rights, or common-law rights, would seem to be peculiarly applicable to this clause of the Constitution, although they may not be generally referred to as guides in construing the Constitution. These will be found in 1 Bl. Com., 87; 1 Inst., 111, 115; 1 Bl. Com., 89; Plowd. Rep., 206; 13 Mod., 118; Plowd., 113; 1 Bac., 11, 18, 38; 1 Bac., 3, 5; 2 Burr., 803, 805; Com. Dig., Action on Stat. C. G.; Salk., 212; 19 Vin. Ab. Stat., E. 6; 1 Story's Com., 384, 387, 397, 401, 411, 436; *Martin v. Hunter*, 1 Wheat. Rep., 326, 410.

With these general guides of construction, it is inquired whether the power granted to Congress by the Constitution transfers the whole subject of property of authors to the exclusive authority and control of Congress, so that the property of an author ceases to exist at all, without the legislation of Congress, or whether it leaves the author in the enjoyment of his property, as he had it before the adoption of the Constitution, and merely attempts to improve what was supposed to be an imperfect enjoyment, by authorizing Congress to secure it.

This is not the question whether the power is concurrent or exclu-

## Argument for the appellants.

sive. If the author's common-law property is not taken away, nor made wholly dependent upon the legislation of Congress, but if Congress possess the mere partial power to secure it, then the property remains as at common law, subject to State legislation, and the auxiliary legislation of Congress. The question now is simply as to a right of property. If we take the rules above cited from Mr. Justice Story's Commentaries as guides of interpretation, can there be a question as to the nature of the delegation of power, or its extent or amount? The delegation is to secure exclusive rights,—not to grant property or confirm property, or grant rights or confirm or establish rights, but to secure rights.

We are willing to admit that this language is broad enough, and is adapted to transfer to Congress the whole legislation and control over patents. There is, at common law, no property in them; there is not even a legal right entitled to protection. They have a moral or equitable right, but unknown to the law. Congress, therefore, when authorized to secure their rights, are authorized to do everything; and full power over the subject is delegated to them.

But it does not follow, that because Congress are authorized to create *de novo*, and to secure the right to patents by mere force of the word *secure*, that they are therefore authorized by force of that word to create *de novo*, and then secure copyrights. For a very different process would then take place in relation to the two things. In creating patents, they take nothing away. They deprive the inventor of no property. He had nothing, and they gave him all merely by securing. But if by the word *secure* they are authorized to give an author all that he is afterwards to possess, the operation effects a total deprivation of his common-law property. So that to allow the word "secure" to confer the same power over copyrights as over rights to inventions, is to make it a word of a totally different meaning and import in the one case from the other. The language is not broad enough, nor is it adapted to the taking away of property or preëxisting rights. We are, therefore, to reject the argument that a copyright must exist and be held solely under the Constitution, because patent-rights must be.

What is there, then, in the delegation of the power to *secure* an author's exclusive rights, which should be construed to deprive him of his property, and make him dependent wholly on the security provided? Are not the words in themselves plain and clear?—and is not the sense arising from them distinct and perfect? And if so, is interpretation admissible?—and if not, is not the question settled? For it never can be pretended that the naked words, authorizing Congress

to secure rights, take away or affect the property in which those rights exist.

There would seem to be nothing, therefore, in the plain meaning of the word *secure*, which should alter, affect, or take away an author's property in his writings. Indeed, it seems too plain to admit of argument, that when the Constitution authorizes Congress to secure an acknowledged preëxisting right, and does not authorize them to grant it, it is an express declaration that it subsists, and is to subsist, independently of their power.

But it may be said that all the author can ask or have is security for his rights, and that this is all he had at common law, and that the constitutional clause does not take away his security, or any part of it, but only transfers to Congress the power and duty to secure him which before belonged to the States.

We answer, that if this construction is derived from the import of the words themselves, it is strained beyond all bounds allowed by the rules of construction. There is the strongest reason to believe, from the language of the Constitution, that those who framed it, adopted it with a particular view to preserve the common-law right to copy-rights untouched. If this clause in the Constitution is to be construed as taking away the author's common-law right, it deprives him of a part of the security he had at common law, and does more than merely transfer to Congress a power and duty which before belonged to the States. It is, then, asked whether the word *secure* can be found to possess any such meaning as to take away, and diminish, and disturb, either by common law or constitutional rules of construction.

The meaning of the clause of the Constitution, when tried by the usual rules of interpretation, is shown to be as contended by the appellants. Cited, 19 Viner's Abr., 510, E. 6; and see 2 Inst., 2d ed.; Plowden, 113; 1 Ch. Pl., 144; *Almy v. Harris*, 5 Johns. Rep., 175; *The President, &c., of the Farmers' Turnpike Road v. Coventry*, 10 Johns. Rep., 389.

Chief Justice MARSHALL (12 Wheat., 653, 654) lays great stress on the framers of the Constitution having been acquainted with the principles of the common law, and acting in reference to them. Most of them were able lawyers, and certainly able lawyers drew up and revised the instrument. Are we, then, to believe that if they had any design to take away the common-law right, or to authorize Congress to take it away or to impair it, they would, knowing the rules of construction cited, and like common-law maxims, have used the language they have? There is the strongest reason to believe, from the language, it was adopted for the purpose of preserving it, and to re-

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serve from Congress any power over it. This probability arises almost irresistibly from the language used, and under the circumstances that it was used.

The case of *Donaldson v. Beckett* was decided in the House of Lords in 1774. This case, and all the law on this subject discussed and decided by it, must have been known to the lawyers of the convention. The opinion of the judges in the case of *Miller v. Taylor* must also have been familiar to them.

From the statute of Anne, then, down to 1774, there had been in England a continual contest about the words of that statute, and whether it was a statute to secure a right already existing. It agitated the literary world especially, because it belonged to them; and it agitated the courts. Cases of unequalled importance arose out of, and were decided upon, the use of these words. Yeates, J., calls the case of *Miller v. Taylor* a case of "great expectation." This case occurred in 1769, and immediately followed the still greater case of *Donaldson v. Beckett*, in which the twelve judges gave each an opinion in the House of Lords. These cases, therefore, occurred and were reported a few years before the adoption of the Constitution.

Had the convention designed to take away, or to authorize Congress to take away, the common-law property, they would have used the words *vest* or *grant*, and would have carefully avoided the word *secure*.

But what reason can be discovered why the framers of the Constitution should wish or intend to take away, or authorize Congress to take away, the common-law right? What was the mischief they had in view?

Will it be said that the public have rights as well as the author, and that it is impolitic to allow a perpetual right? Suppose we grant it. Yet, what has the Constitution to do with a mischief like this? It does not require a national power to cure it. The States were fully adequate to provide a remedy themselves; and the States gave Congress no powers which they could as well exercise themselves. Will it be pretended that the States could not regulate, limit, or take away the right within their own territories, and that it was necessary to empower Congress to do it?

Will it be said that it was designed to take from the States their power over copyright, lest, if a State were to protect the rights of authors, the citizens of other States might be curtailed of their rights within that State? The answer is obvious: No person can have any rights opposed to the author's. He has the property, and it cannot stand in the way of another's property or rights. Besides, the objec-

tion goes to the whole of State legislation on any subject; for a State may, by its laws, curtail or affect the rights of citizens of other States in other particulars; and why be so careful to prevent them in this? As we have already shown, copyrights have, in these respects, none of the mischiefs attending them which attend a right to inventions.

There could be but one possible motive for making copyrights a national concern, and that was because the States might not, or could not, individually, afford them a just protection. From this single motive, what intention are we to infer? That, and that only, apparent on the face of the Constitution—an intention to secure the right.

Why is it, however, that if the public good was had in view by the framers of the Constitution, and not the author's benefit singly, either as regards patents or copyrights, that they did not undertake to guard the citizens of the several States against the protection which the States might afford to inventions introduced from abroad? For that, as well as for the printing of foreign books, a State might, if it chose, grant monopolies. But this, and other mischiefs to spring from State legislation, it was thought proper to provide against.

It is contended that the case of copyrights is one within the concurrent powers of the United States and the States. It is not within either of those kinds of exclusive powers enumerated in *The Federalist*, (No. 34,) but belongs to the other class of powers.

What is the power here? A power to *secure* the right of authors. And the question is whether the States may not protect and enforce the common-law right, while the United States secure it. Is such a power totally and absolutely contradictory and repugnant? Is it not, on the contrary, perfectly consistent with the other? It is as consistent as a common-law remedy is with a statute remedy—it is the same thing. Both may exist and act in concert, and no conflict can occur, unless the State undertakes to deprive an author of what Congress has secured to him. If that were a reason for taking away the State power, it would be a reason for depriving them of all power; for, so long as they have power to legislate, they can pass laws to interrupt those of Congress. It is impossible to imagine a case where a power of Congress could receive so little interruption from the legislation of the States, because this is a power primarily over private right, and not for national purposes; and it is the only one of the kind in the Constitution.

The opinions of this court have been uniform, that a concurrent power, in cases like this, might exist and be exercised by the States. See *Houston v. Moore*, 5 Wheat. Rep., 48 to 56; and also Mr. Justice Story's Commentaries, 421 to 433.



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It is believed that if the States have resigned to Congress their power over copyrights, and have none remaining in themselves, yet that they have given the power to Congress with a qualification and limitation, and have confined it in their hands, as they had power to do, simply to securing the right of the author. If they have any power besides this, it is merely to abridge the period.

Next. Have Congress impaired the author's rights? That is, supposing the common-law remedies to be gone, and that the author can have no remedy unless he has published the record and deposited the copy in the Secretary of State's office.

It is answered that they have, most essentially. They have entirely changed, and unnecessarily, the whole title which an author had at common law, and the evidence on which it rested. They have taken from him the natural common-law title, and the evidence to support it, and have given him one of a most artificial and difficult character. And is not a man's title to property, his evidence of ownership, a part of the property itself, a part of its value? Is it not this which distinguishes real from personal estate, in some measure, and gives it a higher character? Suppose a man were to lose his title-deeds, or one of them, what would be the value of his property?

What title had a man before the statute, and what has he now? Before the statute, it was sufficient for him to prove himself the author. This he could do by proof in pais, in a thousand ways. The proof of this is easy and imperishable, because it is the natural proof. The name of the author on the book, possession and claim of title alone, or first publication, would be, *prima facie*, sufficient evidence. And these are inherent and inseparable from almost every case, as a part of its natural incidents.

But suppose he must, as is contended, prove a compliance with the requisites of the statutes. He is driven from all his safe and easy common-law proof. There can be no such thing as *prima facie* evidence offered. Must he prove the publication for four successive weeks, forty-two years after it was made? Is he to keep a file of newspapers? and if he does, what proof has he of publication? How is he to prove the delivery of the volume? The law provides for no record. He must call a witness, and then he cannot be safe for forty-two years, unless he files a bill to perpetuate testimony. The evidence in the case establishes the difficulty of such proof. Can a statute, which thus loads a right with burdensome and needless regulations, and makes it wholly dependent on accidental mistake or omission, where it was free from them both, be said not to impair an author's common-law right of property?

If, then, Congress have not the power to impair the author's property, and if the requisites as to publication and delivery of the copy, if made conditions precedent, do impair it, they are so far unconstitutional, and the appellants have a right to claim the benefit of the act without performing them.

4. A citizen of one State has the same common-law property in his copy in other States as the citizens of these States can have; and the common property exists in the State of Pennsylvania; consequently, the complainants are entitled to a copyright at common law in that State, and can have a remedy in the Circuit Court of the United States for its violation, independently of the provisions of the act of Congress, the citizenship of the parties giving the State jurisdiction.

The Constitution of the United States provides that "the citizens of each State shall be entitled to all privileges and immunities of citizens of the several States."

The Constitution, by this provision, designed to make, and does, in fact, make us one nation, living under the same laws. It designed to give to all the citizens of the United States not merely the benefits and privileges secured to them by national laws, but the benefits of all the laws of all the States, and the privileges conferred by them. Under this provision, a citizen of New York has all the privileges of the laws of Pennsylvania, whatever they may be.

It is this provision which makes us one nation, and this only. It is this alone which gives to all the citizens of the United States uniform and equal civil rights throughout all the territories of the nation. Other constitutional provisions secure political advantages; but without this we should be a mere league, and not a nation. We should be several distinct nations. Vattel says (p. 159, book i, ch. 19): "The whole of a country possessed by a nation, and subject to its laws, forms, as we have said, its territories, and it is a common country of all the individuals of the nation."

In this sense of a nation, this provision of the Constitution makes us one, and makes all the States the common country of all the individuals of the nation.

An author, then, who is a citizen of one of the States, is entitled to have his property in his copy protected in every other State, according to the laws of such State, without the aid of any national law. The only question is, do the laws of the State give an author a property in his copy? For if they do, who shall say he is not entitled to enjoy his property under such laws as much as any other kind of property? Has not a citizen of New York a right to hold lands or any other kind of property under the laws of Pennsylvania? And if that State were

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to attempt to deprive him of the same rights as her own citizens enjoy, would it not be a violation of this clause of the Constitution? The truth is, a citizen of New York is, so far as all his civil rights and privileges are concerned, a citizen of Pennsylvania. See Mr. Justice Story's Commentaries, 674, 675.

An author's copyright at common law exists in Pennsylvania.

The American colonies brought hither, as their birthright and inheritance, the common law, so far as it was applicable to their situation. Judge CHASE, in *United States v. Worrall*, 1 Dall. Rep., 384.

Chief Justice M'KEAN, in 1 Dall. Rep., 67, says the common law has always been in force in Pennsylvania. Statutes made before the settlement of the province have no force, unless convenient and adapted to the circumstances of the country; all made since have no force, unless the colonies are named. See also page 74.

There never was a statute in Pennsylvania relative to copyright, and the statute of Anne was passed after the settlement of that State. The common law therefore prevails there.

5. The publication of the record in the newspapers, and the delivery of the copy to the Secretary of State, are not made conditions precedent at all by the acts of Congress, or, if at all, only as to the right to the security provided by the acts. A non-observance of the statutory directions in these particulars does not deprive the author of the ordinary remedies, by an action on the case and bill in equity. Besides, the publication of the record and delivery of the copy were at most intended only as a means of notice of the author's right; and actual notice, in this case abundantly shown, dispenses with those modes of constructive notice.

After stating the particular provisions of the act of 1790, the counsel proceeded to argue that, on the proper construction of the act, the publication of the record or the delivery of the copy is not in any way connected with the right; and the delivery of the copy has nothing to do even with the penalties and forfeitures imposed by it. The provisions of the act are, in some respect, similar to those of the statute of Anne, and it must have been drawn with reference to it. Congress, by this law, did not think proper to impose all the penalties which are found in the act of Anne, because they were engaged in discharging their constitutional power of *securing* the author's right.

The copy to the Secretary of State is a mere donation from the author. Congress give him no equivalent for it. The clerk is paid for the record, and what do government give the author for the copy but security? Have they a right to sell the security—to put a price

on the exercise of their constitutional powers? What right does the Constitution give them to require a donation from the author? And will it be believed that they intended to forfeit his property if he did not furnish it?

The month which may elapse after the right attaches, and before publication, and the six months before depositing the copy, show that these things are not conditions precedent.

Natural rights are generally known by their own incidents. Property always carries with it its own indicia of ownership, and literary property not less than any other. The superaddition of record evidence, the highest known to law, and all that is required of ownership of real estate, was probably deemed sufficient by Congress; and they therefore required no other of the right of an author. It would be a fair presumption that, when they had required enough, they would not go on to require a superfluity.

But the publication of the record and delivery of the copy have been held, by a very numerous, learned, and able court, on full argument, (the court of errors, in Connecticut, composed of the twelve judges,) to be only directory, and to have nothing to do with the author's right. *Nicholas v. Ruggles*, 3 Day's Rep., 145.

But it is said that, although the publication and delivery of the copy are not conditions precedent by the act of 1790, they are made so by the act of 1802; and that this has been decided in the case of *Ever v. Coxe*, 4 Wash., 487, as to the publication of the record!

The counsel then proceeded to comment on the decision of Mr. Justice WASHINGTON, in the case referred to, denying that the language said by him to be contained in the first section of the act of 1802 was contained in it, and asserting that the meaning of the words used in the section had been strained by the judge. He contended that the act of 1802 was not intended to operate on the provisions of the preceding law, but only to refer to them as established by that law. There is no enacting language in the latter law; and without enacting language, it can be no enactment.

It is the duty of this court, before it allows property to be sacrificed, even if the words of an act are clear and free from doubt on their face, to look carefully at the intention of the legislature, to look at the spirit of the law and its consequences, and at the old law, the mischief and the remedy.

The counsel then went into an examination of both the statutes; for the purpose of showing that, applying these principles, the construction of those acts should be such as was maintained by the appellants. In the course of this examination, he cited 19 Vin. Abr., 510, E. 6;

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Plowd., 111; 2 Institutes, 200; 1 Bl. Com., 87; *University v. Beyer*, 16 East, 316; *Postmaster-General v. Early*, 12 Wheat., 148.

The act of 1802 does not make the publication and delivery conditions precedent, because it is impossible they should be so. The first act vests the right on recording the title. It then gives two months to publish the record, and six months to deliver the copy. A condition precedent is an act to be done precedently, and it is impossible to publish the record until the record is first made, and the right attaches on making the record.

The act of 1802 declares that the author, "before he shall be entitled to the benefit of the act" of 1790, shall, "in addition to the requisites," &c. Now, what was the benefit of that act? It is entitled an act to secure the author's right, and the power of Congress is to secure the right; *i. e.*, an existing right. How does the act secure the right? Only by penalties and forfeitures. It gives no action on the case, no bill in equity; and if it had given them, it would have been as to them wholly inoperative, for no court had jurisdiction of them. What, then, was meant by—what, in fact, was—the "benefit of that act"? Certainly the penalties and forfeitures;—nothing else. We claim the benefit of the act of 1819, which expressly gives a bill in equity, and the Circuit Court jurisdiction.

It is in vain to say that the acts in question are conditions precedent to the right. The right itself is recognized by the Constitution and law as an existing right; and the right is not given by the act, but is only secured by it. The security, as we have shown, is the penalties and forfeitures, which we do not now claim. The action on the case is a remedy founded on the right, and not on the statute, which gives none. And this bill is founded on the right, and on the act of 1819. We, therefore, get neither the right nor remedy from the act of 1790; and what benefit do we claim from it?

In support of the construction thus contended for, were cited, Rules of Construction found in 6 Bac. Abr., 379, Statute 1, pl. 1; 383, pl. 4, 5; 387, pl. 6; 391, pl. 10; 19 Vin. Abr., 519, Statute E. 6, pl. 86; 520, pl. 96; 525, pl. 129; 524, pl. 119; 528, pl. 156; 5 Vin. Abr., Condition, 2 a. pl. 2, 3, 4, 5; 528, pl. 154, 158.

It is agreed that the object of the requisites in the act is to give notice, and statutes, however strong their language or positive their enactments, which require things to be done for notice, are held not to apply, and that their provisions need not be complied with where actual notice is proved. Such are the registry acts and other similar acts, which declare that instruments shall be absolutely void if not recorded. *Le Nevé v. Le Nevé*, 2 Atk. Rep., 650; *Jackson ex dem. v.*

*Burgett*, 10 Johns. Rep., 460; *Jackson ex dem. v. West*, 10 Johns. Rep., 466.

It is fully shown by the evidence that the defendant had notice, and a part of that evidence shows that the claim of the appellant, Mr. Wheaton, was admitted.

The rule is, that the provisions of the registry acts do not apply except in cases of *bona fide* purchasers. What is *bona fide* purchaser? A purchaser without notice—no matter what his property, or his attempt to get it, has cost him. Is Mr. Peters a *bona fide* purchaser?

It is objected that the record of some volumes is taken out as author and proprietor. In answer, we say it is the clerk's duty to make out the record; and we cannot be held to forfeit our property because he has not done it correctly.

But the record is right. As author, and not having parted with the right, Mr. Wheaton was also proprietor. The act is adapted to a proprietor as well as author, and to enable a proprietor who is not the author to secure a copyright. In our case, Mr. Wheaton is described as author, and the superaddition of proprietor is mere surplusage.

6. The directions of the acts of Congress as to the publication of the record and delivery of the copy to the Secretary of State, and the renewal of the right of the first volume, have been complied with; and the complainants have offered all the proof they are bound to offer of those facts.

In support of these positions, the counsel referred to the evidence in the record.

As to the delivery of copies to the Secretary of State, he stated that the law is silent as to any proof. It directs no memorandum of the deposit to be made. The presumption, therefore, is, that none is made; and, in fact, they did not begin to make any until about the close of these volumes.

It appears that certificates were given, sometimes, latterly. But the law does not direct them, does not know them; and why should one take them? Would they be evidence of anything if he had them? And Mr. Brent proves the greatest irregularity as regards certificates and memoranda. Mr. Carey proves the same thing.

But the law does say that the Secretary of State shall preserve the copies in his office. This, then, is the evidence required by law, that the volumes have always been in his office, since within six months of their publication. And this is proved by Mr. Brent's deposition. The volumes are and have been there. It is for them to show that they were not placed there by us under the law.

How can we prove, by parol, facts which occurred from sixteen to

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seventeen years before the proof taken in this cause? The proof must be parol, and such proof the law presumes to be out of men's power after the lapse of six years. Without the copies having actually been found there, the law would presume that an act enjoined by law to be performed, was performed after such a lapse of time. It would presume it in favor of right and natural justice against a wrong-doer. See a case of presumption even of the enrolment of articles of apprenticeship against positive evidence to the contrary. *The King v. The Inhabitants of Long Buckley*, 7 East, 45.

But we have proved positively, by the evidence of Mr. Brent, that eighty copies of every volume were delivered, under the reporter's salary act, within the six months after publication. The four acts of Congress allowing the reporter his salary, also provide that he shall within six months deliver eighty copies to the Secretary of State, one of which he is to keep and transmit to his successor in office, of course to be preserved in the office.

The fact is, that eighty-one copies were sent, but the law giving the salary not requiring more than eighty, the papers in the department under these acts speak of but eighty; and all being sent to the department together, is the reason why there was no minute, or memorandum, or certificate, as in some cases under the copyright law.

And is not this within the letter of the copyright law, the delivery of the eighty copies alone? And if we have complied with the letter of the law, ought it not to save us from a forfeiture of our property? Is it not within the spirit of the law? The judge in the court below insists it is for notice; the counsel insist it is for notice. And is it not as good notice if it is there under one law as under the other? But the judge who decided the case below says that it is not required, under the salary law, to be kept in the office. It is submitted that it is as much required to be kept there under one law as another. At all events, the condition, if it be a condition precedent, is substantially performed by it; and this, as has been shown, is sufficient.

The copyright for the first volume of Wheaton's Reports was renewed in New York, the place of residence of the author. This was done before the publication of any volume of the Condensed Reports, containing any of the matter in Wheaton's Reports. Mr. Wheaton had not parted with his property in them, and by the third section of the act of 1790 it is required that the title shall be deposited and the record made in "the clerk's office of the District Court where the author shall reside."

Law reports, like other books, are objects of literary property; and Mr. Wheaton was the author of the reports in question in this case, and

entitled to the copyright in them. The other complainant, Mr. Donaldson, has a limited property in the copy, by assignment from Mr. Wheaton.

It was never doubted in England that law reports were the subject of copyright. The only question was, whether the prerogative of the crown did not monopolize all law-books, so as to exclude an author's right. Cited, in support of this point, *Roper v. Streater*, Skin. Rep., 234; 4 Burr., 2316, 2403; *Tonson v. Walker*, 3 Swanston, 673; 3 Ves., 709; 2 Bro. Parl. Cases, 100.

The prerogative right, however, is now abandoned, and has long been, in England. Maugham, 101, says "it is now treated as perfectly ridiculous." Godson says the same thing. Patents, 322, 323. See 4 Burrows, 2415, 2416, as to the reason of the prerogative. It there appears the king introduced printing into England.

It is not necessary, however, to produce cases to prove a right so obvious, until cases are produced or principles established which show that it does not exist. There are necessarily but few cases, because the right has not been questioned. One fact is enough, without cases. We know the great price of law reports in England, and we know, of course, that but one person does publish, viz., the proprietor; that there are never contemporaneous editions of the same reports; that a single whole edition is exhausted before another is published, and sometimes lasts half a century. Why is this? Who prevents enterprise and cupidity from participating in this field? What can it be except the copyright?

As to the objection that the matter of which the report is composed is not original, we answer this is wholly unnecessary in copyright. There is no analogy in that respect between copyrights and patents. A man who makes an encyclopedia may have a copyright, although he does not write a word of it. And in *Carey v. Kearsley*, 4 Esp. Rep., 168, where it was attempted to show that the survey in which the copyright was claimed was made at the expense of the post-office, and that the copyright belonged to the post-office, Lord Ellenborough said: "I do not know that that will protect the defendant. At law, the first publisher, even though he has abused his trust by procuring the copy, has a right to it, and to an action against the person who publishes it without authority from him."

The salary of the reporter was never designed to be a compensation in full, and to deprive him of his copyright. Had such an effect been intended, or thought of, it would have been expressed. It stipulates an equivalent for the sum allowed him, or a greater part of it, viz., eighty copies. When Congress, by the last reporter's act, re-



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duced the price of the volume to five dollars, the copyright was considered.

Mr. Wheaton published his first volume without a salary. He had been appointed reporter by the court, and was looking to the profits of the copy as his only compensation. But it was found unequal to the labor and time, and, in truth, no compensation. In this state of things, to enable him to go on, Congress gave him one thousand dollars, (for which he gives them back eighty copies,) and say nothing of its being an equivalent for his copyright. The copyright was established in England, and in this country, before the law was passed. And is established property to be taken away by implication? Does any one believe that Mr. Wheaton would have spent half a year or more in making and publishing these reports, if he had supposed he had not the copyright? After deducting the eighty copies, the thousand dollars would not leave enough to pay the expenses of a gentleman in Washington during the term, and going and coming. Besides, he took steps to secure his copyright every year. It was considered a copyright book. Congress saw this and knew it. Their laws with him were contracts, made under a full knowledge of existing facts. And shall it be said, when they made no exception of the copyright, and knew that he relied on it, that they intended to deprive him of it? It would have been a fraud unworthy of Congress, as it would have been disgraceful to an individual. Other reporters in this country, in the State courts, who had salaries, had always secured their copyright; (even Mr. Peters has secured his;) and the right to do so was never doubted.

Mr. Wheaton published the first volume without salary; consequently this objection cannot apply to that.

As to the cases and abstracts, they are clearly Mr. Wheaton's own composition. He acquired the right to the opinions by judges' gift. They invited him to attend, at his own expense, and report the cases; and there was, at least, a tacit engagement on their part to furnish him with such notes or written opinions as they might draw up. This needs no proof; it is the course of things, and is always done. The mere appointment proves all this. Was this engagement, this understanding, ever altered? Do not the judges of this court know that Mr. Wheaton believed he was acquiring a property in his reports? Did they not suppose he would be entitled to it, if he took the necessary steps to secure it?

Were not the opinions of the judges their own to give away? Are opinions matter of record, as is pretended? Was such a thing ever heard of? They cannot be matters of record, in the usual sense of

the term. Record is a word of determinate signification; and there is no law or custom to put opinions upon record, in the proper sense of that term. Nor were they ever put on record in this case. They were given to Mr. Wheaton, in the first instance. Blackstone, 1 Com., 71, 72, shows that the reasons of the court are not matter of record.

The copy in the opinions, as they were new, original, and unpublished, must have belonged to some one. If to the judges, they gave it to Mr. Wheaton. That it did belong to them is evident, because they are bound by no law or custom to write out such elaborate opinions. They would have discharged their duty by delivering oral opinions. What right, then, can the public claim to the manuscript? The reporter's duty is to write or take down the opinions. If the court choose to aid him by giving him theirs, can any one complain?

But we allege and prove that Mr. Wheaton was the author of the reports,—that he published them. This is enough to entitle him to a copyright, until they prove that he is not. The burden of proof is on them. See *Carey v. Kearsley*, 4 Esp. Rep., 168, already cited.

It is contended that it is against public policy to allow reports to be copyrighted; and extravagant suppositions are made—as, that an author might destroy them, or never publish them, or put an unreasonable price on them.

Is one to be divested of property, is a common rule of law to be overthrown, because the imagination of man can devise a danger which may arise, however improbable? And, besides, in this case the reporter would lose his salary, and in all cases he must lose his place, if he were guilty of any of such absurdities.

As to enhancing the price, which is one of the evils apprehended, if the author were to do it unreasonably he would lose his place; and he must always do it to his own injury, for he would lose his sales and profit. In England, the statute of 54 Geo. III, amending the statute of Anne, omits the provision in the statute of Anne intended to prevent too high a price. This shows that experience had proved that no such evil was to be apprehended. In Germany, where a free, perpetual copyright exists, books are cheaper than anywhere else in the world. Maugham, 14, 15.

Congress had power to apply the remedy, and they did apply it, when they thought proper, by fixing the price.

It is attempted to put judicial decisions on the same ground as statutes. It is the duty of legislators to promulgate their laws. It would be absurd for a legislature to claim the copyright; and no one else can do it, for they are the authors, and cause them to be published with-

## Argument for the appellants.

out copyright. Statutes never were copyrighted;—reports always have been.

It is said that one employed by Congress to revise and publish the statutes might as well claim a copyright as a reporter. The difference is, one is employed to act as a mere agent or servant, or clerk of the legislature, to prepare the laws to be properly promulgated. He is engaged to do what it is well understood never is copyrighted, and does not admit of copyright. There is a distinct understanding—a contract—that he is to do the work for his compensation, and not to claim a copyright. But a reporter is not an agent employed by Congress. He is, and is understood to be, engaged for himself, as principal; and Congress buy eighty copies, and add a salary to his profit from his copy. He was doing before the act what it was understood he could copyright, and what he did copyright; and the act does not intimate that there was to be any change; and he went on copyrighting, and they renewed his salary without any objection or stipulation.

It is the bounden duty of government to promulgate its statutes in print, and they always do it. It is not considered a duty of government to report the decisions of courts, and they therefore do not do it. The oral pronouncement of the judgments of courts is considered sufficient. Congress never employed a reporter, and they never gave any one any compensation, before Mr. Wheaton. Mr. Cranch reported without compensation, and relied upon his copyright; and Mr. Wheaton continued, with a full understanding that he was to report in the same way.

Are the court prepared to deprive all the authors of reports in this country of their copyrights?—of property which they have labored to acquire, with the full belief, of all others as well as of themselves, that they were to be legally entitled to it?

8. The publication of the defendants is a violation of the complainants' rights.

The *quo animo* of the publication is important. An abridgment was not contemplated, and the work was intended to be supplied at less cost. This is stated in the proposals annexed to the bill. The answer admits the decisions contained in the third Condensed Reports to have been previously published in Wheaton's Reports, and that it is intended to continue the publication of the same. It is denied in these papers that Mr. Wheaton could have a copyright; and if he could, that he has taken the necessary steps to secure it.

The actual violation of the complainants' rights consists in having, first, printed the abstracts made by Mr. Wheaton; secondly, in taking the statements of the cases made by Mr. Wheaton, *verbatim*, from

Wheaton's Reports; thirdly, in having taken points and authorities, and in some instances the arguments, and in all cases oral opinions, from Wheaton's Reports, and for which, of course, no materials could be found elsewhere; fourthly, in having printed the whole of the opinions, which it is not pretended were found elsewhere. No report was had to the records for the statements of the cases.

The Condensed Reports are not a fair abridgment. Cited *Butterworth v. Robinson*, 5 Vesey, 709; 1 American Jurist, 157; Maugham, 129-136.

The appellees submitted the following points for the consideration of the court:

1. That the book styled "Wheaton's Reports" is not lawfully the subject of exclusive literary property.

2. If the book of reports of the complainants be susceptible of exclusive ownership, such ownership can be secured only by pursuing the provisions of certain acts of Congress.

3. The provisions of the acts of Congress have not been observed and complied with by the complainants, or others in their behalf.

4. Reports of the decisions of the Supreme Court, published by a reporter appointed under the authority of the acts of Congress, are not within the provisions of the laws for the protection of copyrights.\*

5. The entries of the copyrights by the appellant claim more than Mr. Wheaton was, in fact or in law, entitled to, as "author," "proprietor," "author and proprietor," and were for this cause void.

6. The work styled Condensed Reports is not an illegal interference with the right, whatever it may be, in Wheaton's Reports.

*Mr. J. R. Ingersoll, for the defendants.*

The defendants submit the following argument, in answer to the complaint exhibited by the bill and testimony of the appellants.

They propose to show: 1. That the book styled "Wheaton's Reports" is not lawfully the subject of exclusive literary property. 2. If the book of reports of the complainants be susceptible of exclusive ownership, such ownership can be secured only by pursuing the provisions of certain acts of Congress. 3. The provisions of the acts of

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\* As the court gave no opinion upon this point, and, as the reporter has been informed, did not consider it when the case was disposed of, a great portion of the arguments upon it, by the counsel for the appellees, has been omitted in this report. Should the case be brought again before the court, as it will be in the event of the issue directed by the court being found for the appellants, this point will be urged to a decision.

Congress have not been observed and complied with by the complainants, or others in their behalf.

1. The character of the work in which the right to literary property is asserted by the complainants, is sufficiently described in their own bill. It consists, they say, of twelve books of reports of the decisions of the Supreme Court of the United States. It was prepared in the due exercise of the appointment of Mr. Wheaton as reporter, which he derived from the court. The writings or *memoranda* of the decisions were furnished by the judges to Mr. Wheaton, who alone preserved the notes and opinions thus furnished to him, together with other materials compiled by himself; and, having retained all these materials in his possession exclusively, he finally destroyed them. The work, agreeably to the description of it in the bill, is composed of "cases, arguments, and decisions." However rich it may be in other materials, they are not made the subject of claim; nor is any interference with them alleged, or made in any degree the subject of complaint. The claim and complaint are confined to the *reports* properly so called. If the profession and the country are indebted to the individual exertions of the reporter for valuable notes, which may have been usefully inserted to increase his emoluments or enlarge his literary reputation, they are not at all connected with the work as described and exclusively claimed in the proceedings before the court.

Reports are the means by which judicial determinations are disseminated, or rather they constitute the very dissemination itself. This is implied by their name; and it would necessarily be their nature and essence, by whatever name they might be called. The matter which they disseminate is, without a figure, the *law of the land*;—not, indeed, the actual productions of the legislature. Those are the rules which govern the action of the citizen. But they are constantly in want of interpretation, and that is afforded by the judge. He is the "*lex loquens*." His explanations of what is written are often more important, than the mere naked written law itself. His expressions of the *customary law*, of that which finds no place upon the statute book, and is correctly known only through the medium of reports, are indispensable to the proper regulation of conduct in many of the most important transactions of civilized life. Accordingly, in all countries that are subject to the sovereignty of the laws, it is held that their promulgation is as essential as their existence. Both descriptions of laws are within the principle. The source from which they spring makes no difference. Whether legislative acts, or judicial constructions or decrees, knowledge of them is essential to the safety of all. A pregnant source of jurisdiction to the enlightened tribunal to which this,

case is now submitted, is altogether foreign to the enactments of the legislature. The extended principles of national law, and the rules which govern the maritime intercourse of individuals, are fairly and authoritatively known only as they are promulgated from this bench. It is, therefore, the true policy, influenced by the essential spirit of the government, that laws of every description should be universally diffused. To fetter or restrain their dissemination must be to counteract this policy. To limit, or even to regulate it, would, in fact, produce the same effect. Nothing can be done, consistently with our free institutions, except to encourage and promote it. Everything which the legislature or the court has done upon the subject is purely of that character and tendency.

The defendants contend, that to make "reports" the subject of exclusive ownership, would be directly to interfere with these fundamental principles and usages. They believe that no man can be the exclusive proprietor of the decisions of courts or the enactments of the legislature, and that nothing in the light of property in either can be infringed.

The two things being analogous, let the illustration of the one in controversy be derived from the one that is not. That a particular act of Congress, or any number of acts of Congress, could be made any man's exclusive property, has, perhaps, never been supposed. Yet the same labor is devoted to the construction of them—the same degree of talents is required for the due and proper composition of them. A particular individual receives them for publication, and the manuscripts may be said to belong to him, for "having retained such materials in his possession exclusively," as long as he had occasion for them, in every case it may probably be said "he finally destroyed the same." This person is specially employed to publish the acts of Congress. He does so under an *appointment* which has been deemed, by some learned judges, incompatible with the tenure of an office under one of the States. Where, then, does the parallel end? An individual may voluntarily publish an edition of the laws; but he does not, by such publication, make the *laws* his own. It is not necessary to determine whether he has or has not exclusive property in the peculiar combination, or in the additional matter which his edition may contain. He certainly does not, by either combination or addition, appropriate to himself that which is neither the one nor the other; and his combination being untouched, and his additions discarded, a stranger may surely use as he pleases that which at first was public property, and is public property still. Those acts themselves are no

## Argument for the defendants.

more the property of the editors than the hall in which they were enacted is the property of the members who passed the laws.

If either statutes or decisions could be made private property, it would be in the power of an individual to shut out the light by which we guide our actions. If there be any effect derived from the assertion that the judges furnished their decisions to the reporter, the gift would be both irrevocable and uncontrollable, even by the judges themselves. The desires of the court to benefit the public, and the wishes and necessities of the public to receive the benefit, might alike be frustrated by a perverse or parsimonious spirit. A particular case, or a whole series of cases, might be suppressed by a reporter endowed with different feelings from those of the highly-respectable complainant in this cause. It might become the interest of such a person to consign the whole edition to the flames, or to put it at inaccessible prices, or to suffer it to go out of print before the country or the profession is half supplied. These are evils incident to every publication which can be secured by copyright. Mere individual works, whether literary or religious, the authors can undoubtedly thus control. During the "limited time" for which they are constitutionally secured in an exclusive enjoyment of them, there is no remedy. Their right is perfect during that period. A similar right must exist, if at all, in the publisher of reports. Can such a power be asserted, with all its consequences, over the decisions of the highest judicial tribunal of the land?

We are not to be told that the interest of the proprietor would secure the country against so great an evil. The law endeavors to prevent the occurrence of any possible wrong, although it may not anticipate the precise mode of accomplishing it. But there are contingencies readily conceivable when the interest of a venal reporter might be promoted by the course suggested. A party might feel it to his own advantage, and, therefore, make it to the advantage of the reporter, to suppress a part, or the whole of the edition of his work. The law cannot, and ought not to, be made the prisoner or the slave of any individual.

It is proper here to draw a distinction between *reports*, the immediate emanations from the sources of judicial authority, and mere *individual dissertations*, or *treatises*, or even *compilations*. These may be of great utility, but they are not the law. Exclude or destroy them, and the law and the knowledge of it still exists. The same fountains from which the authors of them drew are accessible to others. These private works may be regarded as so many by-paths to the temple of justice, smoothed and straightened by individual labor, and laid out

for greater convenience over private ground. The owner may close them at his pleasure, and no one can complain. But the entrance to the great temple itself, and the highway that leads to it, cannot be shut without tyranny and oppression. It is not in the power of any department of the government to obstruct it.

The reports in England used to be printed with the express permission or allowance of the twelve judges prefixed. Probably it would have been held a contempt of court to print them without. We are told that four reporters were formerly appointed by the king "to commit to writing, and truly to deliver, as well the words spoken as the judgments and reasons thereupon given," in the courts of Westminster. 2 Croke's Reports, preface. When Sergeant Henden *vouched for authority* Dalison's printed reports, Sir Henry Hobert "demanded of him by what warrant those reports of Dalison's came in print." 3 Croke's Reports, preface.

Sir James Burrow rebelled against the habit of receiving a special allowance or recommendation from the judges, preparatory to publication, and actually published without any allocatur. His preface, (page 8,) which explains all this, also has a reference to the *property of the reporter*. But that has, evidently, no allusion to copyright property, for it refers to a proceeding previous to the publication by the reporter, viz., a surreptitious publication by some other person, "and after the surreptitious edition has been stopped by an injunction, the book has been published, with consent of the reporter, without leave or license, and no notice taken or complaint made of it."

Reporting, however, in England, as it respects the common-law courts, at least, is a very different thing from reporting in this country. There the reporter has, with regard to the decisions themselves, a labor to perform which requires experience, talents, industry, and learning, and he receives nothing from the judges to aid him in his task. Here (with respect to the opinions) he does nothing more than transcribe, if he does so much. And, having received the manuscripts from the judges, if he should not himself publish them, they are withheld from the public, to the infinite detriment of the whole nation.

The cases that have been decided in England have, as it should seem, turned on a question of prerogative, and not of copyright.

Such was the point in the *Company of Stationers v. Seymour*, 1 Mod., 256. "Matters of State and things that concern the government were never left to any man's liberty to print that would. And particularly the sole printing of law-books has been formerly granted in other reigns."



## Argument for the defendants.

The case in 1 Vern., 120, (Anonymous,) was a motion by the *king's patentees* for an injunction to stop the sale of English Bibles printed beyond sea. The lord keeper then referred to the circumstance that a patent to print law-books had been adjudged good in the House of Lords.

In the case of *Company of Stationers and Parker, Skinner*, 233, Holt, arg., "agreed that the king had power to grant the printing of books concerning religion or law, and admits it to be an interest, but not a sole interest." The court inclined for the defendant, (who had pleaded the letters patent of the king, which granted to the University of Oxford to print *omnes et omni modo libros* which are not prohibited to be printed, &c.) and they said that "this is a prerogative of power which the king could not grant so, but that he might resume it, but otherwise it is of a grant of an interest."

In *Gurney v. Longman*, 5 Ves., 506, 507, Lord Erskine declared that he granted the injunction (as to publishing the trial of Lord Melville) "not upon anything like literary property, but upon this only, that these plaintiffs are in the same situation, as to this particular subject, as the king's printer exercising the right of the crown as to the prerogative copies."

The cases of *Bell v. Walker*, 1 Bro. C. C., 451, and *Butterworth v. Robinson*, 5 Ves., 709, are not sufficiently developed to show whether they turned upon copyright proprietorship or a proprietorship derived from a prerogative grant.

It cannot be contended, with any semblance of justice, that the *mere opinions* of the judges communicated to Mr. Wheaton, as it is alleged they were, could be the subject of literary property. A book composed in part of those opinions, and in part of other matters, does not change the nature of the opinions themselves. An individual who thus mingles what cannot be exclusively enjoyed, with what can, does, upon familiar principles, rather forfeit the power over his own peculiar work than throw the chain around that which is of itself as free as air. The intermixture, if it affect either description of materials, must render the whole unsusceptible of exclusive ownership. That which is public cannot, in its nature, be made private, but not *e contra*. The lucubrations of the reporter assume the hue of the authoritative parts of his book, and must abide by the result of a connexion so framed and a color so worn. Whether a stranger could extract the original parts, in the face of a copyright, and publish them alone, it is not necessary to discuss. But upon the principles just asserted, he could give additional dissemination to the whole, as he finds it connected together. And he could, it is conceived, unquestionably select what is justly pub-

lic property, and leaving the merely private work of the reporter untouched, publish the rest with entire impunity.

2. Our second point is, that the exclusive ownership of an author can be obtained only by pursuing the provisions of the acts of Congress.

Upon this particular point, a moment's attention will be usefully given to the celebrated case of *Miller v. Taylor*, 4 Burr., 2303, and its companion, *Donaldson v. Beckett*, 4 Burr., 2408.

Judgment of the court of king's bench having been entered for the plaintiff in *Miller v. Taylor*, a decree of the court of chancery was founded upon it in the case of *Donaldson v. Beckett et al.* This came before the House of Lords on an appeal, and the decree of the court of chancery (and, of course, *Miller v. Taylor* along with it, in principle) was reversed, "the Lord Chancellor seconding Lord Camden's motion to reverse." Besides the influence of the decision itself, we have the force of these professional opinions, and that of a majority of the eleven judges who gave their sentiments, that the existence of the statute deprived the author of any right of action which he may have had at the common law.

The question of a common-law right has not been decided favorably to the author; and if it had been, the existence of a statute is thus recognized as superseding both the right and the remedy which may have previously existed. The marginal note of Sir James Burrow to *Miller v. Taylor*, 4 Burr., 2303, itself is, "authors have *not* by common law the sole and exclusive copyright in themselves or their assigns in perpetuity after having printed and published their compositions," &c. If in England, the source and fountain of the common law, no such right exists, what can be alleged in favor of its existence in these United States? We contend that there could be no such common-law right here, even if there were no statute; and that if there could be, it is incompatible with the provisions of the statute.

All the arguments contained in the powerful and splendid opinion of Mr. Justice Yates in *Miller v. Taylor*, 2 Burr., 2354, are of irresistible force here.

Feudal principles apply to real estate. The notions of personal property of the common law, which is founded on natural law, depend materially on possession, and that of an adverse character, exclusive in its nature and pretensions. Throw it out for public use, and how can you limit or define that use? How can you attach *possession* to it at all, except of a subtile or imaginative character? If you may read, you may print. The possession is not more absolute and entire in the one case than the other. It is an artificial, and therefore arbitrary rule which draws the distinction; and in order to render it avail-

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Argument for the defendants.

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able, the lesson must be read in the statute, and the means must be resorted to which are there pointed out. Even in the face of a statute backed by the Constitution itself, let an inventor lose his possession, and his privilege is gone. The decision of this court as to the patent for fire hose was to this effect. *Pennock v. Dialogue*, 2 Peters, 1.

If the right secured by statute does not enable the owner to reclaim his lost possession, even when aided by the common law, (if it be so,) how can the common law, independently of all statutes, avail?

Analogous rights, if such they may be called, are nothing without actual possession and use. Light and air and a part of the great ocean may be claimed and held as long as necessary for the occupant; but abandon the immediate occupation, and the exclusive power and exclusive possession are gone together.

These and similar reasons contribute to show the source of literary property everywhere. They justify the positive provisions, and manifest the wisdom of them which give existence to it among ourselves. It is not to be found in natural law or common law, and the deficiency is wisely and aptly supplied.

The inconveniences to the public that would be the consequence of mere common-law assertion of the right would be endless. It would lead to perpetual strife. If the mere individual stamp of authorship would afford even a foundation for a claim, originality might be pretended to by numerous individuals, and a test of truth might not be obtained. If the real author give his work the official stamp of originality before it goes forth into the world, most of the questions that would otherwise occur are anticipated. The source of exclusive ownership is therefore found in positive enactments, and not in any unwritten law.

What is the common law of the United States? To sustain a copyright, it must be a very different thing from what the sages of the American law have supposed. To construe existing laws and contracts, to aid in giving them effect, to furnish lucid definitions, sound principles and apt analogies, it is rich in the most important uses. For all these and various other purposes it is indispensable. Most of the crimes prohibited by statute would be misunderstood without its assistance; all of the civil enactments would become obscure if it did not shed its light in never-failing streams upon them. Yet it cannot originate a single punishment, or create a single crime. It does not give any jurisdiction to the judge, or increase the number or widen the extent of the subject on which he has authority to decide. When he has a duty to perform, it gives him wisdom and strength to perform it; but the duty itself it cannot create, enlarge, diminish, or destroy.

This subject is well treated of by Mr. Duponceau in his "Dissertation on the Nature and Extent of the Jurisdiction of the Courts of the United States." In his preface (page 11) he says: "The common law of the United States is no longer the *source* of power or jurisdiction, but the *means* or instrument through which it is exercised; therefore, whatever meaning the words *common-law jurisdiction* may have in England, with us they have none; in our legal phraseology they may be said to be *insensible*." To them may be applied the language in which the common lawyer of old spoke of a title of the civil law: "*In ceux parolæ n'y ad pas entendment*."

Again, (preface, pages 14, 15,) "I contend that in this country no jurisdiction can arise" from the common law as a source of power—"while," as a means for its exercise, "every lawful jurisdiction may be exercised through its instrumentality and by means of its proper application."

The common law would be impracticable in its application to copyrights in the United States. It might vary in every State in the Union from the rest. What is the common law of New York or Pennsylvania? It is the common law of England, as it has been adopted or modified in those respective States. Each State, then, has, or may have, its own common law as a system, or as it applies to a particular subject of regulation or control. But copyrights, as recognized by the United States, must be uniform. There cannot, therefore, be a State common law for copyrights, for the want of necessary uniformity; and if the United States cannot derive it through the States, they have it not at all. "This power," says Chancellor Kent, 2 Com., 299, "was very properly confided to Congress, for the States could not separately make effectual provision for the case."

The States themselves at no time ever treated this as a common-law right. Before the adoption of the Federal Constitution, accordingly, several of them are found to have made special provision by statute on the subject. New Hampshire, Massachusetts, Connecticut, New Jersey, Maryland, and North Carolina each passed acts of assembly to secure to authors an exclusive enjoyment for a term of years. Why should they have secured a right already in full existence? They might have merely provided a penalty for an already perfect right. The periods for which an exclusive right is maintained are different in these provincial enactments. In Germany, this difficulty is cured by rendering them perpetual in each department. But there is no common government, in that country, to which the subject can be referred.

This is a subject expressly ceded by the States to the general gov-

## Argument for the defendants.

ernment. It is extinguished with regard to them in all its parts. Whatever power or control the States might have exercised is now gone, and all is vested in the United States. No common-law power, then, of any kind, in relation to copyrights, exists. Not in the States, for they have surrendered the whole subject to the Federal government. Not in the United States, for they exercise only the jurisdiction which is conferred by the Constitution and the laws. Nor have they declined or omitted to fulfill the trust thus confided to them. If some powers are left unexercised, (as in the case of bankruptcy,) such omission cannot be asserted with regard to the protection of literary property. It is amply provided for. No assistance is needed from any other jurisdiction;—no deficiency is ever suggested to have been left to be supplied.

Mr. Duponceau, in his treatise already cited, page 101, asserts “that when the Federal courts are sitting in and for the States, they can, it is true, derive no jurisdiction from the common law, because the people of the United States, in framing their Constitution, have thought proper to restrict them within certain limits; but that whenever, by the Constitution, or the laws made in pursuance of it, jurisdiction is given to them either over the person or subject-matter, they are bound to take the common law as their rule of decision, whenever other laws, national or local, are not applicable.”

Judge CHASE, in the case of the *United States v. Worrall*, 2 Dallas's Rep., 384, uses this comprehensive phrase: “In my opinion, the United States, as a Federal government, HAVE NO COMMON LAW!” “If, indeed, the United States can be supposed for a moment to have a common law, it must, I presume, be that of England; and yet it is impossible to trace when or how the system was adopted or introduced.”

It would be most strange if the double jurisdiction did exist. The Constitution, and the statutes enacted in furtherance of its provisions, instead of providing or extending rights and remedies, would have greatly limited and restrained them. Instead of doing, as they were designed to do, much benefit to the author, they have done him much positive harm. He had already, according to the theory we are opposing, rights by the common law. These rights, if they were perfect in their nature, were unlimited in their extent. The patronage of American legislation, then, abridges the duration of the right, if it does not curtail its enjoyment, by imposing restraints and prescribing preliminary forms. It does more: it draws a distinction between the stranger and the citizen, or resident; but the distinction, if it mean anything, is in favor of the former and against the latter. The natural law, or common law, would be unlimited in the duration of the

privilege which it would confer ; and the labor and skill exhibited in the composition would secure the right. This would be an innate privilege of the foreigner. The statute law afterwards comes and confines the security to a term of years, and makes the way to obtain it intricate, or at least perplexed ! How does this consist with the language or the spirit of the eighth clause of the eighth section of the first article of the Constitution ? That clause ordains that Congress shall have power “to PROMOTE the progress of science and useful arts, by securing for limited times, to authors or inventors, the exclusive right to their respective writings and discoveries.” It would not be to promote, but to retard that progress, if it possessed already a more active stimulus. There would be no occasion to secure for a limited time, if the exclusive right already existed in perpetuity.

The case of *Ewer v. Coxe*, 4 Wash. C. C. Rep., 487, is broad enough to cover all that is now contended for. Judge WASHINGTON having demonstrated the necessity of the proprietor’s complying with the provisions of the act of Congress, in order to obtain the benefit conferred by that act, declares “if he has not that right, he can have no remedy of any kind.” The right thus referred to was one purely under the statute. But it was the only available one that could exist,—the only one that could carry with it, or be productive of, *any* remedy.

In order to sustain his claim at all, an author who has not complied with the provisions of the statute must make out these several positions: 1. That a right and a remedy existed independently of the statute, and prior to it. 2. That the provision of redress by the statute does not take away a previous right.

We have endeavored to show that the first of these positions is unsound, and if so, the second is altogether inapplicable.

The language of the Supreme Court of New York, (*Almy v. Harris*, 5 Johnson, 175 ; see also *Scidmore v. Smith*, 13 Johnson, 322, and 1 Roll. Abr., 106, pl. 16,) applied to a totally different matter, may be usefully quoted here: “If Harris had possessed a right at common law to the exclusive enjoyment of this ferry, then the statute giving a remedy in the affirmative, without a negative expressed or implied, for a matter authorized by the common law, he might, notwithstanding the statute, have his remedy by action at the common law. 1 Com. Dig., Action on Statutes, C. But Harris had no exclusive right at the common law, nor any right but what he derived from the statute. Consequently he can have no right since the statute, but those it gives ; and his remedy, therefore, must be under the statute, and the penalty only can be recovered.”

## Argument for the defendants.

“But where a statute gives a right, and furnishes the remedy, that remedy must be pursued.” *Gedney v. The Inhabitants of Tewksbury*, 3 Mass. Rep., 309. And “when a statute creates a new right, without prescribing a remedy, the common law will furnish an adequate remedy to give effect to the statute right. But when a statute has created a new right, and has also prescribed a remedy for the enjoyment of the right, he who claims the right must pursue the statute remedy.” *Smith v. Dean*, 5 Mass. Rep., 515.

The same principles will make it necessary, in order to reach the rights which the statute creates, to pursue the means which it points out. Judge WASHINGTON, in *Ewer v. Coxe*, 4 Wash. C. C. Rep., 491, already cited, says “that the author must perform all that is pointed out before he shall be entitled to the benefit of the act. It seems to me,” says he, “that the act will admit of no other construction.”

The case of *Beckford v. Hood*, 7 T. R., 620, has been relied on to show that the directions of the English statute are not necessary preliminaries to the establishment of the right. The judges of the king's bench were construing a very different statute from ours. The second section of the act of 8 Anne, ch. 19, 12 Statutes at Large, 82, recites that “whereas many persons may, through ignorance, offend against this act, unless some provision be made whereby the property in every such book, &c., may be ascertained, &c.,” and then enacts that “nothing in this act contained shall be construed to extend to subject any bookseller, printer, or other person whatsoever, to the forfeitures or penalties therein mentioned, for or by reason of the printing or reprinting of any book or books without such consent as aforesaid, unless the title to the copy of such book or books hereafter published shall, before such publication, be entered in the register-book of Stationers' Hall, &c.”

The corresponding clause of the act of Congress of April 29, 1802, runs thus: “That every person, &c., before he shall be entitled to the benefit of the act, &c., shall, in addition to the requisites, &c.” The preliminary in the English statute is connected directly with the penalty. In ours, it is directly associated with the whole benefit of the act. The decision in *Beckford v. Hood* cannot affect the present case, even if it be sound. Of the soundness of it there may be much doubt, when we find Lord Hardwicke deciding, in *Blackwell v. Harper*, 2 Atk., 95, that “upon the act of 8 Anne, ch. 19, the clause of registering with the Stationers' Company is relative to the penalty, and the property cannot vest without such entry.” A farther view is taken by Judge HOPKINSON of this decision in *Beckford v. Hood*, which is respect-

fully submitted as a conclusive reply. It will be found in his printed opinion. (See Appendix.)

Let us look at the statutes themselves. The question here between us seems to be, whether the acts of Congress merely *provide a remedy*, or also *constitute a right*?

The act of 31st of May, 1790, would have commenced with its second section, if it had merely intended to suggest redress for the infringement of an existing right. This second section, however, is only a corollary or incident to the first, which provides, in compliance with what the Constitution had authorized, security to authors which they did not in any shape enjoy before. There is nothing declaratory about it.

"*From and after the passing of this act, the author, &c., shall have the sole right, &c.*" The right is certainly prospective, and it is (we say) conditional. The right is to arise, at all events, subsequently to the passage of the act, and it is to commence "from the recording the title, &c., in the clerk's office, as is hereinafter directed."

It would seem quite unnecessary thus gravely to confer in prospect a privilege already enjoyed, and to trammel it with conditions, if it was already unconditional. This is certainly no restraining statute.

An argument has already been used, and it will not be formally repeated, that the ostensible or professed *encouragement* of learning, by *securing, &c., during the times mentioned*, would be a mere delusion; for the encouragement had been more liberal—the security not less perfect—and the right more comprehensive, because of unlimited extent, if they respectively had *any* anterior existence whatever. It is no less striking, that Congress, who are supposed to be declaring the common law, and merely providing a precise penalty for the infraction of a right under it, could not, by any possible exercise of their power or authority, come up to the supposed common-law right; for the paramount authority of the Constitution restrains the exercise of any encouragement to a limited time.

The act proceeds to mark out the preparatory step towards penalty or prohibition, viz., the *legal acquisition* of a copyright. Section 1. And how is the copyright to be *legally acquired*? Why, only by following the directions of the statute; *i. e.*, depositing the title in the clerk's office, publishing the record, and delivering a copy within six months to the Secretary of State, to be preserved in his office. Section 3.

Judge WASHINGTON was inclined to think that some of these provisions were merely necessary to enable the author to sue for the forfeitures provided by the second section.



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But that would be quite an empty satisfaction. The copies forfeited by the invading party are to be destroyed, and the penalty of fifty cents for every sheet in his possession, belongs one-half to the United States. The author is not much the better for this provision. He might have reserved all the damages for himself, independently of the act, if the right existed previously.

It is not necessary to rely upon the construction of this act alone, if there be any doubt with regard to the true interpretation of it. The supplementary act, passed April 29, 1802, is free from all difficulty. It is on this that Judge WASHINGTON relies.

This last act provides, section 1, that the author, "before he shall be entitled to the benefit, &c., shall," in addition to the requisites enjoined in the third and fourth sections of said act, &c., "give information, by causing the copy of the record, &c., to be inserted at full length in the title-page, &c."

It thus makes those clauses which had before been of doubtful name, *requisites*. It requires him to perform them, not as preliminary to forfeiture or penalty, which are only particular provisions of parts of the act, but as preliminary to the benefit of the act itself. He, therefore, in terms, is denied its advantages, unless he perform the conditions precedent. These, agreeably to a well-known rule, are to be construed strictly, and the party who omits to bring himself within them can claim no right whatever. The statute becomes a unit; all its benefits are yielded or withheld, exactly as all its requisites have been fulfilled or disregarded.

*Requisite* is aptly defined by the American lexicographer, Noah Webster, to be "so needful that it cannot be dispensed with; something indispensable." An author must show that he has complied with these affirmative requisitions, or they will not be presumed for him.

There are familiar analogies which will fully sustain this position. Take the statute which regulates distresses for rent. Certain provisions are made which justify a landlord for acts which would otherwise amount to a trespass. But he must show that he has performed them strictly, or, as the law first stood in England, and does still in Pennsylvania, he is a trespasser *ab initio*; and the statute of George II only so far alters the rule as to leave the party to his remedy by action on the case for the recovery of the actual damages that may have been sustained.

If notice be required by statute, as, for example, preparatory to a suit against a magistrate for misconduct in office, not only is it never presumed, but nothing can supply its proof;—not even knowledge of

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the design to sue, which might be substantially the same thing. In such case, *knowledge is not notice*.

There is nothing against our construction in the principle which requires a strict interpretation of certain statutes. If the act be penal, we are not endeavoring to enforce the penalty. There is nothing penal as to the author claiming the copyright. All the penalties are against other persons. It is to be construed strictly when it is to be enforced against *them*. He claims the benefit of his copyright, which is a grant to be obtained only on conditions precedent and well defined. He attempts to enforce with rigor, if not the penal forfeitures, at least the penal prohibitions of the law, against the defendant, whom he alleges to be a wrong-doer. Against the defendant, thus, without (if it be without) bringing himself under the provisions of the law, the alleged proprietor denounces awful consequences. The defendant asks nothing—wants nothing—but to be let alone until it can be shown that he has violated the rights of another.

Where is the difference between this act and the act respecting patents, as regards the right of the alleged owner? This court has said, that if a defendant sued for the infringement of a patent-right “shows that the patentee has failed in any of these prerequisites on which the authority to issue the patent is made to depend, his defense is complete;—he is entitled to the verdict of the jury and the judgment of the court.” *Grant v. Raymond*, 6 Peters, 220.

3. There will be little difficulty in showing that the provisions of the acts of Congress have not been complied with.

The requisites are:

1st. The deposit of a printed copy of the title in the clerk's office of the District Court where the author or proprietor resides.

2d. Within two months from the date thereof, the publishing of a copy of the record in one or more newspapers printed in the United States, for four weeks.

3d. Within six months, the delivery, &c., to the Secretary of State of a copy to be preserved in his office.

With regard to the first volume, the bill is defective in not stating either of the last two requisites. The complainants are *informed by M. Carey*, and *believe* that all things which are requisite and necessary to be done, &c., have been done!

An inference or conclusion even of the party would be a sorry substitute for the allegation and proof of the facts themselves. The court must have an opportunity to judge whether *all things* were done, &c.; and that they can have only when the things which were done are exhibited and proved. But here is double-distilled inference. The

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parties are *informed* of Mathew Carey's *conjecture*; and this is presented to the court as a substitute for proof; while H. C. Carey proves that Mathew Carey knew nothing about it, for all was left to *him*. It is extraordinary, if Mr. Carey really possessed any information on this subject, that he was not produced as a witness.

Upon the complainants' own allegations, their case must fail. But the proof is scarcely less defective than the allegations of the bill. Henry C. Carey, the clerk of his father in 1816, states that they were in the habit of advertising, and from the *course of business* he does not doubt it was advertised, but he *had no recollection of it*. He has no recollection at all of a deposit of a copy in the office of the Secretary of State. But he says that the most probable way in which it was sent, was by Mr. Wheaton. In other words, that it was not sent by himself; and, therefore, as to any proof from him, that it was not sent at all.

Mr. Brent states that the eighty copies of the volume of Wheaton's Reports, containing the decisions for February Term, 1817, were delivered to the Department of State on or before the 4th day of November, 1817. This refers, of course, to the second volume, which contains the decisions of that term, and not the first, which is for the previous year. Subsequent volumes had been delivered in the same manner; all of them were received under the acts of Congress giving a salary to the reporter. He adds, that there has always been, according to his recollection, one or more complete sets of said reports, from the time of their publication, in the said Department of State. But he is unable to recollect, or state more particularly, *when* the same were first placed in said department, or for *what purpose*.

Both of these particulars, it is conceived, must be made out. The delivery must be within six months. The loose declaration that, according to his recollection, there has always been one or more sets, &c., *from the time of publication*, if it could have any force by itself, is done away by his acknowledged inability to recollect when they were first placed there. The object of the receipt of them, too, is directly the reverse of that prescribed by the copyright law; for, instead of being delivered *to be preserved in the office*, &c., they were, if delivered at all, merely a part of a general library, intended to be lent out and used. If delivered to be preserved, the presumption is that the particular copy so left would be found. It will scarcely be contended that the second edition of the first volume can cure the defects of the first. It can have no copyright existence by itself.

With regard to the subsequent volumes, the bill is scarcely less defective. The declaration of Robert Donaldson is vague and un-

satisfactory. It could not be otherwise. He knew nothing of the subject. The result of the inquiries at the Department of State is evasively set forth; and were it otherwise, he must state the fact, and not the inquiry.

The bill proceeds to insist that the complainants would still be entitled to the benefits of the acts of Congress, although they should be unable to prove that a copy was delivered, &c. We say that such proof is a necessary preliminary.

The proof with regard to these subsequent volumes is equally defective. Of the second volume, there is no proof of publication; and of none of the volumes is there either allegation or proof of deposit, agreeably to the provisions of the law.

The fourth volume wants publication. It began August 28th and ended September 17th, instead of 25th.

The seventh had but two publications in July, four in August, and one in September.

The eighth had one publication in October, five in November, and two in December.

Of the ninth, there is no evidence of publication at all.

The tenth, eleventh, and twelfth are all defective in publication.

It is not necessary to dwell upon the facility with which proof of delivery might have been preserved and exhibited if it had been made. The requisites of the law must be shown. But the certificate of Mr. Van Buren, with regard to the second edition of the first volume, is a specimen of what might have been, and would have been, produced with regard to the whole, if the deposit had, in fact, been made.

In the absence of all right on the part of the complainants, not much difficulty is apprehended from any supposed possession or enjoyment, by color of privilege. Judge WASHINGTON, in delivering his opinion in *Ewer v. Cox*, disposes of this question to our hand. 4 Wash. C. C. Rep., 489. "I hold it to be beyond controversy," says he, "that if the plaintiff has no copyright in the work of which he claims to be the owner, a court of equity will not grant him an injunction. This was formerly the doctrine of the English court of chancery, and still is, as I conceive, notwithstanding Lord Eldon has, in some instances, granted an injunction, and continued it to the hearing, under circumstances which rendered the title doubtful, if the plaintiff had possession *under a color of title*. But surely if he has no title at all, or such a one as would enable him to recover at law, even that judge would, I presume, refuse an injunction.

The authorities cited by Judge WASHINGTON support the principle which he maintains.

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Against whom is this mere naked possession claimed? Not the defendant; for during the period when it has existed he was only one of the mass of individuals who had not any particular concern in disturbing the complainants' colorable claims. It is, therefore, against the public, who cannot thus be baffled of their rights.

It is, however, a most extraordinary case that would justify a perpetual injunction without a trial at law. This is a proceeding which turns aside from the regular and proper mode of ascertaining title, and asks that the existence of it shall be definitely rested upon mere colorable claims. The complainants do not choose to bring their case to the proper test; but, assuming as *conclusive* what at the utmost is only *prima facie* evidence in their favor, they propose to hang up forever, in a state of presumption and doubt, that which is susceptible of a just and satisfactory settlement. All that the defendants ask, in the dismissal of the bill, is that their rights may not be prejudged.

*Mr. Sergeant, for the defendants.*

The claim now asserted by the appellants is to a perpetual right in Wheaton's Reports, in Mr. Wheaton and his representatives and assigns. Such a right is necessarily exclusive. It goes beyond the right claimed to be secured under the copyright acts of Congress. Such a claim should be clearly established. It is asserted for the first time in a court of the United States. It has no precedent in the proceedings of the courts of England; for, since the decision in that country that the statute of Anne took away the alleged right of an author at common law, there can be found no precedent in that country to sustain such a claim.

The Condensed Reports, so far as it is now material to examine them, are made up of statements which are to be found on the records, and of the opinions of the court. Mr. Wheaton's notes are not interfered with—nor are his reports of the arguments of counsel. These, it might be admitted, are his own—if he can have a property in any of the matters contained in the volumes published as a public officer.

Mr. Wheaton's Reports are made up as an officer of the court. The court appointed him under the authority of a law of the United States, and furnished him the materials for the volumes; not for his own sake, but for the benefit and use of the public; not for his own exclusive property, but for the free and unrestrained use of the citizens of the United States. In relation to the work, he was not an author, but as an officer, as a public agent, selected, authorized, and paid for making up the reports of the decisions of the court.

In the whole composition, under these views of the facts of the case, not a word in the reports belongs to him. It could not be the intention of the court to give him a perpetual right to the opinions delivered by them. No such purpose could have been entertained by Congress, when the appointment of a reporter was directed. The objects of the law, and of the court, were to authorize, enforce, and secure the publication of the proceedings and decisions of the court, for public information. Any argument or course of argument tending to a different conclusion must be wrong, because contrary to the design of his appointment. It is in derogation of common right.

Let us see how the claim of the complainants is made out.

1. The question whether the power to regulate copyrights under the Constitution is exclusive, can never arise until some State shall pass a law interfering with its exercise by Congress. 3 Story's Com., 50. Until then, it must be a theoretical question. The law of New York, which was intended to secure exclusive right in the navigation of the waters of that State by steam, was by this court decided to be unconstitutional. The court decided the case on other grounds, it is true, but still so decided.

Up to the present moment, no State has asserted a right to interfere with the power of Congress, under the Constitution, to regulate copyright. There is no judicial decision which asserts or supposes any such right. There is not a trace, sign, or symptom of any such right existing in the legislation or judicial proceedings of any State. There is, therefore, no collision,—no case for judgment. But the contrary is evident.

It is not necessary to inquire whether States *have* the power, if they have not chosen to exercise or claim it. It is clear that there was no such thing in any of the States prior to the Constitution, but by the invitation of Congress under the confederation. Fed., No. 43; 3 Story's Com., 49. Congress found the whole case unprovided for; and the laws made by some of the States, at their instance, and which have been referred to by the counsel for the appellants, ceased when the Constitution was adopted.

But supposing that a concurrent power to regulate and secure copyright existed in the States and the United States, (a supposition of exceeding difficulty and doubt,) and that the States may act, notwithstanding the exercise of the power by Congress, it is for the States to choose whether they will do so or not. They have not so chosen;—they leave it to Congress. But there are many reasons for considering this power exclusive, as well as reasons which clearly show it ought to be exclusive.

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1. It was originally taken up by Congress as matter properly belonging to their cognizance. Early in the progress of the government the first law was passed, which was followed by other legislation, thus establishing the present regulations. This power did not exist in Congress under the confederation. None of the provisions in that compact applied to it; and it now rests upon the article in the Constitution which gives Congress the power to "promote the progress of science and the useful arts." The whole ground is admitted to have been vacant on the establishment of the present government. It was a new power. Fed., No. 43; 3 Story's Com., 48; Rawle on the Constitution, ch. 9, pp. 105, 106; 2 Kent's Com., 306, &c.

2. The power could only be properly, beneficially, and effectually exercised by Congress. By vesting the power in the national legislature, the system became uniform and certain. Authors, but for this, would have been subjected to different provisions and conditions in every State, thus materially affecting the value of all their rights. And the community throughout the whole nation were thus, after a certain interval, entitled to the benefits of the writings or compositions of those who availed themselves of the laws passed under the constitutional provisions. 3 Story's Com., 48, 49.

3. There is an absolute incompatibility between the existence of the power in the United States and in the States.

It has been repeatedly said that the Constitution has not occupied the whole ground; that it has provided for the author, and not for the public. But the true state of the case is directly the reverse of this. It has provided for the case of the author only as instrumental to the provision for the public. The clause in the Constitution gives Congress the power, not to secure a copyright to the author, but to "*promote the progress of science and the useful arts, by securing for limited times, to authors, &c., the exclusive right to their respective writings, &c.*" It is to be for a *limited time*,—no longer. 3 Story's Com., 49.

4. The state of the law in England was known here by the adjudications in the courts of that country. These adjudications stood in this way: 1. That there was a common-law right before the statute of Anne. 2. That there was no common-law right after that statute. According to those decisions, the effect of legislation was to take away the common-law right. Where the power of legislation over the subject was placed, there was the power over the whole matter.

5. The same word "secure" is applied in the article in the Constitution to inventions as well as to the works of authors.

In inventions, it is admitted there was no common-law property.

The use of the word "secure" cannot, therefore, presuppose an existing right. It would have the same effect, and be equally applicable to both. No benefit can, therefore, be derived from the use of the term, however ingenious the argument which invokes it in aid of the pretensions of the complainants. Cited act of 41 Geo. III; Maugham, 36, 37.

6. The uniform construction and the practice under it have been such as is contended for by the defendants.

It is true, there was an omission in the laws to give full power to the courts of the United States in cases of copyright; but the omission was to no great extent. There was no provision for jurisdiction when the parties to a suit of which copyright was the subject were citizens of the same State. *Binns v. Woodruff*, 4 Wash. C. C. Rep., 48. But that omission was supplied by the act of 1819. 3 Story's U. S. Laws, 1719.

7. In what state, supposing an author to have a right at common law, is the right to exist and be protected? If there is a right of property, it must be governed by, and have the benefit of, all the rules which affect such property. It accompanies the owner everywhere. It is not his because he is a citizen of the United States. It derives no additional security from such citizenship. A stranger who is an author—a foreigner—has the same common-law right of property, and no foreign book can be printed here. Such has not been the understanding in England, from which the principles to sustain the right are derived. No common-law right extended to Ireland before the union. There, at all times, before the union, the works of authors, however secured under the statute of Anne, in England, were printed and published. If a common-law right existed, or was supposed to exist, we should have found, in the proceedings of the Irish courts, its establishment by judicial decisions.

But supposing it were otherwise, and that a right at common law does exist, upon the laws of what State do the complainants rely? Upon the law of Pennsylvania? In the Circuit Court, the right was claimed on the common law of the nation. In this court, it is asserted to rest upon the common law of a State. Below, no intimation of such a thing was given. If any such right, under the common law of Pennsylvania, exists, we of Pennsylvania do not know it. Strangers have discovered it, and claim the benefit of it, for the first time. Not a trace of its existence can be found in the whole history of that State. No authority from any of the laws or the decisions of the courts has been vouched. It is denied that it exists.

It is, then, assumed, without hesitation, that the right of action,



## Argument for the defendants.

whatever it is, which an author has for an infringement of his copyright, arises from the Constitution and laws of the United States. The Constitution gives Congress the power "to promote the progress of science and the useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." Art. 1, sec. 8, ch. 8. Until *secured* by Congress, he could have no right under the Constitution. When secured, it must be to such extent and upon such terms as Congress may enact.

Some argument has been presented upon the word "securing," as admitting a preëxisting right. But there is no force in the suggestion. There must be a preëxisting state of things, out of which a right to apply to be secured arises. That right is brought into existence by the constitutional provision. It had no existence as a right, incident to the fact of the author being a member of the community of the nation, until the constitutional provision. By the agreement of those who made the Constitution, the right was brought into existence, and it was to be secured. The language, therefore, is accurate. It has already been observed that the term "securing" is applied equally to *inventions*; yet no common-law right to inventions has been asserted.

The Federal judiciary, at all events, can have no cognizance of claims to copyright, but under the laws of the United States, made in pursuance of the Constitution, and to the extent such laws may authorize them to go.

Thus understood, what is the right of an author? There is a difference between a *patent* and a *copyright*. A patent, in due form, is *primâ facie* evidence of the right of the inventor. It is, itself, *primâ facie* proof of all the prior acts required by the laws. It rests for its support upon the invention. But invention without a patent is nothing. A man without a patent could not ask the aid of the court to protect his claims. The patent is, therefore, evidence *primâ facie* of right.

A copyright is quite a different thing. Its existence as a right depends upon doing certain acts. The doing of these is the foundation of the right. Their being done is the only *evidence* of the right. If they are not done, no right, or even claim, exists. These acts, therefore, as to copyright, are as a patent in the case of an invention. There is nothing that performs the office of a patent. The whole acts together establish the right.

In the case of an invention, the patent being a *primâ facie* case of right, in the first instance, where the right of the inventor is disputed, it is sufficient to prove the patent at law or in equity.

In the case of a copyright, the title is made out *primâ facie*, at law and in equity, by stating and proving the acts which, by the provisions of the law, constitute a copyright.

This distinction is a most material one, and to be always kept in mind. It goes to the root of the whole case. If anything has been omitted or neglected; if any of the requirements of the law, the performance of which are conditions upon which the right rests, and by which the right would be protected by the law, have been neglected, there is no title at all,—no title in existence. Such a case is the same with that of an inventor coming into court without a patent.

The court will not grant him an injunction. *Ever v. Coxe*, 4 Wash. C. C. R., 487. There is nothing in such a case on which to ingraft the doctrine of possession. It is only when a *primâ facie* title exists, one made out by showing a compliance with the law, that the doctrine of possession can be applied. *Ever v. Coxe*, 4 Wash. C. C. R., 488.

This brings us to the first head of inquiry, which separates itself into two branches:

1. What are the requisites to a copyright under the laws of Congress? 2. Have these requisites been complied with?

1. Upon the first question, we have the light of a judicial decision, and there is no decision to the contrary. It is that of a judge of the highest and the most regarded judicial talents—one whose opinions have always received the utmost respect. In *Ever v. Coxe*, 4 Wash. C. C. R., 487, Judge WASHINGTON held that to entitle the author of a book to a copyright, he must deposit a printed copy of the title of such book in the clerk's office; publish a copy of the record of his title within the period, and for the length of time prescribed by the third section of the act of Congress of 31st of May, 1790; and deposit a copy of the book in the Secretary of State's office within six months after its publication. The requisites of the third and fourth sections of the act of Congress of 1790, relative to copyrights, are not merely directory, but their performance is essential to vesting a title to the copyright secured by law. The act of Congress of 29th April, 1802, declares that in addition to the requisites enjoined in the third and fourth sections of the act of 1790, and before the person claiming a copyright shall be entitled to the benefits of the same act, he shall perform all the new requisites, and that he must perform the whole before he shall be entitled to the benefits of the act. "It seems to me," says the judge, "that the act will admit of no other construction."

The argument upon the two acts, taken together, is plain and convincing. Act of 1790, 1 Story's Laws of United States, 94; act of

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Argument for the defendants.

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1802, 2 Story's Laws of United States, 866. The question, be it remembered, is, what are the requisites under the act of 1802?

1. When these acts were passed, the whole subject of copyrights was open for legislation. The object of Congress was to carry into effect the provisions of the Constitution, by establishing a mode of obtaining a copyright. The provisions of the laws have no other view.

It is material and reasonable, then, to suppose that whatever was directed to be done was a *requirement*. The acts to be performed were to secure for a limited time to an author the benefit of his writings, and these acts were directed for that purpose. It is impossible to distinguish, so that one of the acts shall be decreed material, and another not so. The whole and each of the acts are pointed out in the law, and the most natural course is to deem them all material. They do all, in effect, constitute the conditions of the title;—they constitute the title itself.

2. Upon the words of the act, it seems impossible to raise a doubt. They are plain, clear, and require no explanation. The acts they require are of easy performance; the evidence that they have been performed can always be obtained and preserved. The reason of requiring these acts is not here in question.

It is probably true, that when the act of 1790 was passed, Congress had before them the statute of Anne, and the decisions of the English courts upon that statute, and on all the litigated questions of literary property, and of copyright. This is equally true of the act of 1802; and this must be considered in reading that act.

But the reason of the requirement of the law is obvious. The author "shall deliver a copy to the Secretary of State, to be preserved in his office."

The copy to be delivered is not to constitute a part of the library of the Secretary of State. The books deposited for copyright never do form a part of the library of the Department of State. They are, it is understood, always marked "deposited for copyright," with the date of the deposit. The books so deposited are not lent out, or ought not to be. They are "to be preserved in the office" of the Secretary of State. They are not delivered for the sake of the officer, nor are they like the copies delivered to the Stationers' Company, under the act of Anne.

Why does the law require a copy to be deposited in the office of the Secretary of State? It is a material requirement. Why, it is asked, were models and drawings to be deposited in the Patent Office, a part of the Department of State? That is a kindred subject, and the reason is the same in one case as in the other.

If a model or a drawing of a machine or invention is required to be deposited in the Patent Office, the reasons and the objects of the requirement are, that the public may know what the invention is; and that, after the limited period shall have expired, they may have the use of it, according to the purpose of the provision in the Constitution. A book or writing is required to be deposited for the same reason. The matter claimed as original is there to be preserved, in order that the extent and nature of the claim for the limited period may be known. The deposit of the title in the clerk's office, the publication of the record in the newspapers, give no information of the contents of the work; but the deposit of it in the Secretary's office does this; and as it is "to be preserved" there at all times, there the extent of the author's claims can be always known.

The law enjoins on the Secretary of State obligations which are consistent with those views of its purposes. It is made his duty to preserve the books deposited in his office. He is thus the trustee of the author and of the public. The court will not suppose this duty is ever neglected. It will always presume the injunctions of the law are complied with.

As to the author, he has an easy mode of securing the evidence of his compliance with the law. To his rights, the preservation of the book deposited is not essential. He has done all that is required of him, by depositing the copy of his work; and the certificate of the Secretary of State, which the Secretary has power to give, will be evidence of the deposit.

An examination of the provisions of the act of 1802, must result in the conviction that the construction contended for by the defendants is the true one. The act must be interpreted,—not altered. It must be read in its own words, and according to the common meaning and use of the terms in which it is expressed. The first and second sections of the act are those upon which the construction is to be given; and no better language, for the clear interpretation of them, can be used than that used by Judge WASHINGTON, in *Ever v. Coxe*.

It is of no importance to the case, whether, by the law of 1790, the acts to be done by an author were conditional or directory. They were enjoined—they were "requisites." The act of 1802 has so declared them, and without this they were clearly so. This cannot be reasonably denied.

The construction conceded by Judge WASHINGTON, in *Ever v. Coxe*, of the provisions of the act of 1790, is not satisfactory. Having ascertained to his complete satisfaction that the act of 1802 left no room to doubt that the acts imposed on an author were conditions essential

## Argument for the defendants.

to his copyright, that venerable and learned judge did not consider it necessary to examine the provisions of the law of 1790 with the care and scrutiny he would have done had the case rested on that law only.

The requirements of the law of 1790 are made of the party himself. It is in his power to perform them all. They are all and each of them parts of a system having reference to the author and publisher. The act of depositing a copy in the office of the Secretary of State is one of the number of acts by which he evinces his *intention* to secure a copyright, and by which he *executes* his intention. Less than the whole does not suffice to prove the intention. Less than the whole is not a copyright.

The publication in the newspapers is on the same footing. It will surely be admitted that was material. Yet they are both of the same character. There was no necessity for either, if not for both. Unless both were to be performed, both were nugatory; and the whole provisions of the law might have been a dead-letter.

The law of 1802 places the question of construction of the act of 1790 out of doubt or controversy. It declares the acts stated in the law of 1790 to be requirements. He shall, in addition to the "requisites" "enjoined" in the third and fourth sections of the act of 1790, do certain things. Every word of the law must have effect. Each section contains one requisite, and no more. Neither, therefore, can be rejected. All must have their full force.

The second section is equally clear. It helps to construe the other.

These, it will be seen, are words of enactment, not of *recital*. They make the law; they do not declare or expound it. Whatever the law may have been before 1802, it is now established. The decision in *Ewer v. Coxe*, in establishing the construction of the act of 1802, establishes that of both statutes.

Under these views of the law, founded on the fair and sound construction of their provisions, and supported by the decision in *Ewer v. Coxe*, copyright is the union of these acts, the "requirements" of the laws by an author. It is *nomen collectivum*, signifying all that confers and constitutes the right.

2. Such being the law, how stand the facts of the case? And now it must be conceded that the proof of title, and compliance with the law, lies upon the complainant. He must state the facts distinctly in the bill, and he must *prove* them as stated. Most clearly this is his duty, when he asks the extraordinary aid of a court of equity.

Nor can it be deemed unreasonable to require this. The proof of this title to copyright is of such a nature that it may easily be preserved.

It may consist of an official certificate of the deposit of a copy of the work,—of newspapers to prove the required publication.

There is a want of such allegations in the bill, as well as of such proof.

Mr. Sergeant declined going into an examination of the bill and evidence in support of the positions he assumed, considering that they had been fully sustained by the argument of Mr. Ingersoll. He also referred, in support of these positions, to the opinion of the learned judge in the Circuit Court, by whom the case was decided. (See Appendix.)

Upon the point made by the counsel for the appellants, that the delivery of the eighty copies of the reports under the reporter's act was a compliance with the requisite of copyright acts, of the deposit of a copy in the Secretary of State's office, he also referred to the decision of Judge HOPKINSON.

The case, as exhibited on the record, and by the examination of it which has been submitted to the court, is one which has no claim to the relief sought by the complainants. Its principal features are repeated, to connect with them other matters deserving the consideration of the court.

Mr. Wheaton undertook the preparation and publication of the reports of the decisions of the court, under the appointment of the court. He furnished nothing original from his own mind. All the contents of the reports were the fruits of the minds of others—supplied for the public use, at the public expense, or at the expense of others. There is not a thought of Mr. Wheaton's from the beginning to the end of the work. It was intended for the public, for their use and benefit; and should, therefore, be made as public as possible.

In process of time, after the publication of the first volume of his reports, Mr. Wheaton became a public officer, with a salary for his labor as reporter, and obliged to perform the duties of the office. This provision for the reports, it has been said in the course of the argument for the complainants, was obtained at the earnest solicitation of Mr. Wheaton. It, therefore, became a contract on his part, for the sum allowed by the law, to prepare and publish the reports. See act of 1823. He became, like the clerk of the House of Representatives, keeping the journals.

The object of his appointment, the plain purpose of the law, was to preserve a record of the proceedings and decisions of the court,—the highest tribunal in the nation,—and to give them circulation. If Mr. Wheaton could have a copyright, this object might be entirely defeated—his book might be a sealed book.

Out of this public work it becomes necessary to compile something less bulky and expensive. The usefulness of such a publication is admitted by all but those interested to deny it. Mr. Peters undertakes to prepare it, and he has completed the work. He announced his intention to do this publicly, and fully explained his plan. No efforts were made to stay this proceeding until invited by him, and after he had completed the third volume of his work. If the further circulation of his book is stopped, it will be a public injury. Such a result will limit the knowledge of the law of the land, as determined and established by this court, to but a small portion of the community; while all are interested in knowing it.

But here a question arises, whether books of reports can be copyrighted in England or in the United States.

There are no cases decided, in which the principle is established that reports of the decisions of the courts of law are the subjects of copyright. The case of *Streater v. Roper* (4 Bac. Abr. Prerogative; Maugham, 101, note) was reversed in Parliament. By that decision, the prerogative right, the right of the patentee, was established. No right, as author, was sustained by this case; but the contrary. It is true, that Maugham says the prerogative claim is ridiculous; but it rests on a decision that it is the ancient law. In the case of *Butterworth v. Robinson*, 5 Ves., 509, it does not appear how the right was derived.

By the decisions of the House of Lords, no such right is maintained. No copyright, in any one author, is supported by those decisions. No one could report but by the authority of the chancellor; and this authority was exclusive—it prohibited all others from interfering. *Gurney v. Longman*, 13 Ves., 493. The whole of this subject will be found to be examined in the compilations of Jeremy, Maugham, and Godson. The law is not established, at least it has not been so declared, that reports can be private property. Essentially, their contents are public property. The knowledge of the decisions of courts should not be confined. It is consistent with the views of this court, that copies of their opinions should be multiplied to any extent, and in any form required. Publicity is the very thing required.

4. The reporter is a public officer, and his duty, by law, is to publish. He has no liberty to keep back the matter which he collects and prepares in the performance of his official duties. The act of 1817, 3 Story's Laws, 1639, regards him as a public officer. So, by the subsequent acts, which will be found in Story's Laws, 1803, 1913, 2046. The court, in 3 Peters, 397, at January Term, 1830, decided that the reporter was the proper officer to give copies of the opinions

of the court, when required. Could he refuse such copies? Could he refuse to give a copy of a report of a case, when asked for it, on the ground that it was his property, and only to be used by his consent, and for his benefit? The whole purpose of the reporter's act would be defeated, could this be done. That act makes him the officer to give publicity to the proceedings of the court; but, upon this view of the matter, it has placed him in a situation to get possession of the official actions of the court; it has given access to the records of the court, and has placed him in a situation by which he has obtained all the materials to accomplish the plain and obvious intention of the law, for his private advantage, and that he may defeat and set at naught that intention. Such cannot be the law. This court will never sanction such pretensions.

The purpose of the appellants is to subject the defendants to all the evils of a violation of the copyright acts, by a proceeding which deprives them of the benefits of a trial by jury. Such a course will not receive the favor of this court. The facts upon which the rights of the complainants must rest, whatever may be the construction of the acts of Congress, are not made out. All the essential facts to sustain their claims are denied; and certainly, it will be admitted, the proof offered to sustain them by the complainants is imperfect. Will the court, then, give its aid in such a case? Will they reverse the decision of the Circuit Court, and order a perpetual injunction? Will they not say to the complainants, if you have rights, go into a court of law and establish them?

*Mr. Webster, in reply.*

There was at one period no regular series of reports of the decisions of this court. Mr. Cranch's reports had been published as far as the sixth volume; the rest of the matter, which afterwards formed the remaining volumes, was in manuscript. In this state of things, Mr. Wheaton proposed a regular annual publication of the decisions, with good type, and to be neatly printed. It was found necessary that there should be some patronage from the legislature, there being so few persons who would purchase the reports. Mr. Wheaton applied to Congress, personally solicited its aid, and made a case which prevailed. Congress passed a temporary law, which was renewed again and again. The successor of Mr. Wheaton has had the full benefit of the grant obtained by the personal exertions of Mr. Wheaton.

If the work of the appellee be an interference with the rights of the appellants, it is not a heedless one; it may not be an intentional interference, but the acts which constitute it are intentional. The



defendant was well advised of the injury which the appellants foresaw. This is fully proved by the evidence. The publication of the defendant has materially injured the appellants. Many volumes of Wheaton's Reports were on hand, unsold, at the time of the publication of the third volume of Condensed Reports.

The intention of the defendant was not to make an abridgment, but to make a substitute for the whole of the appellant's work. The reports of the appellant were the result of the joint action of Congress and the reporter; they set the price. If Congress had thought that the people should have them cheaper, they would have lowered the price. The defendants should not have run a risk in accommodating the public; they could judge for themselves.

The question before the court is one for the most enlarged and liberal consideration. Cases which are not in form, but are in substance an infringement of the author's right, are to be viewed, as respects the author, liberally. This spirit pervades all the adjudged cases.

Has there been an indefensible use of the appellant's labors? In the Condensed Reports there is the same matter as in the reports of the appellant, under the same names. Is this an abridgment? An abridgment fairly done, is itself authorship,—requires mind; and is not an infringement no more than another work on the same subject? In the English courts, there are frequently more reports than one of the same cases. These reports are distinct works. Abridgments are the efforts of different minds. The Condensed Reports have none of the features of an abridgment, and the work is made up of the same cases, and no more than is contained in Wheaton's Reports.

The attention of the court is called to certain facts. The laws of Congress relating to the reporter's office do not bear on the question of copyright. There is no intimation in the statute of such an interference, or that the sum allowed the reporter is in lieu of copyright. The right in the reporter to fix the price of the volumes, recognizes a right to exclude others from publishing. He receives one thousand dollars, and gives eighty copies to the United States, of the value of four hundred dollars. Would he give up the copyright for this sum, this modicum? The law was intended to secure to him the rights he possessed, and to add to them also.

Before the statute of Anne, the copyright of authors was acknowledged. In 1769, it underwent investigation in the courts. The statute of Anne was passed 1711. Pennsylvania was settled in 1682. The common law was carried to Pennsylvania on its settlement, and the statute of Anne did not change or affect it. The copyright of an

## Argument for the appellants.

author existed in the colonies, and exists in the United States; and particularly in Pennsylvania.

It has been said, by the counsel for the defendants, that there is no legislation in the State of Pennsylvania, or judgment of her courts, recognizing the common-law right. Before the revolution there were few books made, and there are no reports of the decisions of the courts anterior to that event. The common law is a fountain of remedy, perennial and perpetual—by its principles protecting rights when they are infringed, and its principles existing, although not called into action.

The import of the act of Congress of 1790 is that, before its enactment, there were legal rights of authorship existing; it provides for existing property,—not for property created by the statute. There is nothing for its provisions to stand upon but the common law. That law is not one of grant or bounty; it recognizes existing rights, which it secures. The aim of the statute was to benefit authors, and thereby the public.

The right of an author to the production of his mind is acknowledged everywhere. It is a prevailing feeling, and none can doubt that a man's book is his book—is his property. It may be true that it is property which requires extraordinary legislative protection, and also limitation. Be it so.

But the appellants are entitled to protection under the statute. It is a clear case. All the statutes should be taken together. The decision of Judge WASHINGTON in *Ewer v. Coxe* was not appealed from; and the question is for the first time before this court.

Is the deposit of the copy in the office of the Secretary of State a condition precedent or subsequent? There is no question but that it is the latter. There is no need of the deposit being made until six months after publication. From and after the recording of the title, the right is secured, and the author may immediately bring his action for an infringement. Does this case stand differently from what it would if the action had been brought within six months after recording the title-page? *Ewer v. Coxe* says the book must be deposited before the right arises; the statute says differently.

By the act of 1790, there were certain requisites, not prerequisites, enjoined on an author. Does the law of 1802 make the requisites of the act of 1790 prerequisites? There are conclusive reasons against this. It was the intention of the law to add to, but not to change the character of the law of 1790. If this was otherwise, there was a direct repeal of the second section of that law, by which an action is given upon filing the title-page in the clerk's office.

## Opinion of the court.

The act of 1802 is an addition to the first act, but not a repeal of it. This is the hinge of this case. The construction contended for will repeal the second section of the act of 1790, and will create a forfeiture.

What reason is there to doubt that the copies were deposited as required by the law? It is the ordinary course of trade to deliver them. Is it an unfair construction to suppose that the one copy required by the laws to be delivered is included in the eighty copies delivered as reporter? Is there not a special provision in the case of the reporter, that he shall deliver eighty copies, while others deliver one copy? The same term of six months is required for the delivery in both.

Mr. Justice M'LEAN delivered the opinion of the court.

After stating the case, he proceeded:

Some of the questions which arise in this case are as novel in this country as they are interesting. But one case involving similar principles, except a decision by a State court, has occurred; and that was decided by the Circuit Court of the United States for the District of Pennsylvania, from whose decree no appeal was taken.

The right of the complainants must be first examined. If this right shall be sustained as set forth in the bill, and the defendants shall be proved to have violated it, the court will be bound to give the appropriate redress.

The complainants assert their right on two grounds: First, under the common law; secondly, under the acts of Congress.

And they insist, in the first place, that an author was entitled at common law to a perpetual property in the copy of his works, and in the profits of their publication; and to recover damages for its injury, by an action on the case, and to the protection of a court of equity.

In support of this proposition, the counsel for the complainants have indulged in a wide range of argument, and have shown great industry and ability. The limited time allowed for the preparation of this opinion, will not admit of an equally extended consideration of the subject by the court.

Perhaps no topic in England has excited more discussion among literary and talented men, than that of the literary property of authors. So engrossing was the subject for a long time, as to leave few neutrals, among those who were distinguished for their learning and ability. At length the question, whether the copy of a book or literary composition belongs to the author at common law, was brought before the court of king's bench, in the great case of *Miller v. Taylor*, reported in 4 Burr., 2303. This was a case of great expectation; and the four

judges, in giving their opinions *seriatim*, exhausted the argument on both sides. Two of the judges, and Lord Mansfield, held that, by the common law, an author had a literary property in his works; and they sustained their opinion with very great ability. Mr. Justice Yeates, in an opinion of great length, and with an ability, if equalled, certainly not surpassed, maintained the opposite ground.

Previous to this case, injunctions had issued out of chancery to prevent the publication of certain works, at the instance of those who claimed a property in the copyright, but no decision had been given. And a case had been commenced at law between Tonson and Collins, on the same ground, and was argued with great ability more than once, and the court of king's bench were about to take the opinion of all the judges, when they discovered that the suit had been brought by collusion to try the question, and it was dismissed.

This question was brought before the House of Lords, in the case of *Donaldson v. Beckett et. al.*, reported in 4 Burr., 2408.

Lord Mansfield, being a peer, through feelings of delicacy, declined giving any opinion. The eleven judges gave their opinions on the following points:

1st. Whether at common law an author of any book or literary composition had the sole right of first printing and publishing the same for sale, and might bring an action against any person who printed, published, and sold the same without his consent? On this question, there were eight judges in the affirmative, and three in the negative.

2d. If the author had such right originally, did the law take it away upon his printing and publishing such book or literary composition?—and might any person afterward reprint and sell, for his own benefit, such book or literary composition, against the will of the author? This question was answered in the affirmative by four judges, and in the negative by seven.

3d. If such action would have lain at common law, is it taken away by the statute of 8 Anne?—and is an author by the said statute precluded from every remedy except on the foundation of the said statute, and on the terms of the conditions prescribed thereby? Six of the judges, to five, decided that the remedy must be under the statute.

4th. Whether the author of any literary composition, and his assigns, had the sole right of printing and publishing the same in perpetuity, by the common law? Which question was decided in favor of the author, by seven judges to four.

5th. Whether this right is any way impeached, restrained, or taken away by the statute 8 Anne? Six to five judges decided that the

right is taken away by the statute; and, the Lord Chancellor seconding Lord Camden's motion to reverse, the decree was reversed.

It would appear, from the points decided, that a majority of the judges were in favor of the common-law right of authors, but that the same had been taken away by the statute.

The title and preamble of the statute 8 Anne, ch. 19, is as follows: "An act for the encouragement of learning, by vesting the copies of printed books in the authors or purchasers of such copies, during the times therein mentioned.

"Whereas printers, booksellers, and other persons have of late frequently taken the liberty of printing, reprinting, and publishing, or causing to be printed, reprinted, and published, books and other writings, without the consent of the authors or proprietors of such books and writings, to their very great detriment, and too often to the ruin of them and their families," &c.

In 7 Term Rep., 627, Lord Kenyon says: "All arguments in the support of the rights of learned men in their works must ever be heard with great favor by men of liberal minds to whom they are addressed. It was probably on that account that, when the great question of literary property was discussed, some judges of enlightened understanding went the length of maintaining that the right of publication rested exclusively in the authors, and those who claimed under them, for all time; but the other opinion finally prevailed, which established that the right was confined to the times limited by the act of Parliament. And that, I have no doubt, was the right decision."

And in the case of the *University of Cambridge v. Pryer*, 16 East, 319, Lord Ellenborough remarked: "It has been said that the statute of 8 Anne has three objects, but I cannot subdivide the first two; I think it has only two. The counsel for the plaintiffs contended that there was no right at common law, and perhaps there might not be; but of that we have not particularly anything to do."

From the above authorities, and others which might be referred to if time permitted, the law appears to be well settled in England, that, since the statute of 8 Anne, the literary property of an author in his works can only be asserted under the statute; and that, notwithstanding the opinion of a majority of the judges in the great case of *Miller v. Taylor* was in favor of the common-law right before the statute, it is still considered in England as a question by no means free from doubt.

That an author, at common law, has a property in his manuscript, and may obtain redress against any one who deprives him of it, or by improperly obtaining a copy endeavors to realize a profit by its pub-

## Opinion of the court.

lication, cannot be doubted; but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world.

The argument that a literary man is as much entitled to the product of his labor as any other member of society, cannot be controverted. And the answer is, that he realizes this product by the transfer of his manuscripts, or in the sale of his works, when first published.

A book is valuable on account of the matter it contains, the ideas it communicates, the instruction or entertainment it affords. Does the author hold a perpetual property in these? Is there an implied contract by every purchaser of his book, that he may realize whatever instruction or entertainment which the reading of it shall give, but shall not write out or print its contents?

In what respect does the right of an author differ from that of an individual who has invented a most useful and valuable machine? In the production of this, his mind has been as intensely engaged, as long and perhaps as usefully to the public, as any distinguished author in the composition of his book.

The result of their labors may be equally beneficial to society, and in their respective spheres they may be alike distinguished for mental vigor. Does the common law give a perpetual right to the author, and withhold it from the inventor? And yet it has never been pretended that the latter could hold, by the common law, any property in his invention after he shall have sold it publicly.

It would seem, therefore, that the existence of a principle may well be doubted which operates so unequally. This is not a characteristic of the common law. It is said to be founded on principles of justice, and that all its rules must conform to sound reason. Does not the man who imitates the machine profit as much by the labor of another as he who imitates or republishes a book? Can there be a difference between the types and press with which one is formed, and the instruments used in the construction of the other?

That every man is entitled to the fruits of his own labor, must be admitted; but he can enjoy them only, except by statutory provision, under the rules of property which regulate society, and which define the rights of things in general.

But if the common-law right of authors were shown to exist in England, does the same right exist, and to the same extent, in this country?

It is clear there can be no common law of the United States. The Federal government is composed of twenty-four sovereign and inde-

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Opinion of the court.

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pendent States, each of which may have its local usages, customs, and common law. There is no principle which pervades the Union and has the authority of law, that is not embodied in the Constitution or laws of the Union. The common law could be made a part of our Federal system only by legislative adoption.

When, therefore, a common-law right is asserted, we must look to the State in which the controversy originated. And in the case under consideration, as the copyright was entered in the clerk's office of the District Court of Pennsylvania, for the first volume of the book in controversy, and it was published in that State, we may inquire, whether the common law as to copyrights, if any existed, was adopted in Pennsylvania.

It is insisted that our ancestors, when they migrated to this country, brought with them the English common law, as a part of their heritage.

That this was the case to a limited extent, is admitted. No one will contend that the common law, as it existed in England, has ever been in force in all its provisions in any State in this Union. It was adopted, so far only as its principles were suited to the condition of the colonies; and from this circumstance we see what is common law in one State is not so considered in another. The judicial decisions, the usages and customs of the respective States, must determine how far the common law has been introduced and sanctioned in each.

In the argument, it was insisted that no presumption could be drawn against the existence of the common law, as to copyrights, in Pennsylvania, from the fact of its never having been asserted until the commencement of this suit.

It may be true, in general, that the failure to assert any particular right may afford no evidence of the non-existence of such right. But the present case may well form an exception to this rule.

If the common law, in all its provisions, has not been introduced into Pennsylvania, to what extent has it been adopted? Must not this court have some evidence on this subject? If no right, such as is set up by the complainants, has heretofore been asserted, no custom or usage established, no judicial decision been given, can the conclusion be justified that, by the common law of Pennsylvania, an author has a perpetual property in the copyright of his works?

These considerations might well lead the court to doubt the existence of this law in Pennsylvania, but there are others of a more conclusive character.

The question respecting the literary property of authors was not made a subject of judicial investigation in England until 1760, and

## Opinion of the court.

no decision was given until the case of *Miller v. Taylor* was decided, in 1769. Long before this time, the colony of Pennsylvania was settled. What part of the common law did Penn and his associates bring with them from England?

The literary property of authors, as now asserted, was then unknown in that country. Laws had been passed, regulating the publication of new works under license; and the king, as the head of the Church and the State, claimed the exclusive right of publishing the acts of Parliament, the book of common prayer, and a few other books.

No such right at the common law had been recognized in England when the colony of Penn was organized. Long afterwards, literary property became a subject of controversy, but the question was involved in great doubt and perplexity; and, a little more than a century ago, it was decided, by the highest judicial court in England, that the right of authors could not be asserted at common law, but under the statute. The statute of 8 Anne was passed in 1710.

Can it be contended that this common-law right, so involved in doubt as to divide the most learned jurists of England, at a period in her history as much distinguished by learning and talents as any other, was brought into the wilds of Pennsylvania by its first adventurers? Was it suited to their condition?

But there is another view still more conclusive.

In the eighth section of the first article of the Constitution of the United States, it is declared that Congress shall have power "to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." And in pursuance of the power thus delegated, Congress passed the act of the 30th of May, 1790.

This is entitled "An act for the encouragement of learning, by securing the copies of maps, charts, and books to the authors and proprietors of such copies, during the times therein mentioned."

In the first section of this act, it is provided, "that from and after its passage, the author or authors of any map, chart, book or books, already printed within these United States, being a citizen, &c., who hath or have not transferred to any other person the copyright of such map, chart, book or books, &c., shall have the sole right and liberty of printing, reprinting, publishing, and vending such map, book or books, for fourteen years."

In behalf of the common-law right, an argument has been drawn from the word *secure*, which is used in relation to this right, both in the Constitution and in the acts of Congress. This word, when used as a verb active, signifies to protect, insure, save, ascertain, &c.



## Opinion of the court.

The counsel for the complainants insist that the term, as used, clearly indicates an intention not to originate a right, but to protect one already in existence.

There is no mode by which the meaning affixed to any word or sentence, by a deliberative body, can be so well ascertained as by comparing it with the words and sentences with which it stands connected. By this rule, the word *secure*, as used in the Constitution, could not mean the protection of an acknowledged legal right. It refers to inventors as well as authors, and it has never been pretended by any one, either in this country or in England, that an inventor has a perpetual right at common law to sell the thing invented.

And if the word *secure* is used in the Constitution in reference to a future right, was it not so used in the act of Congress?

But it is said that by part of the first section of the act of Congress which has been quoted, a copyright is not only recognized as existing, but that it may be assigned, as the rights of the assignee are protected, the same as those of the author.

As before stated, an author has, by the common law, a property in his manuscript; and there can be no doubt that the rights of an assignee of such manuscript would be protected by a court of chancery. This is presumed to be the copyright recognized in the act, and which was intended to be protected by its provisions. And this protection was given as well to books published under such circumstances as to manuscript copies.

That Congress, in passing the act of 1790, did not legislate in reference to existing rights, appears clear from the provision that the author, &c., "shall have the sole right and liberty of printing," &c. Now, if this exclusive right existed at common law, and Congress were about to adopt legislative provisions for its protection, would they have used this language? Could they have deemed it necessary to vest a right already vested? Such a presumption is refuted by the words above quoted, and their force is not lessened by any other part of the act.

Congress, then, by this act, instead of sanctioning an existing right, as contended for, created it. This seems to be the clear import of the law, connected with the circumstances under which it was enacted.

From these considerations, it would seem that if the right of the complainants can be sustained, it must be sustained under the acts of Congress. Such was, probably, the opinion of the counsel who framed the bill, as the right is asserted under the statutes, and no particular reference is made to it as existing at common law. The claim, then,

of the complainants, must be examined in reference to the statutes under which it is asserted.

There are but two statutes which have a bearing on this subject; one of them has already been named, and the other was passed the 29th of April, 1802.

The first section of the act of 1790 provides that an author, or his assignee, "shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the term of fourteen years, from the recording of the title thereof in the clerk's office, as hereinafter directed; and that the author, &c., in books not published, &c., shall have the sole right and liberty of printing, reprinting, publishing, and vending such map, chart, book or books, for the like term of fourteen years, from the time of recording the title thereof in the clerk's office, as aforesaid. And at the expiration of the said term, the author, &c., shall have the same exclusive right continued to him, &c., for the further term of fourteen years; provided he or they shall cause the title thereof to be a second time recorded and published in the same manner as is hereinafter directed, and that within six months before the expiration of the first term of fourteen years."

The third section provides that "no person shall be entitled to the benefit of this act, &c., unless he shall first deposit, &c., a printed copy of the title in the clerk's office, &c." "And such author or proprietor shall, within two months from the date thereof, cause a copy of said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks."

And the fourth section enacts that "the author, &c., shall, within six months after the publishing thereof, deliver, or cause to be delivered, to the Secretary of State a copy of the same, to be preserved in his office."

The first section of the act of 1802 provides that "every person who shall claim to be the author, &c., before he shall be entitled to the benefit of the act entitled an act for the encouragement of learning, by securing the copies of maps, charts, and books to the authors and proprietors of such copies, during the time therein mentioned, he shall, in addition to the requisites enjoined in the third and fourth sections of said act, if a book or books, give information, by causing the copy of the record which, by said act, he is required to publish, to be inserted in the page of the book next to the title."

These are substantially the provisions by which the complainants' right must be tested. They claim under a renewal of the term, but this necessarily involves the validity of the right under the first as

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well as the second term. In the language of the statute, the "same exclusive right" is continued the second term that existed the first.

It will be observed, that a right accrues, under the act of 1790, from the time a copy of the title of the book is deposited in the clerk's office. But the act of 1802 adds another requisite to the accruing of the right, and that is, that the record made by the clerk shall be published in the page next to the title-page of the book.

And it is argued, with great earnestness and ability, that these are the only requisites to the perfection of the complainants' title. That the requisition of the third section to give public notice in the newspapers, and that contained in the fourth to deposit a copy in the Department of State, are acts subsequent to the accruing of the right, and, whether they are performed or not, cannot materially affect the title.

The case is compared to a grant with conditions subsequent, which can never operate as a forfeiture of the title. It is said, also, that the object of the publication in the newspapers, and the deposit of the copy in the Department of State, was merely to give notice to the public; and that such acts, not being essential to the title, after so great a lapse of time, may well be presumed. That if neither act had been done, the right of the party having accrued before either was required to be done, it must remain unshaken.

This right, as has been shown, does not exist at common law—it originated, if at all, under the acts of Congress. No one can deny that when the legislature are about to vest an exclusive right in an author or an inventor, they have the power to prescribe the conditions on which such right shall be enjoyed, and that no one can avail himself of such right who does not substantially comply with the requisitions of the law.

This principle is familiar, as it regards patent-rights, and it is the same in relation to the copyright of a book. If any difference shall be made, as it respects a strict conformity to the law, it would seem to be more reasonable to make the requirement of the author rather than the inventor.

The papers of the latter are examined in the Department of State, and require the sanction of the Attorney-General; but the author takes every step on his own responsibility, unchecked by the scrutiny or sanction of any public functionary.

The acts required to be done by an author, to secure his right, are in the order in which they must naturally transpire. First, the title of the book is to be deposited with the clerk, and the record he makes must be inserted in the first or second page; then the public notice

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in the newspapers is to be given; and within six months after the publication of the book a copy must be deposited in the Department of State.

A right undoubtedly accrues on the record being made with the clerk, and the printing of it, as required; but what is the nature of that right? Is it perfect? If so, the other two requisites are wholly useless.

How can the author be compelled either to give notice in the newspaper, or deposit a copy in the State Department? The statute affixes no penalty for a failure to perform either of these acts, and it provides no means by which it may be enforced.

But we are told they are unimportant acts. If they are, indeed, wholly unimportant, Congress acted unwisely in requiring them to be done. But whether they are important or not, is not for the court to determine, but the legislature; and in what light they were considered by the legislature, we can learn only by their official acts.

Judging, then, of these acts by this rule, we are not at liberty to say they are unimportant, and may be dispensed with. They are acts which the law requires to be done; and may this court dispense with their performance?

But the inquiry is made, shall the non-performance of these subsequent conditions operate as a forfeiture of the right?

The answer is, that this is not a technical grant of precedent and subsequent conditions. All the conditions are important; the law requires them to be performed; and, consequently, their performance is essential to a perfect title. On the performance of a part of them, the right vests; and this was essential to its protection under the statute; but other acts are to be done, unless Congress have legislated in vain, to render the right perfect.

The notice could not be published until after the entry with the clerk, nor could the book be deposited with the Secretary of State until it was published. But these are acts not less important than those which are required to be done previously. They form a part of the title, and until they are performed the title is not perfect.

The deposit of the book in the Department of State may be important to identify it at any future period, should the copyright be contested or an unfounded claim of authorship asserted.

But if doubts could be entertained whether the notice and deposit of the book in the State Department were essential to the title under the act of 1790, on which act my opinion is principally founded, though I consider it in connection with the other act, there is, in the opinion of three of the judges, no ground for doubt under the act of

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1802. The latter act declares that every author, &c., before he shall be entitled to the benefit of the former act, shall, "in addition to the requisitions enjoined in the third and fourth sections of said act, if a book, publish," &c.

Is not this a clear exposition of the first act? Can an author claim the benefit of the act of 1790, without performing "the requisites enjoined in the third and fourth sections of it"? If there be any meaning in language, the act of 1802, the three judges think, requires these requisites to be performed "in addition" to the one required by that act, before an author, &c., "shall be entitled to the benefit of the first act."

The rule by which conditions precedent and subsequent are construed in a grant, can have no application to the case under consideration, as every requisite in both acts is essential to the title.

A renewal of the term of fourteen years can only be obtained by having the title-page recorded with the clerk, and the record published on the page next to that of the title, and public notice given within six months before the expiration of the first term.

In opposition to the construction of the above statutes as now given, the counsel for the complainants referred to several decisions in England, on the construction of the statute of 8 Anne, and other statutes.

In the case of *Beckford v. Hood*, 7 Term Rep., 620, the court of king's bench decided "that an author, whose work is pirated before the expiration of twenty-eight years from the first publication of it, may maintain an action on the case for damages against the offending party, although the work was not entered at Stationers' Hall." But this entry was necessary only to subject the offender to certain penalties provided in the statute of 8 Anne. The suit brought was not for the penalties, and, consequently, the entry of the work at Stationers' Hall was not made a question in the case. In the case of *Blackwell v. Harper*, 2 Atk., 95, Lord Hardwicke is reported to have said, upon the act of 8 Anne, ch. 19, "the clause of registering with the Stationers' Company is relative to the penalty, and the property cannot vest without such entry"; for the words are "that nothing in this act shall be construed to subject any bookseller, &c., to the forfeitures, &c., by reason of printing any book, &c., unless the title to the copy of such book hereafter published shall, before such publication, be entered in the register-book of the Company of Stationers."

The very language quoted by his lordship shows that the entry was not necessary to an investiture of the title, but to the recovery of the penalties provided in the act against those who pirated the work.

His lordship decided, in the same case, that, "under an act of Par-

liament, providing that a certain inventor shall have the sole right and liberty of printing and reprinting certain prints for the term of fourteen years, and to commence from the day of first publishing thereof, which shall be truly engraved with the name of the proprietor on each plate, and printed on every such print or prints," the property in the prints vests absolutely in the engraver, though the day of publication is not mentioned.

The authority of this case is seriously questioned in the case of *Newton v. Coibie*, 4 Bingham, 241. And it would seem, from the decision of Lord Hardwicke, that he had doubts of the correctness of the decision, as he decreed an injunction without by-gone profits. And Lord Alvany, in the case of *Harrison v. Hogg*, cited in 4 Bing., 242, said "that he was glad he was relieved from deciding on the same act, as he was inclined to differ from Lord Hardwicke."

By a reference to the English authorities in the construction of statutes somewhat analogous to those under which the complainants set up their right, it will be found that the decisions often conflict with each other; but it is believed that no settled construction has been given to any British statute, in all respects similar to those under consideration, which is at variance with the one now given. If, however, such an instance could be found, it would not lessen the confidence we feel in the correctness of the view which we have taken.

The act of Congress under which Mr. Wheaton, one of the complainants, in his capacity of reporter, was required to deliver eighty copies of each volume of his reports to the Department of State; and which were, probably, faithfully delivered, does not exonerate him from the deposit of a copy under the act of 1790. The eighty volumes were delivered for a different purpose, and cannot excuse the deposit of the one volume as specially required.

The construction of the acts of Congress being settled, in the further investigation of the case it would become necessary to look into the evidence and ascertain whether the complainants have not shown a substantial compliance with every legal requisite. But on reading the evidence, we entertain doubts which induce us to remand the cause to the Circuit Court, where the facts can be ascertained by a jury.

And the case is accordingly remanded to the Circuit Court, with directions to that court to order an issue of facts, to be examined and tried by a jury at the bar of said court, upon this point, viz.: whether the said Wheaton as author, or any other person as proprietor, had complied with the requisites prescribed by the third and fourth sections of the said act of Congress, passed the 31st day of May, 1790, in regard to the volumes of Wheaton's Reports in the said bill mention-

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ed, or in regard to one or more of them, in the following particulars, viz.: whether the said Wheaton or proprietor did, within two months from the date of the recording thereof in the clerk's office of the District Court, cause a copy of the said record to be published in one or more of the newspapers printed in the resident States, for the space of four weeks; and whether the said Wheaton or proprietor, after the publishing thereof, did deliver, or cause to be delivered, to the Secretary of State of the United States a copy of the same, to be preserved in his office, according to the provisions of the said third and fourth sections of the said act.

And if the said requisites have not been complied with in regard to all the said volumes, then the jury to find in particular in regard to what volumes they or either of them have been so complied with.

It may be proper to remark, that the court are unanimously of opinion that no reporter has, or can have, any copyright in the written opinions delivered by this court, and that the judges thereof cannot confer on any reporter any such right.

Mr. Justice THOMPSON, dissenting.

It is matter of regret with me, at any time, to dissent from an opinion pronounced by a majority of this court; and where my mind is left balancing, after a full examination of the case, my habitual respect for the opinion of my brethren may justify a surrender of my own. But where no such apology is left to me to rest upon, it becomes a duty to adhere to my own opinion; and I shall proceed to assign the reasons which have led me to a conclusion different from that at which a majority of the court has arrived.

It is unnecessary for me to state anything more, with respect to the bill and answer, than barely to observe that the complainants in the court below rest their claim both upon the statutory and the common-law right. The bill charges that all the provisions of the acts of Congress have been complied with; that everything has been done which was required by those acts, in order to entitle them to the benefit thereof; and that, if it were otherwise, the orator, Henry Wheaton, has, as the author of said reports, the property in the copy of the same, and the sole right to enjoy and dispose of the same.

It would be improper, in the present stage of this cause, to examine the evidence which was before the court below, touching certain questions of fact which, it is alleged, are required by the acts of Congress, in order to entitle the complainants to the benefit of those acts, have been complied with. An issue has been directed to inquire into those matters. Nor is it deemed necessary to examine whether the publi-

cation of the Condensed Reports, by the defendants, is a violation of the complainants' copyright, if they have complied with all the requisites of the acts of Congress. This would seem necessarily implied by the ordering of the issue; for such inquiries would be useless, if the right secured under those acts has not been violated.

I shall, therefore, confine myself to an examination of the common-law right, and the effect and operation of the acts of Congress upon such right.

I think I may assume, as a proposition not to be questioned, that in England, prior to the statute of Anne, the right of an author to the benefit and profit of his work is recognized by the common law. No case has been cited on the argument, and none has fallen under my observation, at all throwing in doubt this general proposition. Whenever the question has been there agitated, it has been in connection with the operation of the statute upon this right. The case of *Miller v. Taylor*, 4 Burr., 2303, decided in the year 1769, was the first determination in the court of king's bench upon the common-law right of literary property. In that case, the broad question is stated and examined, whether the copy of a book, or literary composition, belongs to the author by the common law; and three of the judges, including Lord Mansfield, decided in the affirmative. Mr. Justice Yeates dissented. But I am not aware that, upon this abstract question, a contrary decision has ever been made in England. This would seem to be sufficient to put at rest that general question, and render it unnecessary to go into a very particular examination of the reasons and grounds upon which the decision was founded. The elaborate examination bestowed upon the question, by the judges in that case, has brought into view, on both sides of the question, the main arguments of which the point is susceptible. The great principle on which the author's right rests, is that it is the fruit or production of his own labor, and which may, by the labor of the faculties of the mind, establish a right of property, as well as by the faculties of the body; and it is difficult to perceive any well-founded objection to such a claim of right. It is founded upon the soundest principles of justice, equity, and public policy. Blackstone, in his Commentaries, 2d vol., 405, has succinctly stated the principle, that when a man, by the exertion of his rational powers, has produced an original work, he seems to have clearly a right to dispose of that identical work as he pleases, and any attempt to vary the disposition he has made of it appears to be an invasion of that right;—that the identity of a literary composition consists entirely in the sentiment and the language. The same conception, clothed in the same words, must necessarily be the same



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composition; and whatever method be taken to exhibit that composition to the ear or to the eye of another, by recital, by writing, or by printing, in any number of copies or at any period of time, it is always the identical work of the author which is so exhibited; and no other man, it has been thought, can have a right to exhibit it, especially for profit, without the author's consent. The origin of this right is not, probably, to be satisfactorily ascertained; and, indeed, if it could, it might be considered an objection to its existence as a common-law right; but, from the time of the invention of printing, in the early part of the fifteenth century, such a right seems to have been recognized. The historical account of the recognition of the right is to be collected from the discussions in *Miller v. Taylor*. The Stationers' Company was incorporated in the year 1556, and from that time to the year 1640 the crown exercised an unlimited authority over the press, which was enforced by the summary process of search, confiscation, and imprisonment given to the Stationers' Company, and executed by the then supreme jurisdiction of the star chamber. In the year 1640, the star chamber was abolished, and the existence of copyrights before that period, upon principles of usage, can only be looked for in the Stationers' Company, or the star chamber or acts of State; and the evidence on this point, says Mr. Justice Wills, is liable to little suspicion. It was indifferent to the views of government, whether the property of an innocent book, licensed, was open or private property.

It was certainly against the power of the crown to allow it as private property, without being protected by any royal privilege. It could be done only on principles of private justice, moral fitness, and public convenience, which, when applied to a new subject, make common law, without a precedent;—much more when received and approved by usage. And in this case of *Miller v. Taylor* it was found, by the special verdict, “that before the reign of her late majesty, Queen Anne, it was usual to purchase from authors the *perpetual copy-right* of their books, and to assign the same from hand to hand for valuable consideration, and to make the same the subject of family settlements, for the provision of wives and children.” This usage is evidence of the common law, and shows that the copyright was considered and treated as property transferable from party to party; and property, too, of a permanent nature, suitable for family settlement and provisions.

Common law, says Lord Coke, (1 Inst., 1, 2,) is sometimes called right—common right—common justice. And Lord Mansfield says the common law is drawn from the principles of right and wrong, the

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fitness of things, convenience and policy. And it is upon these principles that the copyright of authors is protected. After the year 1640, when the press became subject to license, the various ordinances and acts of Parliament referred to in *Miller v. Taylor*, and collected in Maugham's Treatise on the Law of Literary Property, pages 13 to 16, necessarily imply and presuppose the existence of a common-law right in the author.

The common law, says an eminent jurist, (2 Kent's Com., 471,) includes those principles, usages, and rules of action applicable to the government and security of person and property which do not rest for their authority upon any express and positive declaration of the will of the legislature. A great proportion of the rules and maxims which constitute the immense code of the common law, grew into use by gradual adoption, and received, from time to time, the sanction of the courts of justice, without any legislative act or interference. It was the application of the dictates of natural justice and of cultivated reason to particular cases. In the just language of Sir Matthew Hale, the common law of England is not the product of the wisdom of some one man, or society of men, in any one age, but, of the wisdom, counsel, experience, and observation of many ages of wise and observing men. And, in accordance with these sound principles, and as applicable to the subject of copyright, are the remarks of Mr. Christian, in his notes to Blackstone's Commentaries, 2 Bl. Com., 406, and note. Nothing, says he, is more erroneous than the practice of referring the origin of moral rights, and the system of natural equity, to the savage state which is supposed to have preceded civilized establishments, in which literary composition, and, of consequence, the right to it, could have no existence. But the true mode of ascertaining a moral right is to inquire whether it is such as the reason, the cultivated reason of mankind, must necessarily assent to. No proposition seems more conformable to that criterion, than that every one should enjoy the reward of his labor,—the harvest where he has sown, or the fruit of the tree which he has planted. Whether literary property is *sui generis*, or under whatever denomination of rights it may be classed, it seems founded upon the same principle of general utility to society which is the basis of all other moral rights and obligations. Thus considered, an author's copyright ought to be esteemed an invaluable right, established in sound reason and abstract morality.

It is unnecessary, for the purpose of showing my views upon this branch of the case, to add anything more. In my judgment, every principle of justice, equity, morality, fitness, and sound policy concurs in protecting the literary labors of men to the same extent that prop-

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erty acquired by manual labor is protected. The objections to the admission of the common-law right of authors are generally admitted to be summed up, in all their force and strength, by Mr. Justice Yeates, in the case of *Miller v. Taylor*. These objections may be classed under two heads: the one founded upon the nature of the property or subject-matter of the right claimed, and the other on the presumed abandonment of the right by the author's publication.

The first appears to me to be too subtle and metaphysical to command the assent of any one, or to be adopted as the ground of deciding the question. It seems to be supposed that the right claimed is to the ideas contained in the book. The claim, says Mr. Justice Yeates, is to the style and ideas of the author's composition; and it is a well-established maxim, that nothing can be an object of property which has not a corporeal substance. The property claimed is all ideal: a set of ideas which have no bounds or marks whatever,—nothing that is capable of a visible possession,—nothing that can sustain any one of the qualities or incidents of property. Their whole existence is in the mind alone. Incapable of any other modes of acquisition or enjoyment than by mental possession or apprehension; safe and invulnerable from their own immateriality, no trespass can reach them, no tort affect them, no fraud or violence diminish or damage them;—yet these are the phantoms which the author would grasp and confine to himself, and these are what the defendant is charged with having robbed the plaintiff of.

He asks, can sentiments themselves (apart from the paper on which they are contained) be taken in execution for a debt? or, if the author commits treason or felony, or is outlawed, can the ideas be forfeited? Can sentiments be seized, or, by any right whatever, be vested in the crown? If they cannot be seized, the sole right of publishing them cannot be confined to the author. How strange and singular, says he, must this extraordinary kind of property be, which cannot be visibly possessed, forfeited, or seized, nor is susceptible of any external injury, nor, consequently, of any specific or possible remedy.

These and many other similar declarations are made by Mr. Justice Yeates, to illustrate his view of the nature of a copyright. And he seems to treat the question as if the claim was to a mere idea, not embodied or exhibited in any tangible form or shape. No such pretension has ever been set up, that I am aware of, by any advocate of the right to literary property. And this view of it would hardly deserve a serious notice, had it not been taken by a distinguished judge. Lord Mansfield, in the case of *Miller v. Taylor*, in defining the nature of the right of copyright, says: "I use the word copy in the technical

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sense in which that name or term has been used for ages, to signify an incorporeal right to the sole printing and publishing of something intellectual, communicated by letters;" and this is the sense in which I understand the term copyright always to be used, when spoken of as property.

The other objection urged by Mr. Justice Yeates, that the publication by the author is an abandonment of the exclusive right, rests upon more plausible grounds, but is equally destitute of solidity.

This would seem, according to his view of the case, the main point in the cause. The general question, he says, is whether, after a voluntary and *general publication* of an author's work by himself, or by his authority, the author has a sole and perpetual property in that work, so as to give him a right to confine every subsequent publication to himself or his assigns forever.

And he lays down this general proposition: That the right of publication must forever depend on the claimant's property in the thing to be published. Whilst the subject of publication continues his own exclusive property, he will so long have the sole and perpetual right to publish it. But whenever that property ceases, or by any act or event becomes common, the right of publication will be equally common. The particular terms in which Mr. Justice Yeates states his proposition are worthy of notice. He puts the case upon its being a *general publication*, the meaning of which undoubtedly is, that the publication is without any restriction, expressed or implied, as to the use to be made of it by the party into whose hands it might come, by purchase or otherwise. Unless such was his meaning, the proposition, I presume, no one will contend can be maintained. Suppose an express contract made with a party who shall purchase a book that he shall not republish it,—this surely would be binding upon him.

So, if the bookseller should give a like notice of the author's claim, and a purchase of a book made without any express stipulation not to republish, the law would imply an assent to the condition; and any circumstances from which such an undertaking could be reasonably inferred, would lead to the same legal consequences. The nature of the property, and the general purposes for which it is published and sold, show the use which is to be made of it. The usual and common object which a person has in view in the purchase of a book is for the instruction, information, or entertainment to be derived from it, and not for republication of the work. It is the use of it for these purposes which is implied in the sale and purchase; and this use is in subordination to the antecedent and higher right of the author, and comes strictly within the maxim, *sic utere tuo ut alienam non lædas*.

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But the case is not left to rest on any implied notice of the author's claim, and the conditions on which he makes it public. This is contained on the title-page of the very book purchased, and cannot be presumed to escape the notice of the purchaser. It is there, in terms, announced that the author claims the right of publication; and whoever purchases, therefore, does it with notice of such claim, and is bound to use it in subordination thereto. Mr. Justice Yeates admits that every man is entitled to the fruits of his own labor; but that he can be entitled to it only subject to the general rights of mankind, and the general rules of property; and that there must be a limitation to such right, otherwise the rights of others are infringed. The force of such limitation upon the right is not readily perceived. If the right exists, it is a common-law right, growing out of the natural justice of the case, being the result of a man's own labor. He thinks the statute of Anne fixes a just limitation. But suppose no statute had been passed on the subject, where would have been the limitation? The right existing, who would have authority to say where it should end? It must necessarily be without limitation, and it is no infringement of the rights of others. They enjoy it for the purpose intended, and according to the nature of the property. The purchaser of the book has a right to all the benefit resulting from the information or amusement he can derive from it. And if, in consequence thereof, he can write a book on the same subject, he has a right so to do. But this is a very different use of the property from the taking and publishing of the very language and sentiment of the author, which constitute the identity of his work.

Mr. Justice Yeates puts the effect of a publication upon the ground of intent in the author. The act of publication, says he, when voluntarily done by the author, is virtually and necessarily a gift to the public; and he must be deemed to have so intended it. But no such intention can surely be inferred, when the contrary intention is inscribed upon the first page of the book, which cannot escape notice.

The case of *Percival v. Phipps*, 2 Ves. and Beam., 19, recognizes the implied prohibition against publishing the work of another, arising from the very nature of the property. It was held in that case, that private letters, having the character of literary composition, were within the spirit of the act protecting literary property, and that by sending a letter, the writer did not give the receiver authority to publish it; and this is the doctrine of Lord Hardwicke in *Pope v. Carl*, 2 Atk., 342, where it is said that familiar letters may form a literary composition, in which the author retains his copyright, and does not, by sending them to the person to whom they are addressed, authorize

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him, or a third person, to use them for the purpose of profit, by publishing them against the interest and intention of the author;—that by sending the letter, though he parts with the property of the paper, he does not part with the property of copyright in the composition.

But how stands the case with respect to the effect of publication by the author, according to Mr. Justice Yeates' own rule? He says, "in all abandonments of such kind of property, two circumstances are necessary"—an actual relinquishing of the possession, and an *intention* to relinquish it. That the author's name being inserted in the title-page is no reason against the abandonment; for many of our best and noblest authors have published their works from more generous views than pecuniary profit. Some have written for fame and the benefit of mankind. That the omission of the author's name can make no difference; for, if the property be absolutely his, he has no occasion to add his name to the title-page. He cannot escape, it seems, from calling the copyright *property*, although a mere *idea*; and resorts again to his favorite theory, that it has no *indicia*, no distinguishing marks to denote his proprietary interest therein; and hard, says he, would be the law that should adjudge a man guilty of a crime, when he had no possibility of knowing that he was doing the least wrong to any individual. That he could not know who was the proprietor of these intellectual ideas, they not having any ear-marks upon them, or tokens of a particular proprietor.

If, as Mr. Justice Yeates admits, it is a question of *intention* whether the author meant to abandon his work to the public, and relinquish all private or individual claims to it, no possible doubt can exist as to the conclusion in the present case. Would a jury hesitate a moment upon the question, under the evidence before the court? The right set up and stamped upon the title-page of the book shuts the door against any inference that the publication was intended to be a gift to the public.

Mr. Justice Yeates admits, that so long as a literary composition is in manuscript, and remains under the sole dominion of the author, it is his exclusive property. It would seem, therefore, that the *idea*, when once reduced to writing, is susceptible of identity, and becomes the subject of property. But property, without the right to use it, is empty sound, says Mr. Justice Aston, in *Miller v. Taylor*. And, indeed, it would seem a mere mockery for the law to recognize any thing as property, which the owner could not use safely and securely for the purposes for which it was intended, unless interdicted by the principles of morality or public policy.

It is not necessary that I should go into any particular examination

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of the construction of the statute of Anne, or to what extent it may affect the common-law right of authors in England, because, as I shall hereafter show, that statute was never considered in force in Pennsylvania. The mere common-law right, uninfluenced by that statute, is alone drawn in question under this branch of the case; and the decision in the case of *Miller v. Taylor* would seem to have put that question at rest in England, at that day. Mr. Justice Yeates, in aid of his opinion, relied much upon that statute, arguing that from the title, which is, "An act for the encouragement of learning, by vesting the copies of printed books in the authors or purchasers of such copies, during the times therein mentioned," and from the provision in the act, that the sole right should be vested, &c., for twenty-one years, and no longer, the right was created and limited by the act, and did not rest upon the common law. The other three judges, however, maintained that an author's right was not derived from the statute, but that he had an original perpetual common-law right and property in his work, and that the statute was only cumulative, and giving additional remedies for a violation of the right; that the preamble in the act proceeds upon the ground of a right of property in the author having been violated, and that the act was intended as a confirmation of such right; and that, from the remedy enacted against the violation of the right being only temporary, it might be argued that it afforded an implication that there existed no right but what was secured by the act,—to guard against which, there is an express saving in the ninth section of the act: "Provided, that nothing in this act contained shall extend, or be construed to extend, either to prejudice or confirm any right that the said universities, or any of them, or any person or persons, have or claim to have to the printing or reprinting any book or copy already printed, or hereafter to be printed;" that the words any right manifestly meant any other right than the term secured by the act. It may be observed here, that whatever may be the just weight to be given to the term "vested," and the words "no longer," as used in the statute of Anne, and so much relied on by Mr. Justice Yeates, have no application to our acts of Congress, no such term or provision being used. A writ of error was brought in this case of *Miller v. Taylor*, but afterwards abandoned, and the law was considered settled, until called in question in *Donaldson v. Beckett*, 4 Burr., 2408, which came before the House of Lords in the year 1774, upon an appeal from a decree of the court of chancery, founded upon the judgment in *Miller v. Taylor*.

Upon this appeal, certain questions were propounded to the twelve judges. Lord Mansfield, however, gave no opinion, it being very

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unusual, as the reporter states, from reasons of delicacy, for a peer to support his own judgment upon appeal to the House of Lords. This statement necessarily implies, however, that he had not changed his opinion. There were, therefore, eleven judges who voted upon the questions.

One of the questions propounded was: Whether, at common law, an author of any book or literary composition had the sole right of *first printing* and publishing the same for sale, and might bring an action against any person who printed, published, and sold the same without his consent?

Upon this question, ten voted in the affirmative, and one in the negative.

Another question was: If the author had such right originally, *did the law take it away upon his printing and publishing* such book or literary composition, and might any person afterwards reprint and sell, for his own benefit, such book or literary composition, against the will of the author?

Upon this question, seven were in the negative, and four in the affirmative.

The vote upon these two questions settled the point, that, by the common law, the author of any literary composition, and his assigns, had the sole right of printing and publishing the same in perpetuity.

Another question propounded was: If an action would have lain, at common law, is it taken away by the statute of Anne?—and is an author, by the said statute, precluded from every remedy, except on the foundation of the statute, and on the terms and conditions prescribed thereby?

Upon this question, six voted in the affirmative, and five in the negative; and it will be perceived, that if Lord Mansfield had voted on this question, and in conformity with his opinion in *Miller v. Taylor*, the judges would have been equally divided.

That the law in England has not been considered as settled in conformity with the vote on this last question, is very certain; for it is the constant practice, in chancery, to grant injunctions to restrain printers from publishing the works of others, which practice can only be sustained on the ground that the penalties given by the statute are not the only remedy that can be resorted to. In *Miller v. Taylor*, Lord Mansfield says the whole jurisdiction exercised by the court of chancery, since 1710, the date of the statute of Anne, against pirates of copies, is an authority that authors had a property antecedent, to which the act gives a temporary additional *security*. It can stand upon no other foundation. And in the case of *Beckford v. Hood*, 7



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Term Rep., 616, it was decided that an author whose work is pirated, before the expiration of the time limited in the statute, may maintain an action on the case for damages against the offending party. Lord Kenyon says the question is, whether, the right of property being vested in authors for certain periods, the common-law remedy for a violation of it does not attach within the time limited by the act of Parliament. Within those periods, the act says that the author shall have the sole right and liberty of printing, &c. Thus, the statute having vested that right in the author, the common law gives the remedy by action in the case for violation of it; and that the meaning of the act in creating the penalties was to give an accumulative remedy. And in this all the judges concurred. And Mr. Justice Grose observes that, in the great case of *Miller v. Taylor*, Mr. Justice Yeates gave his opinion against the common-law right of authors; but he was decidedly of opinion that an exclusive right of property was vested by the statute for the time limited; and he says that, by the decision in the House of Lords of *Donaldson v. Beckett*, the common-law right of action is not considered as taken away by the statute of Anne, but that it could not be exercised beyond the time limited by that statute; and it is worthy of notice that this action on the case for damages was sustained, although the work was not entered at Stationers' Hall, nor the author's name affixed to the first publication. This, Lord Kenyon observes, was to serve as a notice and warning to the public, that none might ignorantly incur the penalties and forfeitures given against such as pirate the works of others. But calling on a party who has injured the civil property of another, for a remedy in damages, cannot properly fall under the description of a forfeiture or penalty.

From this view of the law, as it stands in England, it is very clear that, previous to the statute of Anne, the perpetual common-law right of authors was undisputed; that after that statute, in the case of *Miller v. Taylor*, it was held, that this common-law right remained unaffected by the statute, which only gave a cumulative remedy; that the subsequent case of *Donaldson v. Beckett* limited the right to the times mentioned in the statute; but that, for all violations of the right during that time, all the common-law remedies continued, although no entry of the work at Stationers' Hall had been made, according to the provisions of the statute,—such entry being necessary only for the purpose of subjecting the party violating the right to the penalties given by the act.

I do not deem it necessary particularly to inquire whether, as an abstract question, the same reasons do not exist for the protection of

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mechanical inventions as the production of mental labor. The inquiry is not whether it would have been wise to have recognized an exclusive right to mechanical inventions. It is enough, when we are inquiring what the law is, and not what it ought to have been, to find that no such principle ever has been recognized by any judicial decision. The argument was urged, with great earnestness, by Mr. Justice Yeates, in *Miller v. Taylor*, but repudiated by Lord Mansfield and the other judges. With respect to copyrights, however, the law has been considered otherwise, and the original common-law right fully established, though modified in some respects by the statute of Anne.

I shall proceed now to some notice of the light in which copyrights have been viewed in this country.

It appears from the Journals of the old Congress (8 Journals, 257) that this question was brought before that body by sundry papers and memorials on the subject of literary *property*, and which were referred to a committee, of which Mr. Madison was one; and on the 27th of May, 1783, the following resolution was reported and adopted:

“Resolved, that it be recommended to the several States to *secure* to the authors or publishers of any new books not hitherto printed, being citizens of the United States, and to their executors, administrators, and assigns, the copyright of such books for a certain time, not less than fourteen years from the first publication; and to *secure* to the said authors, if they shall survive the term first mentioned, and to their executors, administrators, and assigns, the copyright of such books for another term or time, not less than fourteen years, such copy or exclusive right of printing, publishing, and vending the same to be *secured* to the original authors or publishers, their executors, administrators, and assigns, by such laws and such restrictions as to the several States may seem proper.”

This right is here treated and dealt with as property already existing, and not as creating anything which had previously no being. It is spoken of as something tangible, that might pass to executors and administrators, and transferable by assignment. And the recommendation to the State was, to pass laws to *secure* such a right.

It must be presumed that Congress understood the light in which this subject was viewed in the mother country. And it is deserving of notice that Mr. Madison, one of the committee, afterwards wrote the number in *The Federalist* where this subject is discussed; and where it is expressly asserted that this has been adjudged in England to be a right at common law.

And it is worthy of remark, also, that no mention is here made of any right in mechanical inventions; and although the arts and sci-

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ences are connected in the same clause in the Constitution, and placed under the legislative power of Congress, it does not by any means follow that they were considered as standing on the same footing.

Several of the States had already passed laws on this subject, and many others, in compliance with the recommendation of Congress, did the same.

The State of Massachusetts, as early as March, 1783, passed a law entitled "An act for the purpose of *securing* to authors the exclusive right and benefit of publishing their literary productions for twenty-one years." The preamble to this act shows, in a strong and striking manner, the views entertained at that day, in this enlightened State, of the value of this right: "Whereas, the improvement of knowledge, the progress of civilization, the public weal of the community, and the advancement of human happiness greatly depend on the efforts of learned and ingenious persons in the various arts and sciences; as the principal encouragement such persons can have, to make great and beneficial exertions of this nature, must exist in the legal security of the fruits of their study and industry to themselves; and as such security is one of the natural rights of all men, there being no *property* more peculiarly a man's own than that which is produced by the labor of his mind: Therefore, to encourage learned and ingenious persons to write useful books, for the benefit of mankind, be it enacted," &c. The act then proceeds to declare that all books, treatises, and other literary works, &c., shall be the sole property of the author or authors, being subjects of the United States of America, their heirs and assigns, for the full and complete term of twenty-one years from the date of their first publication. And certain penalties are affixed to a violation of the right, with a proviso that the act shall not be construed to extend in favor, or for the benefit, of any author or subject of any other of the United States, until the State of which such author is a subject shall have passed similar laws for securing to authors the exclusive right and benefit of publishing their literary productions. 1 Laws Mass., 94.

This act recognizes, in the fullest and most unqualified manner, the natural right which an author has to the productions and labor of his own mind. And it is worthy of notice that the act does not recognize as a natural right, or in any manner provide for the protection of mechanical inventions, thereby showing the distinction between mental and manual labor, in the view of that legislature, although it is now attempted to put them on the same footing.

The State of Connecticut had previously, in the same year, (January, 1783,) passed an act for the encouragement of literature and

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genius, containing the following preamble: "Whereas, it is perfectly agreeable to the principles of natural justice and equity that every author should be *secured* in receiving the profits that may arise from the sale of his works, and such security may encourage men of learning and genius to publish their writings, which may do honor to their country and service to mankind." Certain provisions are then made for the security of such right, which it is unnecessary here to be particularly noticed.

There is a like proviso, as in the Massachusetts act, that the benefit of the law is not to extend to authors inhabitants of, or residing in, other States, until such States have passed similar laws. Statutes of Connecticut, 474. This law is also confined to literary productions, and in no manner extending to mechanical labors.

In the colony of New York, in the year 1786, a law "to promote literature" was passed, reciting: "Whereas, it is agreeable to the principles of natural equity and justice that every author should be *secured* in receiving the profits that may arise from the sale of his works, and such security may encourage persons of learning and genius to publish their writings, which may do honor to their country and service to mankind;" and then making provision for securing to authors the sole right of printing, publishing, and selling their works for fourteen years,—with a proviso to the fourth section of the act, recognizing a common-law right, but leaving it open and unaffected in cases not coming within the act, viz., "provided, that nothing in this act shall extend to, affect, prejudice, or confirm the rights which any person may have to the printing or publishing of any books or pamphlets at *common law*, in cases not mentioned in this act."

The State of Virginia, also, in the year 1785, passed a similar law, for *securing* to authors of literary works an exclusive property therein for a limited time. 1 Rev. Code, 534. Like laws, for the same purpose, were passed by other States, which are not necessary here to be noticed, enough having been referred to to show the light in which literary property was viewed in this country, and that such laws were passed with a view to protect and secure a preëxisting right, founded on the eternal rules and principles of natural right and justice, and recognized by the common law.

But under the existing governments of the United States, before the adoption of the present Constitution, adequate protection could not be given to authors throughout the United States, by any general law. It depended on the legislatures of the several States; and this led to the provisions in the present Constitution, giving to Congress power "to promote the progress of science and the useful arts, by *se-*

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curing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." Constitution, article 1, section 8.

It has been argued at the bar that, as the promotion of the progress of science and the useful arts is here united in the same clause in the Constitution, the rights of authors and inventors were considered as standing on the same footing; but this, I think, is a *non sequitur*. This article is to be construed distributively, and must have been so understood; for when Congress came to execute this power by legislation, the subjects are kept distinct, and very different provisions are made respecting them. All the laws relative to inventions purport to be acts to promote the progress of the useful arts. They do not use any language which implies or presupposes any existing prior right *to be secured*, but clearly imply that the whole exclusive right is created by the law, and ends with the expiration of the patent. The first law, passed in the year 1790, 1 Story's Ed., 80, requires that the specification shall be so particular as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman, or other person skilled in the art or manufacture, to make, construct, or use the same, *to the end that the public may have the full benefit thereof, after the expiration of the patent term*. This is the consideration demanded by the public for the protection during the time mentioned in the patent; and the books furnish no case, that I am aware of, where an action has been attempted to be sustained upon any supposed common-law right of the inventor.

But the case is quite different with respect to copyrights. All the laws on this subject purport to be made for *securing* to authors and proprietors such copyright. They presuppose the existence of a right which is to be secured, and not a right originally created by the act. The security provided by the act is for a limited time. But there is no intimation that at the expiration of that time the copy becomes common, as in the case of an invention. The right, at the expiration of the time limited in the acts of Congress, is left to the common law protection, without the additional security thrown around it by the statutes, and stands upon the same footing as it did before the statutes were passed. The protection for a limited time, by the aid of penalties, against the violators of the right, proceeds upon the ground that the author, within that time, can so multiply his work, and reap such profits therefrom, as to enable him to rest upon his common-law right, without the extraordinary aid of penal laws.

In *The Federalist*, (No. 43,) written by Mr. Madison, who reported the resolution referred to, in the old Congress, this clause in the Con-

stitution is under consideration, and the writer observes that the utility of this power will scarcely be questioned. *The copyright of authors has been solemnly adjudged in Great Britain to be a right at common law.* The right to useful inventions seems, with equal reason, to belong to the inventors. The public good fully coincides, in both cases, with the claims of individuals. The States cannot separately make effectual provision for either of the cases, and most of them have anticipated the decision of this point by laws passed at the instance of Congress.

Although it is here said that the right to useful inventions seems with equal reason to belong to the inventors as the copyright to authors, yet it is not pretended that the common law equally recognizes them. But the contrary is necessarily implied, when it is expressly said that the copyright has been adjudged to be a common-law right, but is silent as to inventors' rights.

The common-law right of authors is expressly recognized by Mr. Justice Story in his Commentaries. In noticing this article in the Constitution, he says: "This power did not exist under the confederation, and its utility does not seem to have been questioned. The copyright of authors in their works had, before the revolution, been decided in Great Britain to be a common-law right, and it was regulated and limited under statutes passed by Parliament upon that subject." 3 Story's Com., 48. If these statutes do not affect the right in the case now before the court, it remains and is to be viewed as a common-law right.

The judge in the court below who decided this case seems to place much reliance on what he considers a doubt, suggested by Chancellor Kent, as to the existence of the common-law right. Let us see what he does say. "It was," says he, "for some time the prevailing and better opinion in England that authors had an exclusive copyright at common law, as permanent as the property of an estate; and that the statute of Anne, protecting by penalties that right for fourteen years, was only an additional sanction, and made in affirmance of the common law. This point came at last to be questioned, and it became the subject of a very serious litigation in the court of king's bench. It was decided in *Miller v. Taylor*, 1769, that every author had a common-law right in perpetuity, independent of statute, to the exclusive printing and publishing of his original compositions. The court was not unanimous, and the subsequent decision of the House of Lords, in *Donaldson v. Beckett*, in February, 1774, settled this very litigated question against the opinion of the king's bench, by establishing that the common-law right of action, *if any existed*, could not

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be exercised beyond the time limited by the statute of Anne, 2 Com., 375, second edition. It is here fully admitted that, by the decision in *Miller v. Taylor*, every author had a common-law right in perpetuity to the publishing of his original composition. And if it was intended to intimate that the subsequent decision, in *Donaldson v. Beckett*, overruled this decision as to the common-law right, I apprehend this must be a mistake, according to the report of the case in 4 Burr. I understand the decision then was, by ten of the judges, that at common law an author had the sole right of *first printing* and publishing his work, and, by seven judges to four, that such right continued after his *first publication*. It is true, it was decided, by six to five of the judges, that the common-law right of action could not be exercised beyond the time limited by the statute of Anne. But with the construction of this statute we have no concern, if it was not in force in Pennsylvania. The settlement of the common-law right is the material point, and that is admitted, by Chancellor Kent, to have been decided in favor of the author. There is certainly considerable obscurity in the report of this case, as to how far it has modified the common-law remedy. This arises probably from the manner in which the questions were propounded by the House of Lords to the judges.

I do not perceive how it becomes necessary in this case to decide the question whether we have here any code of laws known and regarded as the common law of the United States. This case presents a question respecting the right of property, and in such cases the State laws form the rules of decision in the courts of the United States; and the case now before the court must be governed by the law of copyright in the State of Pennsylvania. The complainants, though citizens of New York, are entitled to the benefit of those laws for the protection of their property, and have a right to prosecute their suit in the courts of the United States.

If, by the common law of England, an author has the copyright in his literary compositions, it becomes necessary to inquire whether that law is in force in the State of Pennsylvania.

It was very properly admitted by the court below, on the trial of this cause, that when the American colonies were first settled by our ancestors, it was held, as well by the settlers as by the judges and lawyers of England, that they brought with them, as a birthright and inheritance, so much of the common law as was applicable to their local situation and change of circumstances, and that each colony judged for itself what parts of the common law were applicable to its new condition. Mr. Justice Story recognizes the same principle in his Commentaries, vol. 1, 137-140. Englishmen, says he, removing

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to another country, must be deemed to carry with them those rights and privileges which belong to them in their native country; and that the plantations formed in this country were to be deemed a part of the ancient dominions, and the subjects inhabiting them to belong to a common country, and to retain their former rights and privileges. That the universal principle has been (and the practice has conformed to it) that the common law is our birthright and inheritance, and that our ancestors brought hither with them, upon their immigration, all of it which was applicable to their situation. The whole structure of our present jurisprudence stands upon the original foundation of the common law. The old Congress, in the year 1774, unanimously resolved that the respective colonies are entitled to the common law of England. 1 Story's Com., 140, and note.

The colony of Pennsylvania was settled about the year 1682, at which period, and down to the time of the case of *Miller v. Taylor*, 1769, the whole course of the British government, as well in Parliament as in the star chamber and court of chancery, proceeded, in relation to the regulation of copyrights, upon the ground of an existing common-law right in authors, and which was so universally acknowledged, that it was not contested in a court of justice until that case, and then solemnly, and upon the most mature deliberation, decided to be a common-law right, notwithstanding the statute of Anne, passed in the year 1710. And the subsequent decision of *Donaldson v. Beckett* turned entirely upon the construction of that act, which it was supposed limited the remedy to the time prescribed in the act for the protection of the copyright. So that at the time of the settlement of Pennsylvania, and for nearly a century thereafter, the common-law right, with all the common-law remedies attached to it, was the received and acknowledged doctrine in England. And if the common law was brought into Pennsylvania by the first settlers, the law of copyright formed a part of it, and was in force there, and has so continued ever since, not having been abolished or modified by any legislature in that State. But the existence of the common law in Pennsylvania is not left to interfere upon the general principles applicable to emigrants, before alluded to; there is positive legislation on the subject.

We find, as early as the year 1718, a law in that colony with a recital, "Whereas, King Charles II, by his royal charter to William Penn, for erecting this country into a province, did declare it to be his will and pleasure that the laws for regulating and governing of property, within the said province, as well for the descent and enjoyment of lands as for the enjoyment and succession of goods and chat-



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tels, and likewise as to felonies, should be and continue the same as they should be, for the time being, by the general course of the law in the kingdom of England, until the said laws shall be altered by the said William Penn, his heirs and assigns, and by the free men of the said province, their delegates or deputies, or the greater part of them, and whereas it is a settled point that as the common law is the birth-right of all English subjects, so it ought to be their rule in the British dominions. But acts of Parliament have been adjudged not to extend to these plantations, unless they are particularly named as such: Now, therefore," &c.,—and certain statutes relating to crimes are adopted, and this question came under the consideration of the Supreme Court of that State, in the case of *Morris's Lessee v. Van Dorin*, 1 Dall., 64, in the year 1782, and Chief Justice M'KEAN, in pronouncing the judgment of the court, says: "This State has had her government for above a hundred years, and it is the opinion of the court that the common law of England has always been in force in Pennsylvania. That all statutes made in Great Britain before the settlement of Pennsylvania have no force here, unless they are convenient and adapted to the circumstances of the country, and that all statutes made *since the settlement of Pennsylvania* have no force here, unless the colonies are particularly named;" and he adds that the spirit of the act of 1718 supports this opinion.

With respect to English statutes which have been considered in force in Pennsylvania, we have the most satisfactory evidence in the report of the judges of the Supreme Court of that State, made under an act of the legislature passed April 7, 1807, 3 Binn., 395, by which the judges were required to examine and report which of the English statutes are in force in that commonwealth, and upon this subject the report states: "With respect to English statutes, enacted since the settlement of Pennsylvania, it has been assumed, as a principle, that they do not extend here, unless they have been recognized by our acts of assembly, or adopted by long-continued practice in courts of justice. Of the latter description there are very few, and those, it is supposed, were introduced from a sense of their evident utility. As English statutes, they had no obligatory force, but, from long practice, they may be considered as incorporated with the law of our country."

From this review of the law, I think I have shown that, by the common law in England, down, at least, to the decision in the case of *Donaldson v. Beckett*, an author was considered as having an exclusive right in perpetuity to his literary compositions; that this right, as a branch of the common law, was brought into Pennsylvania with

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the first settlers, as early as the year 1682; that whatever effect and operation the statute of Anne may have been deemed to have had upon the common law in England, that statute never having been in force in Pennsylvania, the common-law right remains unaffected by it; and, with this view of the law and the rights of an author, I proceed to consider the acts of Congress which have been passed on this subject,—observing, in the first place, that we are bound to presume that Congress understood the nature and character of this claim of authors to the enjoyment of the fruits of their literary labors, and the ground upon which it rested. This is useful and necessary to conduct us to a right understanding of their legislation. A knowledge of the mischief is necessary to a just and correct view of the remedy intended to be applied.

But the knowledge of Congress on this subject is not left open to presumption. The question as to its being an exclusive and perpetual right was brought directly to the view of Congress.

Three acts have been passed on this subject, and being not only in *pari materia*, but connected with each other by their very titles and objects, are to be construed together, and explained by each other.

The last act on the subject was passed in the year 1831, and is entitled “An act to amend the several acts respecting copyrights, approved February 3, 1831.” And the report of the judiciary committee, to whom the subject was referred, shows in what point of light the subject was presented to Congress.

Your committee, says the report, believe that the just claims of authors require from our legislation a *protection* not less than what is proposed in the bill reported. From the first principles of proprietorship *in property*, an author has an *exclusive and perpetual right*, in preference to any other, to the fruits of his labor. Though the nature of literary property is peculiar, it is not the less real and valuable. If labor and effort in producing what before was not possessed or known will give title, then the literary man has title, perfect and absolute, and should have his reward.

The object of the law, and to which the attention of Congress was specially drawn, was the *protection* of property, claimed and admitted to be exclusive and perpetual in the author.

It may be useful, preliminarily, to notice a few of the settled rules by which statutes are to be construed.

In construing statutes, three points are to be regarded: the old law, the mischief, and the remedy,—and the construction should be such, if possible, to suppress the mischief and advance the remedy. 1 Bl. Com., 87; Bac. Ab. Stat., 1, pl. 31, 32.

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An affirmative statute does not abrogate the common law.

If a thing is at common law, a statute cannot restrain it, unless it be in negative words. Plowd., 113; 2 Kent's Com., 262; 2 Mason, 451; 1 Inst., 111, 115; 10 Mod., 118; Bac. Ab. Stat., 9.

Where a statute gives a remedy, where there was one by the common law, and does not imply a negative of the common-law remedy, there will be two concurrent remedies. In such case, the statute remedy is accumulative. 2 Bac. 803, 805; 2 Inst., 200; Com. Dig. Action upon Statute, 6.

Considering the common-law right of the author established, and with these rules of construing statutes kept in view, I proceed to the consideration of the acts of Congress.

The first law was passed in the year 1790, (1st vol. Story's edition of Laws of United States, 94,) and is entitled "An act for the encouragement of learning, by *securing* the copies of maps, charts, and books to the authors and proprietors of such copies, during the times therein mentioned."

The first section declares that the author of any book or books already printed, being a citizen of the United States, and who hath not transferred the copyright to any other person, and any other person, being a citizen of the United States, &c., who hath purchased or legally acquired the copyright of such book, in order to print, reprint, publish, or vend the same, shall have the *sole right* and liberty of printing, reprinting, publishing, and vending the same, for fourteen years *from the recording of the title thereof* in the clerk's office, as hereinafter directed. The like provision is made, with respect to books or manuscripts not printed or thereafter composed. The title and this section of the act obviously consider and treat this copyright as property,—something that is capable of being transferred; and the right of the assignee is protected equally with that of the author; and the object of the act and all its provisions purport to be for *securing* the right. Protection is the avowed and real purpose for which it is passed. There is nothing here admitting the construction that a new right is created. The provision in no way or manner deals with it as such. It in no manner limits or withdraws from the right any protection it before had. It is a forced and unreasonable interpretation, and in violation of all the well-settled rules of construction, to consider it as restricting, limiting, or abolishing any preëxisting right. Statutes are not presumed to make any alteration in the common law, further or otherwise than the act expressly declares. And, therefore, when the act is general, the law presumes it did not intend to make any alteration; for if such was the intention, the legislature would have so ex-

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pressed it. 11 Mod., 148; 19 Vin., 512; Stat., E. 6, pl. 12. And hence the rule is laid down in Plowden, if a thing is at common law, a statute cannot restrain it, unless it be in negative words. It is in every sense an affirmative statute, and does not abrogate the common law.

The cumulative security or protection given by the statute attaches from the recording of the title of the book in the clerk's office of the District Court where the author or proprietor shall reside. If the statute should be considered as creating a new right, that right vests upon recording the title. This is the only prerequisite, or condition precedent, to the vesting the right. Whatever it is that is given by the statute, and the other requirements in the third and fourth sections, of publishing in the newspaper within two months from the date of the record, and delivering a copy of the book to the Secretary of State within six months from the publication, cannot be construed as prerequisites or conditions precedent to the vesting. These provisions cannot be considered in any other light than as directory. In no other view can these sections of the law be made consistent with the provisions of the first section. The benefit of the act, so far as respects the exclusive right, takes effect from the time of recording the title in the clerk's office, but the publication in the newspaper may be made at any time within two months, and the copy delivered to the Secretary of State within six months. What would be the situation of the author if his copyright should be violated before the expiration of the time allowed him for these purposes? Would he have no remedy? The second section declares in terms that if any person, from and after the recording the title, shall, without the consent of the author or proprietor, print or reprint, &c., he thereby incurs the penalties given by the act. Both the right and the remedy, therefore, given by the act, attach on the recording of the title. And this construction is not at all affected by anything contained in the third section of the act, which declares that no person shall be entitled to the benefit of this act unless he shall have deposited a printed copy of the title in the clerk's office. This is in perfect harmony with the first and second sections; and, although the requirement to publish a copy of the record in the newspaper is in the same section, it is in a separate and distinct clause, and no more required to be considered a prerequisite than if it was in a distinct section, and so it was considered by Mr. Justice WASHINGTON in *Ever v. Cox*, (4 Wash. C. C. Rep., 490,) and he also in that case considered the requirement in the fourth section, to deliver a copy to the Secretary of State, as directory, and not as a condition; and, indeed, the result of his opinion was, that if the au-

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thor's copyright depended upon the act of 1790, it would be complete by a deposit of a copy of the title in the clerk's office; but that the act of 1802 not only added another requisite, viz., causing a copy of the record to be inserted at full length in the title-page, but made the publication in the newspaper and the delivery of a copy of the book to the Secretary of State prerequisites, although not made so by the act of 1790. Mr. Justice WASHINGTON is fully supported in his construction of the act of 1790 by the case of *Nichols v. Ruggles*, 3 Day, 145, decided in the Supreme Court of errors of the State of Connecticut, where it is held that the provisions of the statute, which require the author to publish the title of his book in a newspaper and to deliver a copy of the work to the Secretary of State, are merely directory, and constitute no part of the essential requisites for securing the copyright. This case was decided in the year 1808, and I do not find any reference to the act of 1802. This can only be accounted for upon the supposition that, in the opinion of the counsel and court, this act did not at all affect the construction of the act of 1790, for had it been supposed that the act of 1802 made the publication in a newspaper and a delivery of a copy of the work to the Secretary of State prerequisites to the vesting of the copyright, it would necessarily have led to a different result on the motion for a new trial. Judge HOPKINSON, who tried the cause now before the court, thinks the act of 1790 will not admit of the construction given to it by Judge WASHINGTON, but that under that act the publication in a newspaper and delivery of a copy of the work to the Secretary of State are prerequisites to the establishment of the right; and such I understand to be the opinion of a majority of this court, by which the construction of the act of 1790 by Judge WASHINGTON is overruled. I have already attempted to show that this construction of the act of 1790 cannot be sustained; nor do I think that the act of 1802 will aid that construction of the act of 1790, and in this, I understand, my brother M'LEAN concurs, so that upon this question, as to the effect of the act of 1802 upon the act of 1790, the court is equally divided, and the decision of the cause rests upon the act of 1790. A brief notice, however, of the act of 1802 (2 Story's edition Laws of United States, 866) may not be amiss.

It purports, so far as it relates to the present question, to be a supplement to the act of 1790, and declares that the author or proprietor of a book, before he shall be entitled to the benefit of that act, shall, in addition to the requisites enjoined in the third and fourth sections of said act, give information, by causing a copy of the record, required to be published in a newspaper, to be inserted at full length in the

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title-page, or in the page immediately following the title-page of the book. It is to be observed, that this purports to be a supplementary act, the office of which is only to add something to the original act, but not to alter or change the provisions which it already contains. It leaves the original act precisely as it was, and only superadds to its provisions the matter of the supplement, and both, when taken together, will receive the same construction as if originally incorporated in the same act. This is the natural and rational view of the matter. Suppose this new requisite had been in the original act, how would it stand? If it was in a separate and distinct section, it would run thus: that the author, before he shall be entitled to the benefit of this act, shall insert, at full length, in the title-page of the book, a copy of the record of the title. This could not change the construction of the act as to the publication in the newspaper, or delivery of a copy of the book to the Secretary of State. Nor could it have any such effect, if it followed immediately after the prerequisite of depositing a printed copy of the title of the book in the clerk's office; and this would have been the natural place for the provision, if it had been inserted in the original act.

Judge WASHINGTON, in *Ever v. Cox*, says that the supplemental act declares that the person seeking to obtain this right shall perform this new requisition, in addition to those prescribed in the third and fourth sections of the act of 1790, and that he must perform the whole before he shall be entitled to the benefit of the act. I find no such declaration in the act. The second section, which relates to prints, does contain this declaration, but it has no application to books.

If the act of 1802 is intended as a legislative construction of the act of 1790, and it is clearly erroneous, it cannot be binding upon the court.

The act of 1831, being in *pari materia*, may be taken into consideration in construing the previous acts which it purports to amend; and we find in this act only two prerequisites imposed upon an author, to entitle him to the benefit of the act, viz., to deposit a printed copy of the title of the book in the clerk's office of the District Court of the district wherein the author or proprietor shall reside, and to give information of the copyright being secured, by inserting on the title-page, or the page immediately following, the entry therein directed, viz., "entered according to the act of Congress," &c. And these being prerequisites under the former laws, it is fairly to be concluded that they were the only prerequisites, and that the other requirements are merely directory; and, if so, the complainants in the court below have shown all that the acts of Congress require to vest

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the copyright. The title has been recorded in the clerk's office, and a copy of the record inserted in the title-page of the book.

But if the complainants in the court below have not made out a complete right under the acts of Congress, there is no ground upon which the common-law remedy can be taken from them. If there be a common-law right, there certainly must be a common-law remedy. The statute contains nothing in terms having any reference to the common-law right; and if such right is considered abrogated, limited, or modified by the acts of Congress, it must be by implication; and to so construe these acts, is in violation of the established rules of construction—that where a statute gives a remedy in the affirmative, without a negative expressed or implied, for a matter which was actionable at common law, the party may sue at common law as well as upon the statute. 1 Chitty's Pl., 144. This is a well-settled principle, and fully recognized and adopted in the case of *Almy v. Harris*, 5 Johns. Rep., 175.

Whatever effect the statute of Anne may have had in England, as to limiting or abridging the common-law right there, no such effect, upon any sound rules of interpretation, can grow out of our acts of Congress. There is a wide difference in the phraseology of the laws. The statute of Anne contains negative words. It declares that the author shall have the sole right and liberty of printing, &c., for the time contained in the statute, and *no longer*; and these are the words upon which the advocates for the limitation of the common-law right mainly rest; and it was, for a long time, considered, by the ablest judges in England, that even these strong words did not limit or abridge the common-law right, and the question at this day is not considered free from doubt.

This act, and the construction which it had received in England, were well known and understood when the act of Congress was passed, and no such limitation is inserted or intended, or any matter at all repugnant to the continuance of the common-law right, in its full extent. These laws proceed on the ground that the common-law remedy was insufficient to protect the right, and provide additional security, by means of penalties, for the violation of it. Congress having before them the statute of Anne, and apprised of the doubt entertained in England as to its effect upon the common-law right, if it had been intended to limit or abridge that right, some plain and explicit provision to that effect would doubtless have been made, and not having been made, is, to my mind, satisfactory evidence that no such effect was intended.

If the present action was to recover the penalties given by the

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statute, it might be incumbent on the appellants to show that all the requirements in the acts of Congress had been complied with. This would be resorting to the new statutory remedy, and the party must bring himself within the statute, in order to entitle him to that remedy. But admitting that the right depends upon the statute, and is limited to the time therein prescribed, the remedy by injunction continues during that time. This is admitted by Mr. Justice Yeates, in *Miller v. Taylor*. The author, says he, has certainly a property in the copy of his book, during the term the statute has allowed; and whilst that term exists, it is like a lease, a grant, or any other common-law right, and will equally entitle him to all common-law remedies for the enjoyment of that right. He may, I should think, file an injunction bill to stop the printing. But I may say, with more positiveness, he might bring an action to recover satisfaction for the injury done, contrary to law, under the statute. And the same doctrine is laid down, by the whole court, in *Beckford v. Wood*, 7 Term Rep., 616. Lord Kenyon says the statute vests the right in authors for certain periods; and within those periods, the act says the author shall have the sole right and liberty of printing, &c.; and the statute having vested the right in the author, the common law gives the remedy by action on the cause for a violation of it; and that the act, by creating the penalties, meant to give an accumulative remedy.

The language in the statute of Anne, which is considered as vesting the right, is the same as in the act of Congress. In the former, it is considered as necessarily implied in the declaration that the author shall have the *sole right* during such time, &c. And in the act of Congress there is the same declaration—that the author shall have the *sole right* of printing, &c., from the time of recording the title in the clerk's office. The right being thus vested at the time, draws after it the common-law remedy; and there is no more reason for contending that the remedy given by the statute supersedes the common-law remedy, under the act of Congress, than under the statute of Anne. The statute remedy is through the means of penalties in both cases.

The term for which the copyright is secured, in the case now before the court, has not expired; and, according to the admitted and settled doctrine in England, under the statute of Anne, the common-law remedy exists during that period.

Upon the whole, in whatever light this case is viewed, whether as a common-law right or depending on the act of Congress, I think the appellants are entitled to the remedy sought by the bill; and that the decree of the court below ought to be reversed, the injunction



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made perpetual, and an account taken according to the prayer in the bill, without directing an issue to try any matter of fact touching the right.

Mr. Justice BALDWIN also dissented from the opinion of the court.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Eastern District of Pennsylvania, and was argued by counsel; on consideration whereof, it is ordered, adjudged, and decreed by this court that the judgment and decree of the said Circuit Court in this cause be, and the same is hereby, reversed, and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to that court to order an issue of facts, to be examined and tried by a jury at the bar of said court, upon this point: whether the said Wheaton as author, or any other person as proprietor, had complied with the requisites prescribed by the third and fourth sections of the said act of Congress, passed the 31st day of May, 1790, in regard to the volumes of Wheaton's Reports, in the said bill mentioned, or in regard to one or more of them, in the following particulars, viz.: whether the said Wheaton or proprietor did, within two months from the date of the recording thereof in the clerk's office of the District Court, cause a copy of the said record to be published in one or more of the newspapers printed in the resident State, for four weeks; and whether the said Wheaton or the proprietor, after the publishing thereof, did deliver, or cause to be delivered, to the Secretary of State of the United States a copy of the same, to be preserved in his office, according to the provisions of the said third and fourth sections of the said act, and that such further proceedings be had therein as to law and justice may appertain, and in conformity to the opinion of this court.

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THE PHILADELPHIA AND TRENTON RAILROAD COMPANY, PLAINTIFFS  
IN ERROR, v. JAMES STIMPSON, DEFENDANT IN ERROR.

(14 Peters, 448.)

1. Action for the violation of a patent-right, granted to the patentee for "a new and useful improvement in turning short curves on railroads."
2. On the 26th September, 1835, a second patent was granted, the original patent, granted in 1831, having been surrendered and cancelled on account of a defective specification; the second patent being for fourteen years from the date of the original patent. The second patent was in the precise form of the original, except the recital of the fact that the former patent was can-

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celled "on account of a defective specification," and the statement of the time the second patent was to begin to run. It was objected that the second patent should not be admitted in evidence on the trial of the case, because it did not contain any recitals that the prerequisites of the act of Congress of 1836, authorizing the renewal of patents, had been complied with. *Held*, That this objection cannot, in point of law, be maintained. The patent was issued under the great seal of the United States, and is signed by the President, and countersigned by the Secretary of State. It is a presumption of law that all public officers, and especially such high functionaries, perform their proper official duties, until the contrary is proved. Where an act is to be done, or patent granted upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act, in granting the patent, is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. No other tribunal is at liberty to reexamine or controvert the sufficiency of such proofs, when the law has made the officer the proper judge of their sufficiency and competency.

3. Patents for lands, equally with patents for inventions, have, in courts of justice, been deemed *prima facie* evidence that they have been regularly granted whenever they have been produced under the great seal of the government, without any recitals or proofs that the prerequisites of the acts under which they have been issued have been duly observed. In cases of patents, the United States have gone one step further; and as the patentee is required to make oath that he is the true inventor, before he can obtain a patent, the patent has been deemed *prima facie* evidence that he has made the invention.
4. It is incumbent on those who seek to show that the examination of a witness has been improperly rejected, to establish their right to have the evidence admitted; for the court will be presumed to have acted correctly, until the contrary is established.
5. To entitle a party to examine a witness in a patent cause, the purpose of whose testimony is to disprove the right of the patentee to the invention, by showing its use, prior to the patent, by others, the provisions of the Patent Act of 1836, relative to notice, must be strictly complied with.
6. It is incumbent on those who insist upon the right to put particular questions to a witness, to establish that right beyond any reasonable doubt, for the very purpose stated by them; and they are not afterwards at liberty to desert that purpose, and to show the pertinency or relevancy of the evidence for any other purpose not then suggested to the court.
7. A party has no right to cross-examine any witness, except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him on other matters, he must do so by making the witness his own, and calling him as such, in the subsequent progress of the cause. A party cannot, by his own omission to take an objection to the admission of improper evidence, brought out on a cross-examination, found a right to introduce testimony in chief, to rebut it or explain it.
8. Parol evidence, bearing upon written contracts and papers, ought not to be admitted in evidence, without the production of such written contracts or papers, so as to enable both the court and the jury to see whether or not the admission of the parol evidence, in any manner, will trench upon the rule that parol evidence is not admissible to vary or contradict written contracts or papers.
9. As a general rule, and upon general principles, the declarations and conversations of the plaintiff are not admissible evidence in favor of his own rights.

## Statement of the case.

This is, however, but a general rule, and admits and requires various exceptions. There are many cases in which a party may show his declarations comport with acts in his own favor, as a part of the *res gestæ*. There are other cases in which his material declarations have been admitted.

10. In an action for an assault and battery and wounding, the declarations of the plaintiff to his internal pains, aches, injuries, and symptoms, to the physician attending him, are admissible, for the purpose of showing the nature and extent of the injuries done to him. In many cases of inventions, it is hardly possible in any other manner to ascertain the precise time and exact origin of the invention.
11. The conversation and declarations of a patentee, merely affirming that at some former period he had invented a particular machine, may well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details, and explaining its operations, are properly deemed an assertion of his right at that time as an inventor, to the extent of the facts and details which he then makes known, although not of their existence at an anterior time. Such declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known and claimed by him; and thus its origin may be fixed at least as early as that period.
12. If the rejection of evidence is a matter resting in the sound discretion of the court, this cannot be assigned as error.
13. The mode of conducting trials, the order of introducing evidence, and the times when it is to be introduced, are properly matters belonging to the practice of the Circuit Courts, with which the Supreme Court ought not to interfere, unless it shall choose to prescribe some fixed general rules on the subject, under the authority of the act of Congress. The Circuit Courts possess this discretion in as ample a manner as other judicial tribunals.
14. Testimony was not offered by a defendant, or stated by him as matter of defense, in the stage of the cause when it is usually introduced according to the practice of the court. It was offered after the defendants' counsel had stated, in open court, that they had closed their evidence, and after the plaintiff, in consequence of that declaration, had discharged his own witness. The Circuit Court refused to admit the testimony. *Held*, That this decision was proper.

In error from the Circuit Court of the United States for the Eastern District of Pennsylvania.

At the April session of the Circuit Court, James Stimpson instituted an action against the plaintiffs in error, for the recovery of damages for the violation of a patent granted to him by the United States, on the 26th day of September, 1835, for "a new and useful improvement in the mode of turning short curves on railroads."

The case was tried on the 16th day of February, 1839, and a verdict was rendered for the plaintiff, for the sum of four thousand two hundred and fifty dollars. On the 6th of May, 1839, a remittitur was entered on the docket of the court, for the sum of one thousand dollars; and a judgment was entered for the plaintiff for three thousand two hundred and fifty dollars.

## Statement of the case.

On the trial of the cause, the defendants tendered a bill of exceptions to the decisions of the court, on their admitting the patent to the plaintiff in evidence, and to other rulings of the court in the course of the trial. The defendants prosecuted this writ of error.

The patent granted by the United States to James Stimpson was as follows:

“The United States of America to all to whom these letters patent shall come:

“Whereas, James Stimpson, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the mode of turning short curves on railroads, for which letters patent were granted the twenty-third day of August, 1831, which letters being hereby cancelled on account of a defective specification, which improvement, he states, has not been known or used before his application, hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement, hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: These are, therefore, to grant, according to law, to the said James Stimpson, his heirs, administrators, or assigns, for the term of fourteen years from the twenty-third day of August, 1831, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said James Stimpson himself, in the schedule hereto annexed.”

Tested at Washington, under the seal of the United States, on the 26th day of September, 1836, by the President of the United States, and certified in the usual form by the Attorney-General of the United States.

“The schedule referred to in these letters patent, and making a part of the same,” contained “a description, in the words of the said James Stimpson himself, of his improvement in the mode of turning short curves on railroads, for which letters patent were granted, dated the twenty-third day August, 1831, which letters patent being hereby cancelled on account of a defective specification.”

The specification describes the invention with minute particularity, and concludes: “What I claim as my invention or improvement, is the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn curves upon railways, particularly such as turning the corners of

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Argument for the plaintiffs in error.

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streets, wharves, &c., in cities and elsewhere, operating upon the principle herein set forth."

The bill of exceptions stated that the counsel for the plaintiff offered in evidence the patent and specification, to the admission of which in evidence the counsel for the defendant objected; but the objection was overruled by the court, and the evidence was admitted.

2. The defendants offered to give in evidence, by Josiah White, the description of a flange upon one side of the railroad cars, and the running upon the tread of the wheel upon the other side, with the flange in a groove, for the turning of curves, which he had seen in use before the date of plaintiff's patent—which was objected to by the counsel for the plaintiff, and the objection sustained by the court. The objection of the counsel for the plaintiff to the introduction of the testimony of Josiah White, was founded on the absence of the notice required by the act of Congress, of the use of the machine at Mauch Chunk, at which place, it was said, his testimony would show it had been used.

3. The third exception was to the refusal of the court to allow the defendants to introduce proof of the conversation between the patentee and the counsel of the Baltimore and Ohio Railroad Company, while an arrangement of a suit against the company was made, as to the character and effects of the arrangements.

4. The counsel for the plaintiff, by rebutting evidence, to extend his claim to the invention prior to the time at which the defendants had proved the reduction of the same into use and practice by others, offered to give evidence by witnesses of the conversations of the patentee on the subject of his invention at an anterior period—which conversations were intended to show the making of the invention by the patentee before and at the period when the same took place. The counsel for the defendants objected to the admission of this testimony; but the court overruled the objection.

5. The fifth exception was to the refusal of the court to admit the examination of Dr. Thos. P. Jones. The plaintiff had discharged his witnesses, on the declaration of the defendants' counsel that they had closed their evidence. The testimony asked from Dr. Jones was to new facts. The court refused to admit the testimony, on the ground that the testimony was improper, and that it was offered too late.

The case was argued by *Mr. Cox* and *Mr. Southard*, for the plaintiffs in error; and by *Mr. J. R. Ingersoll*, for the defendant.

*Mr. Cox* and *Mr. Southard*, on the first exception.

The patent should not have been admitted in evidence. On its

## Argument for the plaintiffs in error.

face, it is inoperative and invalid. It is not a patent under the act of Congress of 1793; but it purports to be a substituted patent for one which had been surrendered. It gives to the patentee the same privileges as those which were given by the first patent. It, therefore, should be in strict and exact conformity with the law of 1793 as well as with the subsequent act of Congress, authorizing the surrender of a patent for an imperfect specification, and the issue of another.

The act of 21st February, 1793, requires, by its third section, that the applicant shall be the true inventor of the machine, &c. This is made a *sine qua non* to the granting the patent, and the oath of the claimant is required to this fact. This provision makes the oath necessary, before the Secretary of State has authority to grant the patent. There is no remedy, if this has been omitted.

There was no decision before the case of *Morris v. Huntington*, Paine's Reps., 348, which affirmed the right of a patentee to surrender his patent for an erroneous or imperfect specification. After this case, Congress authorized such a surrender. Act of Congress of July 3, 1832. By this act, the cause of the surrender must be made out to the satisfaction of the Secretary of State, when a second patent is asked for. It has been decided, that a patent is *prima facie* evidence of the statements on the face of the patent. This does not give any other validity to those statements; and it is not sufficient that some of the requirements of the act of Congress are stated. All must be set forth, and an averment must be made that everything has been done. There is no halting point. Those requirements exist as to any patent granted after the surrender of a patent. The errors or imperfections in the specification, on which the surrender has been made, should be stated. *Grant v. Raymond*, 6 Peters, 218. In the case cited, there was a recital of the surrender of the patent, and the cause of its surrender.

There is in the patent which was before the Circuit Court no recital of the imperfections of the first specification,—no allegation that there was no fraud in the transaction. There is nothing shown but the gratuitous act of the officer in granting the second patent. And yet all the prerequisites to the granting of a second patent should appear in it as well as be of record in the Patent Office.

Without these essential features in a patent given on the surrender of a previous one for the same invention, it cannot be read in evidence to a jury. The requirements in both the acts of Congress of 1792 and 1832, must appear in it. If all those matters are not shown, the second patent stands as a new patent; and by allowing it to be given in evidence, the court altogether disregard the law. If the patent, in

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Argument for the defendant in error.

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this imperfect form, is admitted as *prima facie* proof, all the burden of contradicting it is thrown on the opposite party. Cited on these points *Shaw v. Cooper*, 7 Peters, 245.

In support of the second exception, the counsel contended that the notice given was sufficient to authorize the introduction of the testimony of Josiah White. Cited on this point *Evans v. Eaton*, Peters' C. C. R., 322; Wheat. Rep., S. C. The notice would have been sufficient under the act of Congress of 1793; and why not under the act of July 3, 1836?

The objection to the introduction of the evidence by the counsel for the defendants, which was sustained by the court, and which is the subject of the defendant's third exception, was well taken. It was in the power of the plaintiff to have produced his contract with the Baltimore and Ohio Railroad Company, and have rendered this evidence unnecessary. He did not do so.

As to the fourth exception. It is admitted that it was the right of the plaintiff to prove, by legal rebutting evidence, that the invention made by him, and for which he held the patent, was in use before the period in which the defendant had proved the invention by him. But this evidence could not be given by showing the conversations of the plaintiff on the subject of the invention before the date of the first patent.

Conversations on the subject of an invention are not the invention; nor are the ideas of the invention its actual development. There must be an application of the thought in the construction of the machine.

This is an attempt to give the declarations of a party in evidence after the actual occurrence of the transaction. No declaration of a person, that he intended to take out a patent, could be given in evidence. Cited on this point 1 Wheat. Rep., 313; 10 Serg. & Rawle, 27; 5 Serg. & Rawle, 295; Roscoe on Evidence, 21; 4 Wash. C. C. R., 58; 5 Mason, 6; 1 Gallis. C. C. R., 438.

As to the fifth exception, the counsel contended that the evidence of Dr. Jones was rebutting evidence, and was regular, as it was offered to meet and disprove the plaintiff's declarations, which the court had admitted as testimony.

*Mr. Ingersoll, for the defendant in error.*

1. The objection to the certificate of the Secretary of State should apply rather to the effect than the admissibility of the document. That officer is authorized by law to issue patents, and the presumption is that he has done so rightfully. Possession of the document does not

affect the intrinsic rights of any one. Every question of merit is still open. It enables the patentee to sue, but it neither secures him in the enjoyment of the alleged invention, nor precludes others from contesting the validity of his claims. In the different cases cited, the patent appears to have been received in evidence exactly in the form now exhibited, although it may have availed nothing to the plaintiff afterwards.

*Sullivan v. Redfield*, 1 Paine, 447: "The patent is *primâ facie* evidence of the right." *The Margaretta*, 2 Gall., 519; Remission, though not valid, was given in evidence. See also *Bingham v. Cabot*, 3 Dall., 19; *Bell v. Morrison*, 1 Peters, 355; *Keene v. Meade*, 3 Peters, 6; *The United States v. Liddle*, 2 Wash. C. C. Rep., 205.

2. The testimony of Josiah White would have been admitted under the sixth section of the law of 1793. But the fifteenth, or corresponding section of the law of 1836, requires notice of place, person, and residence. As the law previously stood, great injustice might have been done, unless the court had construed it so as to invest the judge with power to prevent the plaintiff from being taken by surprise. *Evans v. Eaton*, 3 Wheat., 505. The law now wisely anticipates the necessity for an exercise of judicial discretion and possible delay; and requires notice of the place where the improvement is supposed by a defendant to have been previously used. This was not given, and the testimony was necessarily rejected.

3. Although, in truth, the offer to examine Mr. Latrobe upon certain points was not rejected by the court, but withdrawn by the counsel, yet, as it appears by the record to have been a point decided, I will submit to treat it accordingly. The testimony would no doubt have been rejected if the offer had been persisted in, and the delay that would be requisite to put the record right would be deeply injurious to my client.

(1.) The inquiries suggested for the witness are impracticable, and they lead to impracticable results. The inquiry refers to a "negotiation," "arrangement," and "settlement." It asserts the fact that a "grant" or "contract" was made. Negotiation is the necessary preliminary to a contract, is absorbed in it, and forms a part of it. How can you separate them? Out of one identified existence, two things are to be made, essentially distinct from each other. That is impossible.

(2.) The inquiries are irrelative. The arrangement contemplated was *res inter alios acta*. The plaintiffs in error were altogether strangers to it. Many inducements may lead to a settlement with one person which would not render it desirable with another. If it were



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Argument for the defendant in error.

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not that Ross Winans had previously been cross-examined by the counsel for the plaintiffs in the Circuit Court, to the point of settlement with the Baltimore and Ohio Company, no pretense for the inquiry would exist. If that was wrong, this will not make it right. It was not objected to. If not strictly cross-examination, we had no right to resort to it. *Ellmaker v. Buckley*, 16 Serg. & Rawle. If it was regular cross-examination, it cannot justify the proposed irregularity. But we were bound to put the witness on his guard as to a collateral fact which might impeach his testimony. Rule in the Queen's case.

(3.) The object attempted to be proved was a mere entity; an abstraction; nothing actually done, but at best something omitted or avoided; a conclusion or construction; a contingency without a substantial thing to support it.

(4.) It was an attempt to prove by parol some known written arrangement which was susceptible of being produced.

4. Explanations of the patentee himself were good evidence to prove the genuineness of his claims to originality. It is necessary to understand the manner in which this testimony was produced. Plaintiff at first simply produced his patent, and called a witness who proved its utility and infringement by the defendants. Then the defendants went at large into proof of alleged priority of the invention by other persons. All of this went to show a use before the date of the plaintiff's patent. A necessity was therefore thrown upon him of proving that his invention existed, and was communicated by him to different persons at a still earlier period. No doubt of the importance of such proof. It consisted of evidence of plaintiff's invention prior to the defendants' knowledge, or the knowledge of those persons on whom they relied. To meet this particular exigency, that is, to show invention, it is difficult to conceive what can be authentic, except what comes from the inventor himself. He therefore produced several individuals, who stated that he described the improvement to them at a period considerably earlier than defendants had fixed for its earliest use. If he described it, he must have known it. If he knew it before any other person, he must have invented it. That prior knowledge was invention; and that was the very thing to be proved.

Two objections were taken to the character of the proof: 1. That it was derived from the plaintiff himself. 2. That the alleged improvement was not then brought into practical use by him.

Answer 1st. It was an invention, else not patentable; in other words, it must spring from himself. An exhibition of it must necessarily, in some shape or other, be his act. Whatever might be said

or done by others, could not be available to him. The exhibition might be effected by deed, signs, or words. It matters not in what particular manner the effect is produced, but the discovery must make manifest its paternity; and it can do so only through the medium of its proper parent.

This may be done by his works—a machine constructed. Let it be produced; original, practical, perfect in all its parts. Nothing is gained by the author, unless something more than all this appears, namely, authorship. However eloquent the machine may be as to its uses, it cannot speak for itself as to its author. The nearest it can come to speech would be an inscription or label on its front: “J. S., fecit,” for example.

That would at best be a written declaration. What difference would it make that the writing, or stamping, or printing should be in a book? That description of evidence, in a sister department of the law, is conclusive of important rights. It maintaining copyrights, the writing of the party is the essence of the discovery, and the sole proof of invention or originality. If, instead of writing with his own hand, the same author dictates to another person, cannot the amanuensis prove the dictation, and hence the authorship? A blind author has often given to the world the result of his genius, through the pen of another. On a question of authorship, surely the testimony of the scribe would be received as competent.

Another species of proof of invention remains, namely, oral explanation alone. Why may it not be received? It is the very thing itself. To speak it, was to create it, if it did not already exist in thought; and if it did, it must prove it. The proof was given to counteract the allegation of earlier discovery. It produces the effect by showing that the earlier discoverers, as they are regarded, received from the plaintiff the information which enabled them to put the invention in use, and then attempt to deny the right of showing how the information was communicated and obtained. One of the very pieces of testimony objected to, consisted of a conversation with the person who claimed to be an inventor in preference to the plaintiff.

The declarations did not stand alone; they were accompanied by two drawings and a model. The date of the existence of these monuments is clearly proved. The conversations became but a part of the *res gestæ*.

There are many occasions on which one's own sayings and doings are good evidence; in some instances the best, and in others the only evidence. The present is an anomaly, unless it concurs. It does not follow that the expressions of an individual are the illegal crea-

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Argument for the defendant in error.

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tion of testimony for himself. Such are—1. Various kinds of declarations *ante litem motam*. 2. When the sayings are the doings, as in cases of notice. 3. Where the expressions of an individual are the test of a given state of things, as intellect. 4. Proof of a contract, as marriage, by words *de presenti*. 5. Almost any other discovery or invention, not connected with the useful arts. A reward is offered for lost property; the finder informs of the finding of it; the declarations can be proved. ♦

Answer 2d. As to the objection that the explanations were not reduced to practice. Here, too, the objection loses sight of the fact that our evidence was not original, but merely designed to meet a collateral issued as to the period of invention, and not exactly as to invention itself. On any ground, however, the question of invention does not depend upon whether the thing has been reduced to practice, but whether it can be,—not whether it is actually practiced, but practicable. Drawings, descriptions, and models are sent to the Patent Office. These are miniature likenesses,—not the thing itself. Any other course would, in many instances, be quite impracticable. A ship, a house, a town are often the recipients of an improvement which cannot be practically exhibited, except in connection with the vast object to which it is applied. Sometimes the reducing to practice might be destructive of life or property. A guillotine need not be rehearsed in order to prove its power.

Besides, it might destroy the very intention, to insist on practical exercise. It might be regarded as giving the invention to the public, and then the patent-right is gone forever.

5. Thomas P. Jones was called by the defendants, after all the testimony in chief, on both sides, and the plaintiff's rebutting testimony also had been given, and his witnesses dismissed; and much time had been occupied in giving rebutting testimony for the defendants. The declared object was to prove that the invention described in the plaintiff's patent of 1835 was different from the invention described by him in his patent of 1831—in other words, that the patent which purported to be a mere correction of form was, in substance, a totally different thing. We are struck at once with an inconsistency between this point and the whole tenor of the defendants' case. The notice which they gave, the aim of their evidence, their great design, is to show that the thing relied on by the plaintiff, which was patented by him in 1835, was well known and used in 1831—known to everybody, publicly, notoriously. Yet we are now told that it was not known even to the plaintiff himself, but that he found it necessary, four years afterwards, to desert the alleged invention of 1831, and surreptitiously

to foist in a different thing, which then became known to him for the first time. Unless this is the true meaning of the point, it has none.

The evidence offered was original and direct. It contradicted nothing already asserted in evidence. It was directed to a point in no way collateral. It went immediately to the essential merits of the case. It was of great importance, undoubtedly. Nothing could be more conclusive against the plaintiff. Not only would it be destructive of his claim to originality, but it would prove a most audacious fraud, abortively attempted, and calculated, when detected, to deprive him of all standing in or out of court, and to render his defeat as disgraceful as it was inevitable.

Notice of all this ought to have been given, perhaps. It is not urged, however, as an argument, that none was received, although it might have been calculated to take the plaintiff by surprise. But it was a fact above all others requiring, and in its nature admitting of, countervailing proof. Not a clerk in the office, probably, could have failed to give material testimony in reply. These persons were at a distance; and we should have been left to the question of probability whether a man, in any extremity of impudent fraud, would have ventured to place two totally different patents side by side in the office, asserting that they were in substance identical.

The evidence offered was not the best the nature of the case admitted of. Contradiction was to be proved between two written instruments, with, perhaps, a model accompanying each of them. Copies would be the proper sources of illustration. Were copies not accessible? We do not know. No inquiry was made. A thousand copies may have been made before the Patent Office was destroyed. Plaintiff himself, no doubt, had such copies in his possession. No notice was given to him to produce them, before this violent attempt was made to introduce the secondary evidence.

To get rid of all this, the argument was, that the difference was only to be inferred between the patents from a difference between the conversation and one of them. But that would rebut nothing. No person denied that plaintiff's conversations with the witnesses he produced were as they were sworn to be. Other conversations with other persons might show descriptions of other inventions; but they could not possibly show that the first conversations did not take place. The judge gave two reasons for rejecting the testimony. One was, that it was offered at too late a stage of the cause. That was ruled in his sound discretion. From the exercise of that discretion there is no appeal. No attempt was made to take one. On both of his grounds

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he was right. But one was sufficient to cover the whole question, and it is inaccessible to review here.

Mr. Justice STORY delivered the opinion of the court.

This is a writ of error to the judgment of the Circuit Court for the Eastern District of Pennsylvania, rendered in an action brought by Stimpson, the defendant in error, against the plaintiffs in error, for a violation of a patent right granted to him for a new and useful improvement in the mode of turning short curves on railroads.

A patent was originally granted to Stimpson, for the same invention, on the 23d day of August, 1831, and the renewed patent, upon which the present suit is brought, was granted on the 26th of September, 1835, upon the former letters patent "being cancelled on account of a defective specification"; and the renewed patent was for the term of fourteen years from the date of the original patent. With the exception of the recital of the fact that the former letters patent were cancelled "on account of a defective specification," and the statement of the prior date from which the renewed patent was to begin to run, the renewed patent is in the precise form in which the original patents are granted.

At the trial upon the general issue, a bill of exceptions was taken to certain rulings of the court upon points of evidence, to the consideration of which we shall at once proceed, without any further preface.

The first exception taken is to the admission of the renewed patent as evidence in the cause to the jury. The Patent Act of 1832, ch. 162, sec. 3, under which this patent was obtained, provides, that whenever any patent shall be inoperative or invalid, by reason that any of the terms or conditions prescribed by the prior acts of Congress have not, by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, been complied with on the part of the inventor, it shall be lawful for the Secretary of State, upon the surrender to him of such patent, to cause a new patent to be granted to the inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, upon his compliance with the terms and conditions prescribed by the third section of the act of the 21st of February, 1792, ch. 55.

Now, the objection is, that the present patent does not contain any recitals that the prerequisites thus stated in the act have been complied with, namely, that the error in the former patent has arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention; and that without such recitals, as it is the case of a special authority, the patent is a mere nullity, and inoperative. We

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are of opinion that the objection cannot, in point of law, be maintained. The patent was issued under the great seal of the United States, and is signed by the President, and countersigned by the Secretary of State. It is a presumption of law, that all public officers, and especially such high functionaries, perform their proper official duties, until the contrary is proved. And where, as in the present case, an act is to be done or patent granted upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act or granted the patent is *prima facie* evidence that the proofs have been regularly made, and were satisfactory. No other tribunal is at liberty to reëxamine or controvert the sufficiency of such proofs, if laid before him, when the law has made such officer the proper judge of their sufficiency and competency. It is not, then, necessary for the patent to contain any recitals that the prerequisites to the grant of it have been duly complied with, for the law makes the presumption; and if, indeed, it were otherwise, the recitals would not help the case, without the auxiliary proof that these prerequisites had been *de facto* complied with. This has been the uniform construction, as far as we know, in all our courts of justice, upon matters of this sort. Patents for lands, equally with patents for inventions, have been deemed *prima facie* evidence that they were regularly granted, whenever they have been produced under the great seal of the government, without any recitals or proofs that the prerequisites of the acts under which they have been issued have been duly observed. In cases of patents, the courts of the United States have gone one step further, and as the patentee is required to make oath that he is the true inventor before he can obtain a patent, the patent has been deemed *prima facie* evidence that he has made the invention. This objection, then, is overruled; and there was no error in the Circuit Court in the admission of the patent.

The next exception is to the refusal of the court to allow a witness, Josiah White, to give a description of an invention which he had seen on the Mauch Chunk Railroad, in 1827, which had a groove on one side, and run on the other on a flange for crossing, for the purpose of showing that the supposed invention of the plaintiff was known and in use by others before the date of his patent. By the Patent Act of 1836, (which was applicable to the present point,) it is provided, in the fifteenth section, that whenever the defendant relies, in his defense, on the fact of a previous invention, knowledge, or use of the thing patented, he shall state, in his notice of special matter to be used in his defense, the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing,

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and where the same had been used. The object of this most salutary provision, is to prevent patentees being surprised, at the trial of the cause, by evidence of a nature which they could not be presumed to know or be prepared to meet, and thereby to subject them either to most extensive delays or to a loss of their cause. It is incumbent on those who seek to show that the examination of a witness has been improperly rejected, to establish their right to have the evidence admitted; for the court will be presumed to have acted correctly, until the contrary is established.

In the present case, there is no proof on the record that notice had been given, according to the requirements of the statute, that White was to be a witness for the purpose above stated. Unless such notice was given, it is plain that the examination could not be rightfully had. The *onus probandi* is on the defendants to show it, and unless they produce the notice, the objection must fail. In point of fact, it was admitted by counsel, at the argument, that no such notice was given. In either view, then, from the admission, or from the defect of the preliminary proof of notice in the record, the exception is not maintainable.

The next exception is to the refusal of the court to allow certain questions to be put by the defendants to John H. B. Latrobe, a witness introduced by the defendants to maintain the issue on their part. Latrobe, on his examination, stated: "I know Mr. Stimpson by sight and character. He granted to the Baltimore and Ohio Railroad Company the privilege of using the curved ways on their railroad, and all lateral roads connected therewith. I fix the date of the contract in the early part of October, 1834, because I have then a receipt of Mr. Stimpson's counsel for two thousand five hundred dollars. Mr. Stimpson laid his claim against the Baltimore Company for an infringement of his patent in 1832. It was referred to me by the company, and I advised them." The counsel for the defendants then offered to prove, by the same witness, the declarations of the plaintiff and his agent to the witness, that the settlement made with the Baltimore and Ohio Railroad Company with the plaintiff was not an admission by the said company of the plaintiff's right in the alleged invention, but a mere compromise of a pending suit, disconnected with a grant, in writing, made by the plaintiff to the said company; and to that end proposed to put the following questions, respectively, and in order, to the witness: "1. Do you know who was the agent or attorney of James Stimpson, in negotiating the arrangement and settlement between him and the company referred to? Who was he? 2. State if any conversations occurred between James Stimpson, or his

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agent or counsel, at any time during the negotiations, regarding the rights claimed by him in the patent for curved ways, without reference to the existence of a written contract or its contents. 3. What were they?" The court refused to allow these questions to be put, for the purpose aforesaid.

Now, (as has been already intimated,) it is incumbent upon those who insist upon the right to put particular questions to a witness, to establish that right beyond any reasonable doubt, for the very purpose stated by them; and they are not afterwards at liberty to desert that purpose, and to show the pertinency or relevancy of the evidence for any other purpose not then suggested to the court. It was not pretended, at the argument, that the evidence so offered was good evidence in chief, in behalf of the defendants, upon the issue in the cause. It was *res inter alios acta*, and had no tendency to disprove the defendant's title to the invention, or to support any title set up by the defendants; for no privity was shown between the defendants and the Baltimore Company. As evidence in chief, therefore, it was irrelevant and inadmissible. The sole purpose for which it was offered, so far as it was then declared to the court, was to show that the compromise with the Baltimore Company was not founded on any admission of the plaintiff's right in the invention. Be it so; it was then inconsequential, for it certainly had no just tendency to disprove his right. If the compromise had been offered on the part of the plaintiff, for the purpose of establishing his right to the invention, there is no pretense to say that it would have been admissible against the defendants. In the converse case, it is equally inadmissible for the defendants.

But it is now said that the evidence was, in fact, offered for the purpose of rebutting or explaining certain statements made by one Ross Winans, a witness called by the defendants, in his answers upon his cross-examination by the plaintiff's counsel. Now, this purpose is not necessarily, or even naturally, suggested by the purpose avowed in the record. Upon his cross-examination, Winans stated: "I understood there were arrangements made with the Baltimore Company. I heard the company paid five thousand dollars." Now, certainly these statements, if objected to by the defendants, would have been inadmissible upon two distinct grounds: 1. First, as mere hearsay; 2. And, secondly, upon the broader principle, now well established, although sometimes lost sight of in our loose practice at trials, that a party has no right to cross-examine any witness except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him to other matters, he must do



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so by making the witness his own, and calling him, as such, in the subsequent progress of the cause. The question then is presented, whether a party can, by his own omission to take an objection to the admission of improper evidence brought out on a cross-examination, found a right to introduce testimony in chief to rebut it or explain it. If, upon the cross-examination, Winans' answer had been such as was unfavorable to the plaintiff, upon the collateral matters thus asked, which were not founded in the issue, he would have been bound by it, and not permitted to introduce evidence to contradict it. There is great difficulty in saying that the defendants ought to be in a more favored predicament, and to acquire rights founded upon the like evidence to which they did not choose to make any objection, although otherwise it could not have been in the cause. But waiving this consideration, the grounds on which we think the refusal of the court was right, are, first, that it was not distinctly propounded to the court, that the evidence was offered to rebut or explain Winans' testimony; and, secondly, that in the form in which it was put, it proposed to separate the written contract of compromise from the conversations and the negotiations which led to it, and to introduce the latter without the former, although it might turn out that the written paper might most materially affect or control the presumptions deducible from those conversations and negotiations. We think that, upon the settled principles of law, parol evidence bearing upon written contracts and papers ought not to be admitted without the production of such written contracts or papers, so as to enable both the court and the jury to see whether or not the admission of the parol evidence in any manner will trench upon the rule, that parol evidence is not admissible to vary or contradict written contracts or papers.

The next exception is to the admission of the evidence of William A. Stimpson, Richard Caton, and George Neilson, as to certain declarations, and statements, and conversations of the plaintiff, as to his invention prior to the date of his original patent, in order to rebut the evidence of the defendants, as to the invention or use by other persons of the same contrivance before that date. The objection is, that, upon general principles, the declarations and conversations of a plaintiff are not admissible evidence in favor of his own rights. As a general rule, this is undoubtedly true. It is, however, but a general rule, and admits and requires various exceptions. There are many cases in which a party may show his declarations conflict with acts in his own favor, as a part of the *res gestæ*. There are other cases, again, in which his material declarations have been admitted. Thus, for example, in the case of an action for an assault and battery, and

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wounding, it has been held that the declarations of the plaintiff, as to his internal pains, aches, injuries, and symptoms, to the physician called to prescribe for him, are admissible for the purpose of showing the nature and extent of the injuries done to him. See 1 Phillips on Evidence, ch. 12, sec. 1, pp. 200-202, 8th ed., 1838. In many cases of inventions, it is hardly possible in any other manner to ascertain the precise time and exact origin of the particular invention. The invention itself is an intellectual process, or operation, and, like all other expressions of thought, can in many cases scarcely be made known except by speech. The invention may be consummated and perfect, and may be susceptible of complete description in words, a month, or even a year, before it can be embodied in any visible form, machine, or composition of matter. It might take a year to construct a steamboat, after the inventor had completely mastered all the details of his invention, and had fully explained them to all the various artisans whom he might employ to construct the different parts of the machinery. And yet, from those very details and explanations, another ingenious mechanic might be able to construct the whole apparatus, and assume to himself the priority of the invention. The conversations and declarations of a patentee, merely affirming that at some former period he invented that particular machine, might well be objected to. But his conversations and declarations, stating that he had made an invention, and describing its details and explaining its operations, are properly to be deemed an assertion of his right, at that time, as an inventor, to the extent of the facts and details which he then makes known, although not of their existence at an antecedent time. In short, such conversations and declarations, coupled with a description of the nature and objects of the invention, are to be deemed a part of the *res gestæ*, and legitimate evidence that the invention was then known to and claimed by him; and thus its origin may be fixed at least as early as that period. This view of the subject covers all the parts of the testimony of the witnesses objected to in the Circuit Court, and we are of opinion that the court were right in admitting the evidence.

The next and the last exception, is to the rejection of the evidence of Dr. Jones, who was offered to prove that there were material differences between the patent of 1831 and the renewed patent of 1835, and to explain these differences. No doubt can be entertained that the testimony thus offered was, or might be, most material to the merits of the defense. And the question is not as to the competency or relevancy of the evidence, but as to the propriety of its being admitted at the time when it was offered. It appears that the testimony

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was not offered by the defendants, or stated by them, as a matter of defense, in the stage of the cause when it is usually introduced according to the practice of the court. It was offered, after the defendants' counsel had stated, in open court, that they had closed their evidence, and after the plaintiff, in consequence of that declaration, had discharged his own witnesses. The question, then, is, whether it was at that time admissible on the part of the defendants, as a matter of right, or whether its admission was a matter resting in the sound discretion of the court. If the latter, then it is manifest that the rejection of it cannot be assigned as error.

The mode of conducting trials, the order of introducing evidence, and the times when it is to be introduced, are, properly, matters belonging to the practice of the Circuit Courts, with which this court ought not to interfere, unless it shall choose to prescribe some fixed general rules on the subject, under the authority of the act of Congress. Probably, the practice in no two States in the Union is exactly the same; and, therefore, in each State the Circuit Courts must necessarily be vested with a large discretion, in the regulation of their practice. If every party had a right to introduce evidence, at any time, at his own election, without reference to the stage of the trial on which it is offered, it is obvious that the proceedings of the court would often be greatly embarrassed, the purposes of justice be obstructed, and the parties themselves be surprised by evidence destructive of their rights, which they could not have foreseen, or in any manner have guarded against. It seems to us, therefore, that all courts ought to be, as indeed they generally are, invested with a large discretion on this subject, to prevent the most mischievous consequences in the administration of justice to suitors; and we think that the Circuit Courts possess this discretion in as ample a manner as other judicial tribunals. We do not feel at liberty, therefore, to interfere with the exercise of this discretion; and, indeed, if we were called upon to say, upon the present record, whether this discretion was, in fact, misapplied or not, we should be prepared to say that we see no reason to doubt that it was, under all the circumstances, wisely and properly exercised. It is sufficient for us, however, that it was a matter of discretion and practice, in respect to which we possess no authority to revise the decision of the Circuit Court.

Upon the whole, we are of opinion that the judgment of the Circuit Court ought to be

**AFFIRMED WITH COSTS.**

DAVID PROUTY AND JOHN MEARS, PLAINTIFFS IN ERROR, v. DRAPER  
RUGGLES ET AL., DEFENDANTS IN ERROR.

(16 Peters, 336.)

1. The plaintiffs, in the Circuit Court, claimed damages for the infringement of their patent for "a new and useful improvement in the construction of a plow." The claim of the patentee was for the combination of certain parts of the plow, not for the parts separately. The Circuit Court charged the jury, that, unless it is proved that the whole combination is substantially used in the defendants' plow, it is not a violation of the plaintiffs' patent, although one more of the parts specified in the letters patent may be used in combination by the defendant. The plaintiffs, by their specification and summing up, treated the parts described as essential parts of their combination, for the purpose of brace and draft; and the use of either alone by the defendant would not be an infringement of the combination patented. *Held*, That the instructions of the Circuit Court were correct.
2. The patent is for a combination, and the improvement consists in arranging different portions of the plow, and combining them together in the manner stated in the specification, for the purpose of producing a certain effect. None of the parts referred to are new, and none are claimed as new; nor is any portion of the combination less than the whole claimed as new, or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described; and this combination, composed of all the parts mentioned in the specification, and arranged with reference to each other, and to other parts of the plow, in the manner therein described, is stated to be the improvement, and is the thing patented. The use of any two of these parts only, or of two combined with a third which is substantially different in the form or in the manner of its arrangement and connection with the others, is, therefore, not the thing patented. It is not the same combination, if it substantially differs from it in any of its parts.

IN error to the Circuit Court of the United States for the District of Massachusetts.

The plaintiffs in error instituted a suit in the Circuit Court of Massachusetts, for the recovery of damages for the violation of a patent, granted to them by the United States, for a new and useful improvement in the construction of a plow.

The cause was tried before a jury, at October sessions of the Circuit Court, in 1841, and a verdict and judgment were rendered for the defendant. The plaintiffs took exceptions to the charge of the court, and prosecuted this writ of error.

The case was submitted to the court, on printed arguments, by *Mr. Choate*, for the plaintiffs in error, and by *Mr. Dexter*, for the defendants. The case was fully stated in the opinion of the court.

## Opinion of the court.

Mr. Chief Justice TANNEY delivered the opinion of the court.

This case is brought here by a writ of error to the Circuit Court of the United States for the District of Massachusetts.

The action was instituted for the purpose of recovering damages for an infringement of a patent which the plaintiffs had obtained for an improvement in the construction of the plow.

The invention is described in the specification as follows:

"Be it known, that we, the said Prouty and Mears, have jointly invented, made, and applied to use a new and useful improvement in the construction of the plow, which invention and improvement we describe and specify as follows, namely:

"Heretofore, the standard and landside of the plow has been placed perpendicular to and at right angles with the plane of the share; on this standard, the beam has been placed in such manner as to form an acute angle with the landside, of such extent as to place that part of the beam to which the moving power is applied at a distance of three or more inches from an extended line of the landside to the right, while the after-part of the beam extends one or more inches to the left of the perpendicular of the landside, near the handle; the object has been to cause the plow 'to run to land,' or hold its width of furrow. The effect produced has been an uneasy, struggling motion, as it meets resistance at the point, wing, or heel.

"We make our plow with the standard and landside forming an acute angle with the plane of the share, the standard inclining to the right or furrow side in such manner as to enable us to place the center of the beam on a line parallel with the landside, the fore-part thereof at such a distance from the extended line aforesaid as to cause the plow to hold its width of furrow, and the after-part falling within the perpendicular of the landside of the plow, the center of it being nearly perpendicular to the center of resistance, on the mould-board, which we conceive to be at about one-fourth part of the lateral distance from the landside to the wing of the share, and at about one-third part of the perpendicular height from the plane of the share to the upper edge of the mould-board.

"This location of the center of resistance, we base on the fact that many plows, which have been used in sharp, sandy soils, have been worn quite through at that point. The result of this formation of the plow is a steady, well-balanced motion, requiring less power of draft and less effort in directing the plow in its course.

"The inclination of the standard and landside causes the plow to cut under and take up the furrow in the form of an oblique-angled parallelogram, or like a board feather-edged, which, being turned

over, falls on a level with the last furrow more readily than right-angled or square-edged work.

"The coulter, or knife, having a similar inclination, cuts the roots of the grass, &c., and leaves all vegetable matter on the surface, at a greater distance from the under edge of the furrow, which, being turned over, more readily falls in, and is far better covered than with the square-edged work.

"The top of the standard, through which the bolt passes to secure the beam, is transversely parallel to the plane of the share, and extends back from the bolt to such a distance as to form a brace to the beam, when the after-part is passed down by lifting at the fore-part; the share being fast under a rock, or other obstruction, the after-part of this extension is squared in such manner, that, being jogged into the beam, it relieves the bolt in heavy draft.

"The bolts which we use to fasten the pieces of cast-iron, of which our plows are made, together, and the wood-work, are round, with inverted convex heads, like the wood-screw, with a projection on the under side of the head of semicircular form, which fits into a groove in the countersink part of the bolt-hole, as it is cast to receive it, which not only prevents its turning, but also diminishes the liability of breakage at the corners of square holes—all which will more fully appear by reference to the drawing annexed to and forming part of this specification.

"We hereby declare that what we claim as new, and of our invention, is the construction of such plows as aforesaid, and the several parts thereof, not separately, but in combination, for the purposes aforesaid, namely:

"1. The inclining the standard and landside so as to form an acute angle with the plane of the share.

"2. The placing the beam on a line parallel to the landside, within the body of the plow and its center, nearly in the perpendicular of the center of resistance.

"3. The forming the top of the standard for brace and draft. We do not intend to confine our claim to any particular form or construction, excepting such form as may be necessary to place the beam in the perpendicular of the center of resistance, and parallel to the landside, and also to such form of the top of the standard as shall serve for brace and draft, but have given such form as we deem to be most convenient, which may be varied, as is obvious."

The plaintiffs offered to prove the utility of the alleged improvement, which proof was dispensed with by the defendants. Certain plows, alleged by the plaintiffs to be made in conformity with their

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letters patent, and certain plows made by the defendants, which were the alleged infringement of the plaintiffs' patent, were produced in court; and no substantial difference between them was shown by the defendants to exist, unless the fact that the top of the standard in the defendants' plow was not jogged into the beam, and did not extend so far back upon the beam, was to be so considered.

And the plaintiffs offered evidence to show that the top of the standard formed, as stated in the specification, would serve for both purposes of brace and draft, although not jogged into the beam.

The defendants introduced no evidence. The counsel for the plaintiffs requested the court to instruct the jury as follows, to wit:

The counsel of plaintiffs respectfully move the court to instruct the jury, that if the defendants have used, in combination with the other two parts, a standard of the description set forth in the specification, and it is proved to serve both for brace and draft, such use was an infringement of the plaintiffs' claim in that particular, although the defendants may not have inserted it into a jog in the beam.

Also, that if any two of the three parts described as composing the construction claimed in the specification, had been used in combination by the defendants, it was an infringement of the patent, although the third had not been used with them.

The court refused to give the instructions so prayed, or either of them, in manner and form as prayed by the plaintiffs; but did instruct the jury as follows, to wit:

That upon the true construction of the patent, it is for a combination, and for a combination only. That the combination, as stated in the summing up, consists of three things, namely:

1. The inclining the standard and landside so as to form an acute angle with the plane of the share.

2. The placing the beam on a line parallel to the landside, within the body of the plow and its center, nearly in the perpendicular of the center of resistance.

3. The forming the top of the standard for brace and draft.

That unless it is proved that the whole combination is substantially used in the defendants' plows, it is not a violation of the plaintiffs' patent, although one or more of the parts specified as aforesaid may be used in combination by the defendants. And that the plaintiffs, by their specification and summing up, have treated the jogging of the standard behind, as well as the extension, to be essential parts of their combination for the purpose of brace and draft; and that the use of either alone by the defendants would not be an infringement of the combination patented.

And thereupon the jury rendered their verdict for the defendants.

The first question presented by the exception is, whether the extension of the standard, and the jogging of it into the beam, are claimed as material parts of the plaintiffs' improvement. We think they are. In the paragraph in which it is described, he states that it "extends back from the bolt to such a distance as to form a brace to the beam"; and also "that, being jogged into the beam, it relieves the bolt in a heavy draft." And in their summing up, they declare that they claim as new, and of their invention, the construction of such plows as aforesaid, and the several parts thereof, not separately, but in combination; and proceeding then to specify the parts so claimed, they mentioned "the forming of the top of the standard for brace and draft." They, indeed, say that they do not mean to confine their claim to any particular form of construction, except "to such form of the top as shall serve for brace and draft." That is to say, the top is to be so formed and so connected with the beam as to answer both purposes. And as those purposes, according to the preceding part of the specification, are to be accomplished by its extension back from the bolt, and by jogging it into the beam, these two things are essential to it, whatever variation may be made in its shape or size. They are, therefore, material parts of the improvement they claim.

The remaining question may be disposed of in a few words. The patent is for a combination, and the improvement consists in arranging different portions of the plow, and combining them together in the manner stated in the specification, for the purpose of producing a certain effect. None of the parts referred to are new, and none are claimed as new; nor is any portion of the combination less than the whole claimed as new, or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described. And this combination, composed of all the parts mentioned in the specification, and arranged with reference to each other and to other parts of the plow in the manner therein described, is stated to be the improvement, and is the thing patented. The use of any two of these parts only, or of two combined with a third which is substantially different in form or manner of its arrangement and connection with the others, is therefore not the thing patented. It is not the same combination if it substantially differs from it in any of its parts. The jogging of the standard into the beam, and its extension backward from the bolt, are both treated by the plaintiffs as essential parts of their combination for the purpose of brace and draft. Consequently, the use of



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either alone, by the defendants, would not be the same improvement, nor infringe the patent of the plaintiffs.

The judgment of the Circuit Court must therefore be

**AFFIRMED.**

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ELEAZER CARVER v. JOSEPH A. HYDE ET AL.

(16 Peters, 513.)

1. An end to be accomplished is not the subject of a patent. The invention consists in the new and useful means of obtaining it.
2. If the defendant, by a device of substantially different form, or differently arranged with another part of a machine, makes an improvement which more effectually secures the object intended to be accomplished by the plaintiff's patent, it would be difficult to maintain that it could not be lawfully used, because it produced the same result with the plaintiff's invention.
3. In the patent of the plaintiff for improvement in "saw ribs for cotton-gin," the usefulness of the rib depends altogether, as described in his specification, upon the manner of its connection with the periphery of the saws, and with the frame-work. And if, therefore, the rib made by the defendant was not fastened at all to the frame-work, or in a manner substantially different from the plaintiff's, it was no infringement of his patent.

ERROR to the Circuit Court for the District of Massachusetts. The action below was for the infringement of letters patent for improvement in "saw ribs for cotton-gin," granted to the plaintiff June 12, 1838, and reissued November 16, 1839.

*Franklin Dexter*, for plaintiff; *Richard Fletcher, Willard Phillips*, and *Levertt Saltonstall*, for defendants.

Chief Justice TANEY delivered the opinion of the court.

This case is brought here by writ of error, directed to the Circuit Court of the United States for the District of Massachusetts. It is an action by the plaintiff in error against the defendants, to recover damages for the infringement of a patent-right, obtained by the plaintiff on November 16, 1839. The patent is in the usual form, and the questions before us depend upon the construction of the specification, which is in the following words:

"Be it known, that I, Eleazer Carver, of Bridgewater, in the county of Plymouth, and State of Massachusetts, have invented a certain improvement in the manner of forming the ribs of saw-gins, for the ginning of cotton; and I do hereby declare that the following is a full and exact description thereof:

“In the cotton-gin, as heretofore known and used, the fibers of the cotton are drawn, by the teeth of circular saws, through a grating formed of a number of parallel bars or ribs, having spaces between them sufficient to allow the saws to pass, carrying the fibers of the cotton with them, (which are then brushed off by a revolving brush,) but not wide enough to let the seeds and other foreign substances pass through. Above the saws the ribs come in close contact, thus forming a shoulder at the top of the space between them. Various forms have been given to the bars or ribs, with a view to procure a free passage of the cotton; but the cotton-gin, as heretofore made, has been always subject to the inconvenience of the grate becoming choked by hard masses of cotton and motes, or false seeds, collecting in the upper part of the spaces between the ribs, and impeding the action of the saws, and also preventing the mass of cotton which is drawn by the saws up to the top of the spaces, but not drawn through them, from rolling back freely, so as to pass again over the saws, as it should do.

“My improvement, which I am about to describe, is intended to obviate these difficulties; and it consists in giving a new form to the ribs composing the grate. Instead of making the ribs of a bar of iron of equal thickness throughout, so that the upper and under surfaces shall be parallel, I so form the rib, that at the part where the saws pass through, carrying the cotton with them, the space or depth between the upper and outer surface, and the lower or inner surface, shall be greater than the thickness of the rib in other parts has heretofore been, or needs to be, and so great as to be equal to the length of the fiber of the cotton to be ginned, so that the fiber shall be kept extended between the ribs for about its full length, while it is drawn through them by the saws. This mill, of course, requires, either that the rib should be as thick at that part as the length of the fiber, or that the rib should be forked, or divided, about that part, so that the upper or outer surface, and the under or inner surface, shall diverge to that distance of each other, instead of being parallel as formerly, when the rib was made of one bar of uniform thickness. This under or inner surface then takes a new direction upward, and slopes toward the upper or outer surface, until the two surfaces meet above the periphery of the saw. This last described part of the under surface is fastened against the frame-work of the gin. The operation of this improvement is, that those fibers of the cotton which are so firmly caught by the teeth of the saws as to be disengaged from the mass of the cotton to be ginned, are drawn out to their full length, and pass clear through the grate, and are then brushed off by the revolv

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ing brush, while the fibers that are drawn into the grate, but not caught by the teeth of the saws firmly enough to be carried quite through, are disengaged, and pass up to where the under surface meets the upper surface, above the saws, and, finding no obstruction there, pass back out of the grate without choking it, and roll down again with the mass of unginned cotton, and are caught below by the saws, and carried up again, and so on until all the fibers are drawn through."

The specification then proceeds to describe the invention more particularly, by referring to and explaining the drawings annexed to it, showing the advantages of his improvement, the manner of arranging the ribs in the gin, and the mode of inserting and fastening them in the frame-work. This description could not be comprehended without an exact drawing; nor is it necessary, in order to understand the questions of law in dispute between the parties. It is therefore omitted. After giving this description, the specification states the improvement, of which the patentee claims to be the inventor, as follows:

"Having thus described my improved rib and its advantages, I now claim as my invention, and desire to secure, by letters patent, the increasing the depth or space between the upper or outer surface of the rib, and the lower or inner surface of it, at the part where the cotton is drawn through the grate, so that it shall be equal to the length of the fiber of the cotton to be ginned; (whether this be done by making the ribs thicker at that part, or by a fork or division of the rib, or by any other variation of the particular form;) and I also claim, as part of the said improvement, the sloping up of the lower or inner surface of the rib, so as to meet the upper or outer surface above the saws, leaving, when the rib is inserted into the frame, no break or shoulder between the two surfaces, but a smooth and uninterrupted passage upward between the ribs, as above described."

At the trial in the Circuit Court, the plaintiff in error, after having produced his patent, with the schedule annexed to it, offered in evidence, by the testimony of witnesses skilled in the art, that the rib described in the plaintiff's specification was a new and useful improvement; that the fastening of the rib to the frame-work in the manner therein stated had nothing to do with the ginning, but was only necessary to keep the rib firm; that the rib of the defendants was substantially in principle like that of the plaintiff, and operated in the same manner and produced the same effect; and that, in their opinion, it differed from the plaintiff's rib only by taking away a part which was wholly immaterial in the operation of ginning.

The defendants then produced witnesses skilled in the art, who testified that the ribs of the defendants did not substantially operate in the same manner with the plaintiff's, but were different in form and principle, and proceeded to state the particulars in which they differed; and testified that the defendants' ribs were entirely detached from the breast-band, and stood out in front of it, like the bar of the "Edenton grate," which was known and in use long before the plaintiff's; and that the front and back surfaces of the defendants' ribs did not slope and meet at the upper end above the saws as the plaintiff described his to do, and was not shaped as the plaintiff's was exhibited and described in his drawings, specification, and claim.

"Whereupon the defendants' counsel insisted that the ribs of the defendant were, according to the whole evidence, substantially different from those described and claimed by the plaintiff, not only because, as the counsel alleged, it appeared by the whole of said evidence, that, in the defendants' said ribs, no part of the under surface sloped upward, and met the upper surface above the periphery of the saw, and was there fastened against the frame-work of the gin; but, also, in the other particulars above described.

"But the plaintiff's counsel insisted that said ribs were substantially alike, in all respects; and that in the rib of the defendants, the under surface did, according to said evidence, in fact, slope upward, and meet the upper surface above the periphery of the saw, but that it was not necessary to the plaintiff's invention, as described and claimed in his said specification; nor was it essential to the said invention, in fact, that the under surface of the rib should be fastened against the frame-work of the gin, where the two surfaces meet, above the periphery of the saw.

"And the presiding judge who sat at the trial aforesaid did then and there declare and deliver his opinion to the jury aforesaid, as follows, viz.: That to entitle the plaintiff to maintain the action and issue aforesaid, on his part, it was necessary for the jury to be satisfied that the defendants had substantially violated and infringed the patent-right of the plaintiff, as set forth and described in his patent. That if the defendants used only such part of the said patented improvement as was known and used before his supposed invention, it was no violation or infringement thereof. That the improvement of the plaintiff, as specified and summed up by him, was in the following terms, viz.:

"I now claim as my invention, and desire to secure, by letters patent, the increasing the depth or space between the upper or outer surface of the rib, and the lower or inner surface of it, at the part

where the cotton is drawn through the grate, so that it shall be equal to the length of the fiber of the cotton to be ginned; (whether this be done by making the ribs thicker at that part, or by a fork or division of the rib, or by any other variation of the particular form;) and I also claim, as part of the same improvement, the sloping up of the lower or inner surface of the rib, so as to meet the upper or outer surface above the saws, leaving, when the rib is inserted into the frame, no break or shoulder between the two surfaces, but a smooth and uninterrupted passage upward between the ribs, as above described."

That the true construction and interpretation of the specification and summing is, that it claims and states as a substantial part of the improvement, not only the increasing the depth or space between the upper or outer surface of the rib and the lower or inner surface thereof, at the part where the cotton is drawn through the grate, so that it shall be equal to the length of the fiber of the cotton to be ginned in the manner above stated, but it also claims and states as a substantial part of the same improvement, the sloping up of the lower and inner surface of the rib, so as to meet the upper or outer surface above the saws, leaving, when the rib is inserted in the frame-work, no break or shoulder between the two surfaces, but a smooth and uninterrupted passage upward between the ribs, as described in the same specification; and that thereby the fixing or fastening of the ribs against the frame-work, in the manner stated in the specification, is made by the patentee a substantial part of the said improvement; so that if the defendants do not fix or fasten the ribs of their machine against the frame-work in the manner stated in the specification, either at all or substantially in the same manner as the patentee, or fix or fasten it only in a manner known or used before the plaintiff's supposed invention, the defendants are not guilty of any violation or infringement of the plaintiff's patent, as stated in the declaration; and with this declaration, the said presiding judge left the said cause to the jury, who thereupon then and there returned a verdict for the defendants.

It will be seen by this statement, that the question of law presented by the exception is a very narrow one, and depends altogether on the construction of the specification; and it is difficult to make it understood, without the aid of the drawing or model.

The plaintiff considers the invention secured by the patent to consist of the rib only—and of that part of the rib which by its form increases the depth between its upper or outer surface and the lower or inner one, at the place where the cotton is drawn through the grate. He insists that the sloping up of the rib, so as to meet the upper or outer surface of the saw, as well as the manner of fastening

it against the frame-work of the gin, as mentioned in his specification, are not substantial or essential parts of his invention.

The question is, whether they are claimed as such by his patent. The Circuit Court held that they were so claimed; and we think the opinion was clearly right. They are expressly stated by the patentee to be a part of the improvement for which he asks a patent, and he describes particularly the smooth and uninterrupted passage upward between the ribs, leaving no break or shoulder between the two surfaces, when the ribs were inserted in the frame, as one of the advantages resulting from his improvement. And this smooth and uninterrupted surface must necessarily depend not merely on the form of the rib, but also in the manner in which it is connected with the frame-work.

The rib in question is not an invention to be used by itself, but an improvement upon that portion of the cotton-gin; and is to be used in connection with other parts of a machine which has been publicly known and used a long time. There must, therefore, be some mode of fastening and connecting it with the other machinery; and the effect produced by the rib necessarily depends, in a great degree, upon the mode in which it is arranged and connected with the saw, and the other parts of the machine. He specifies the mode, and claims it as part of his invention. According to his statement, his improvement consisted in the form of the rib which increased the depth between the upper and lower surface, at the part where the cotton is drawn through the grate, in the sloping up so as to meet the upper or outer surface above the saws, and in the smooth and uninterrupted passage produced by the manner in which it was connected with the frame. These three things he represents as constituting his improvement, and they are all combined together in his specification and claim, making together one invention, to be used in connection with the other and old machinery of the cotton-gin. And the drawing which accompanies his patent shows the manner in which the rib is sloped and arranged with the saw and annexed to the frame-work, in order to attain the object of the invention.

Now, the end to be accomplished is not the subject of a patent. The invention consists in the new and useful means of obtaining it. And if the defendant had, by a rib of a substantially different form, or differently arranged with the saw, or not fastened at all to the frame, made an improvement which more effectually secured the object intended to be accomplished by the plaintiff's patent, it would be difficult to maintain that it could not be lawfully used, because it produced the same result with the plaintiff's invention.

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Statement of the case.

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The usefulness of the rib depends altogether, as described in the specification, upon the manner of its connection with the periphery of the saw, and with the frame-work. And if, therefore, as was said by the Circuit Court, the rib made by the defendant was not fastened at all to the frame-work, or in a manner substantially different from the plaintiff's, or in a manner known and used before the plaintiff's invention, it was no infringement of his patent. And whether the manner was the same in substance or not, was a question of fact for the jury; and as they found for the defendant, we must assume that it was substantially different.

The judgment of the Circuit Court is therefore

**AFFIRMED.**

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WILLIAM T. McCLURG, JOHN C. PARRY, AND ENOCH J. HIGBY, PARTNERS, DOING BUSINESS UNDER THE FIRM OF McCLURG, PARRY, AND HIGBY, ASSIGNEES OF JAMES HARLEY, PLAINTIFFS IN ERROR, v. LAWRENCE KINGSLAND, ISAAC LIGHTNER, AND JAMES CUDDY, PARTNERS, DOING BUSINESS UNDER THE FIRM OF KINGSLAND, LIGHTNER, AND CUDDY, DEFENDANTS.

(1 Howard, 202.)

1. If a person employed in the manufactory of another, while receiving wages, makes experiments at the expense and in the manufactory of his employer; has his wages increased in consequence of the useful result of the experiments; makes the article invented and permits his employer to use it, no compensation for its use being paid or demanded; and then obtains a patent,—these facts will justify the presumption of a license to use the invention.
2. Such an unmolested and notorious use of the invention prior to the application for a patent, will bring the case within the provisions of the seventh section of the act of 1839, ch. 88.
3. The assignees of a patent-right take it subject to the legal consequences of the previous acts of the patentee.
4. The fourteenth and fifteenth sections of the act of 1836, ch. 357, prescribe the rules which must govern on the trial of actions for the violation of patent-rights; and these sections are operative, so far as they are applicable, notwithstanding the patent may have been granted before the passage of the act of 1836.
5. The words “any newly-invented machine, manufacture, or composition of matter,” in the seventh section of the act of 1839, have the same meaning as “invention,” or “thing patented.”

THIS case was brought up by writ of error from the Circuit Court of the United States for the Western District of Pennsylvania.

The facts are sufficiently stated in the opinion of the court.

The bill of exceptions which was taken on the trial below was as follows:

And the plaintiff thereupon excepted to certain parts of the instructions so given by the court to the jury, which instructions so excepted to are hereinafter set forth, to wit:

"It has, however, been urged, by the plaintiff's counsel, that the right to the continued use is restricted to the 'specific machine, manufacture, or composition of matter so made or purchased,' so that a defendant is protected no farther than in the case of the invention (for which this patent was granted) prior to the application, and is liable to damages if he makes any rolls by Harley's plan afterwards.

"We, therefore, feel bound to take the words, 'newly-invented machine,' in the act of 1839, manufacture, or composition of matter and such invention, to mean the invention patented, and the words 'specific machine' to refer to the thing originally invented, whereof the exclusive right is procured by patent, but not to any newly-discovered improvement to an existing patent.

"The use of the patent must be of the same specific improvement originally invented, as was, before the application, used by any person who had purchased or constructed the machinery on which he operated to produce the effect described in the specification; but when such person confines the future use to the specific mode, method, manner, and process of producing the described effect, it is, by the words and true meaning of the law, without liability to the inventor or other person interested in the invention, so construed; and by thus protecting the person who has engaged the use of an invention before the application for a patent, the great object of the Patent Laws, as declared in the fourth section of the act of 1837, will be consummated,—that is, to protect the rights of the public and 'of patentees in patented inventions and improvements.' 4 Story, 2547. A different construction would make it necessary to carry into all the former laws the same literal exposition of the various terms used to express the same thing, and, thereby changing the law according to every change of phraseology, make it a labyrinth of inextricable confusion.

"Our opinion, therefore, is, that the defendants have a right to the continued use of the improvement patented to Harley. The facts of the case, which are not controverted, have equal effect with a license, and the evidence brings the defendant under the protection of the act of 1839, by the unmolested notorious use of the invention before the application for a patent. Nothing has been shown, on the part of the plaintiffs, to counteract the effect of this prior use; as the assign-



nees of Harley, they stand in his place as to right and responsibility; they took the patent subject to the legal consequences of his previous acts; and connecting these with the want of an assertion of a right to the use by the defendants of the invention patented, till this suit was brought in September, 1835, protects them from liability.

"In our opinion, your verdict ought to be for the defendants. Verdict accordingly, and judgment for defendants."

*Dunlap*, on behalf of the plaintiffs in error, contended that the court below had erred in charging the jury—

1. That the facts justified the presumption of a license or grant to use the invention, and that defendants were protected thereby, independent of any act of Congress.

2. That the words "specific machine," in the fourth section of the act of 1839, referred to the invention itself, and that the authority to use it before the patent carried the right to continue to make and use it after the patent had issued.

Mr. Justice BALDWIN delivered the opinion of the court.

This case comes here on a writ of error to the Circuit Court for the Western District of Pennsylvania, in an action brought by the plaintiffs, assignees of James Harley, against the defendants, for the infringement of a patent granted to Harley for an improvement in the mode of casting chilled rollers and other metallic cylinders and cones, in which judgment was rendered for the defendants. On the trial, it appeared in evidence that it had long been a desideratum to find out some mode by which iron rollers, or cylinders, could be so cast that when the metal was introduced into the mould it should cause a swirl or rotatory motion, by which the flog or dross would be thrown into the center instead of the surface of the cylinder. By the old mode, the metal was conveyed from the furnace to the mould through a gate or pipe, placed in a horizontal or perpendicular direction. The mode alleged to have been invented by Harley is thus described in the specification annexed to the patent: "The tube or tubes, or passages called gates, through which the metal to be conveyed into the moulds shall not enter the mould perpendicularly at the bottom, but slanting, or in a direction approaching to a tangent of the cylinder, or if the gates enter the moulds horizontally, or nearly so, shall not enter in the direction of the axis of the cylinder, but in a tangent form, or inclining towards a tangent of the cylinder."

This was the thing patented, consisting solely in changing the direction of the tube which conveyed the metal to the mould, from a hori-

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Opinion of the court.

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zontal or perpendicular position to an angular one. It produced the desired effect, and was highly useful.

The novelty of the invention was much contested at the trial, but as the case turned on other points, that became an immaterial question; and the case comes before us, on exceptions to the charge of the court, which assumed that Harley was the original and true inventor of the improvement, and put the case to the jury on the following facts, which were in full proof, in nowise contradicted, and admitted to be true:

That Harley was employed by the defendants at their foundry in Pittsburg, receiving wages from them by the week; while so employed, he claimed to have invented the improvements patented, and after several unsuccessful experiments made a successful one in October, 1834. The experiments were made in the defendants' foundry, and wholly at their expense, while Harley was receiving his wages, which were increased on account of the useful result. Harley continued in their employment, on wages, until January or February, 1835, during all which time he had made rollers for them. He often spoke about procuring a patent, and prepared more than one set of papers for the purpose. Made his application the 17th February, 1835, for a patent. It was granted on the 3d of March, and assigned to the plaintiffs on the 16th of March, pursuant to an agreement made in January.

While Harley continued in the defendants' employment, he proposed that they should take out a patent and purchase his right, which they declined. He made no demand on them for any compensation for using his improvement, nor gave them any notice not to use it, till, on some misunderstanding on another subject, he gave them such notice about the time of his leaving their foundry, and after making the agreement with the plaintiffs, who owned a foundry in Pittsburg, for an assignment to them of his right. The defendants continued to make rollers on Harley's plan. The present action was brought in October, 1835, without any previous notice by them. The court left it to the jury to decide what the facts of the case were, but, if they were as testified, charged that they would fully justify the presumption of a license, a special privilege or grant to the defendants to use the invention; that the facts amounted to "a consent and allowance of such use," and show such a consideration as would support an express license or grant, or call for the presumption of one to meet the justice of the case, by exempting them from liability—having equal effect with a license, and giving the defendants a right to the continued use of the invention. The court also charged the jury, that the facts of the case which were not controverted brought it within the provis-

## Opinion of the court.

ions of the seventh section of the act of 1839, by the unmolested notorious use of the invention before the application for a patent by Harley, and that nothing had been shown by the plaintiffs to counteract the effect of this prior use. That as assignees of Harley, the plaintiffs stand in his place as to right and responsibility; they took the assignment of the patent subject to the legal consequences of his previous acts, and connecting these with the absence of an assertion of a right adverse to the defendants' use till this suit was brought, protected the defendants from liability for any damages therefor.

The exceptions to the charge were confined to these two points, which constitute the only subject for our consideration. Whether these exceptions are well taken or not, must depend on the law as it stood at the emanation of the patent, together with such changes as have been since made; for though they may be retrospective in their operation, that is not a sound objection to their validity. The power of Congress to legislate upon the subject of patents is plenary, by the terms of the Constitution; and as there are no restraints on its exercise, there can be no limitation of their right to modify them at their pleasure, so that they do not take away the rights of property in existing patents.

When the patent to Harley was granted and this suit brought, the acts of 1793 and 1800 were the tests of its validity, but the twenty-first section of the act of 1836 repealed all existing laws on the subject of patents, with a proviso, that all suits brought before may be prosecuted in the same manner as if that act had not been passed, "excepting and saving the application to any such action of the provisions of the fourteenth and fifteenth sections of this act, so far as they may be applicable thereto." This repeal, however, can have no effect to impair the right of property then existing in a patentee or his assignee, according to the well-established principles of this court in 8 Wheat., 493. The patent must, therefore, stand as if the acts of 1793 and 1800 remained in force; in other respects, the fourteenth and fifteenth sections of the act of 1836 prescribe the rules which must govern on the trial of actions for the violation of patented rights, whether granted before or after its passage.

In *Pennock v. Dialogue*, this court held, in 1829, "that if an inventor makes his discovery public, looks on, and permits others freely to use it, without objection or assertion of claim to the invention of which the public might take notice, he abandons the inchoate right to the exclusive use of the invention, to which a patent would have entitled him, had it been applied for before such use, and that it makes no difference in the principle, that the article so publicly

used and afterwards patented was made by a particular individual, who did so by the private permission of the inventor." 2 Peters, 14, 15; *Grant v. Raymond*, 6 Peters, 248, 249; *Shaw v. Cooper*, 7 Peters, 313-323.

On this construction of the acts of 1793 and 1800, Harley's patent would have been void on the evidence in this case. Such seems to have been the sense of Congress as expressed in the act of 1832, which authorized the issuing a new patent, when an original one was invalid by accident, inadvertence, or mistake, and without any fraudulent intent, by reason of the terms of the third section of the act of 1793 not having been complied with; "provided, however, that such new patent so granted shall in all respects be liable to the same matters of objection and defense as any original patent granted under the said first-mentioned act. That no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be free public use thereof, shall in any manner prejudice the right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid." 4 Story, 2301.

This act is an affirmation of the principles laid down by this court in the three cases before referred to, and as the exception to the proviso is limited to an use of the invention under a special license of the inventor after the grant of the original patent, it leaves the use prior to the application for such patent clearly obnoxious to the principle established in 2 Peters, 14, 15, whereby the patent would become void.

The same conclusion follows from the fifteenth section of the act of 1836, which declares, that if the thing patented "had been in public use or on sale, with the consent and allowance of the patentee, before the application for a patent," judgment shall be rendered for the defendant with costs. 4 Story, 2511. The case before us is one of this description: the defendants use the invention of Harley for four months before his application for a patent; this use was public; and not only with his express consent and allowance, but he himself made the rollers, on the plan he invented, during those months, from the time when he had ascertained the utility of his invention.

It would, therefore, be no strained, if not the fair construction of this act, if, under such and the other circumstances in evidence in the cause, the court charged the jury that, if they believed the witnesses, the patent subsequently obtained was void. The Circuit Court, however, did not go so far. They held that the defendants might continue

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to use the invention, without saying that the public might use it without liability to the plaintiffs, in which we think there was no error in their direction to the jury; that they might presume a license or grant from Harley, or on the legal effect of the uncontroverted evidence as to the right of recovery by the plaintiffs, or on the construction of the acts of 1793, 1800, 1832, and 1836.

The remaining exception is to the charge of the court below, on the effect of the seventh section of the act of 1839, which is in these words: "That every person or corporation who has or shall have purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer of a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent." Pamphlet Laws, 1839, 74, 75.

The object of this provision is evidently twofold: first, to protect the person who has used the thing patented, by having purchased, constructed, or made the machine, &c., to which the invention is applied, from any liability to the patentee or his assignee; second, to protect the rights granted to the patentee against any infringement by any other persons. This relieved him from the effects of former laws and their construction by this court, unless in case of abandonment of the invention, or a continued prior use for more than two years before the application for a patent; while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor to use his invention, which, if given before the application for a patent, would justify the continued use after it issued, without liability.

At the trial below, and here, the plaintiffs' counsel have contended that this act cannot apply to the present case, inasmuch as the protection it affords to the person who had the prior use is confined to the specific machine, &c., and does not extend to such use of the invention or thing patented, if it does not consist of a machine, &c., as contradistinguished from the new mode or manner in which an old machine or its parts operate, so as to produce the desired effect; but we think that the law does not admit of such construction, whether we look at its words or its manifest objects, when taken in connec-

tion with former laws, and the decisions of this court in analogous cases.

The words "such invention" must be referred back to the preceding part of the sentence, in order to ascertain the subject-matter to which it relates, which is none other than the newly-invented machine, manufacture, or composition of matter constituting the thing patented; otherwise these words become senseless, when the invention is not strictly of a machine, &c. Now, in the present case, we find the invention consists solely in the angular direction given to the tube through which the metal is conducted into the cylinder in which the roller is cast. Every part of the machinery is old; the roller itself is no part of the invention, and cannot be the machine, manufacture, or composition of matter contemplated by Congress; nor can the word "specific" have any practical effect, unless it is applied to the thing patented, whatever it may be, without making a distinction between a machine, &c., and the mode of producing a useful result by the mere direction given to one of the parts of an old machine. Such a construction is not justified by the language of the law, and would defeat both of its objects. If it does not embrace the case before us, the consequence would be that the use of the invention, under the circumstances in evidence, would, according to the decision in 2 Peters, 14, 15, *ante*, invalidate the patent; for if the act operates to save the avoidance of the patent, it must, of consequence, protect the person who uses the invention before the application for a patent. Both objects must be effected or both must fail, as both parts of the act refer to the same thing, and the same state of things, as affecting the person using the newly-invented machine, or the thing patented, as well as the inventor. Had the words "invention" or "thing patented" been used instead of machine, &c., there could have been no room for doubt of the application of the act to the present case; and by referring to the phraseology of the different acts of Congress denoting the invention, it is apparent that, though there is a difference in the words used, there is none as to their meaning or reference to the same thing. Thus, we find in the fourteenth section of the act of 1836, relating to suits for using "the thing whereof the exclusive right is secured by any patent"; in the fifteenth, "his invention, his discovery, the thing patented," "that which was in fact invented or discovered," "the invention or discovery for which the patent issued," "that of which he was the first inventor." In the first section of the act of 1837, "any patent for any invention, discovery, or improvement," "inventions and discoveries"; in the second section, "the invention"; in the third, "invention or discovery"; in the fourth, "patented inventions

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and improvements"; in the fifth, "the thing as originally invented." 4 Story, 2510, 2511, 2546.

We, therefore, feel bound to take the words "newly-invented machine, manufacture, or composition of matter" and "such invention," in the act of 1839, to mean the "invention patented," and the words "specific machine" to refer to "the thing as originally invented," whereof the right is secured by patent; but not to any newly-invented improvement on a thing once patented. The use of the invention before an application for a patent, must be the specific improvement then invented and used by the person who had purchased, constructed, or used the machine to which the invention is applied. So construed, the objects of the act of 1839 are accomplished. A different construction would make it necessary to carry into all former laws the same literal exposition of the various terms used to express the same thing, and, thereby changing the law according to every change of mere phraseology, make it a labyrinth of inextricable confusion.

We are, therefore, of opinion that there is no error in the charge of the court below, and that its judgment be affirmed.

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Western District of Pennsylvania, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court that the judgment of the said Circuit Court in this cause be, and the same is hereby,

**AFFIRMED WITH COSTS.**

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**JAMES STIMPSON, PLAINTIFF IN ERROR, v. THE WEST CHESTER RAILROAD COMPANY, DEFENDANTS.**

(4 Howard, 380.)

1. The practice of excepting generally to a charge of the court to the jury, without setting out specifically the points excepted to, censured. The writ of error not dismissed, only on account of the peculiar circumstances of the cause.
2. Where a defective patent had been surrendered, and a new one taken out, and the patentee brought an action for a violation of his patent-right, laying the infringement at a date subsequent to that of the renewed patent, proof of the use of the thing patented during the interval between the original and renewed patents will not defeat the action.
3. The seventh section of the act of March 3, 1839, has exclusive reference to an original application for a patent, and not to a renewal of it.
4. An original patent being destroyed by the burning of the Patent Office, and the only record of the specifications being a publication in the Franklin Jour-

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nal, the claim is not limited by that publication, because the whole of the specifications are not set forth in it.

5. Whether a renewed patent, after a surrender of a defective one, is substantially for a different invention, is a question for the jury, and not for the court.
6. As the thirteenth section of the act of 1836 provides for the renewal of a patent, where it shall be "inoperative or invalid by reason of a defective or insufficient description or specification," "if the error shall have arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention," the fact of the granting of the renewed patent closes all inquiry into the existence or the inadvertence, accident, or mistake, and leaves open only the question of fraud for the jury.

THIS case was brought up by writ of error from the Circuit Court of the United States for East Pennsylvania.

It was a suit brought in the Circuit Court by Stimpson against the Railroad Company for a violation of his patent-right.

On the 23d of August, 1831, Stimpson took out letters patent for an improvement in the mode of turning short curves on railroads. These letters were not given in evidence upon the trial, having been burned in the conflagration of the Patent Office, in December, 1836, and no copy could be found. Secondary evidence was given of their contents, by the following publication in the Franklin Journal:

"For an improvement in the mode of turning short curves on railroads, such as the corners of streets: James Stimpson, city of Baltimore, August 23.

"37. The plan proposed is to make the extreme edges of the flanches flat, and of greater width than ordinary, and to construct the rails in such a manner that, where a short turn is to be made, the extreme edge of the flanch shall rest upon it, instead of upon the tread of the wheel, thus increasing the effective diameter of the wheel, in a degree equal to twice the projection of the flanch. The claim is made to 'the application of the flanches of railroad carriage-wheels to turn short curvatures upon railroads or tracks, particularly turning the corners of streets, wharves, crossing of tracks or roads, and passing over turnabouts,' &c." Franklin Journal, vol. 9, p. 124.

On turning to pages 270 and 271, volume 4, there will be found specifications of two patents granted to James Wright, of Columbia, Pennsylvania, for the mode of turning curves claimed by Mr. Stimpson. The only difference is, that Mr. Wright proposes to adapt his cars to several different curves, by having three or more offsets in his wheels, when necessary.

On the same day, namely, the 23d of August, 1831, Stimpson took out, also, letters patent for an improvement in the mode of forming and using cast or wrought iron plates or rails, for railroad carriage-



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wheels to run upon. These letters being also destroyed, the following extract from the Franklin Journal was given in evidence.

Franklin Journal, vol. 9, p. 125. "39. For an improvement in the mode of *forming and using cast or wrought iron plates or rails, for railroad carriage-wheels to run upon*: James Stimpson, city of Baltimore, Maryland, August 23, 1831.

"The claim in this case is to 'the application of cast or wrought iron plates for the use of railways on the streets or wharves of cities or elsewhere. The objects of said improvement being to employ rails that will not present any obstacles to the ordinary use of streets, or sustain injury therefrom, and so to form the plates at the intersection of streets or other crossings that cars will readily pass over them, and also on circles of small radius.'

"The rails are to be formed with a groove in them to receive the flanches of the wheels; on one side of the groove, the width is to be sufficient for the tread of the wheel; on the other, it need not exceed three-quarters of an inch. These rails are to be laid flush with the pavement of the streets. At corners to be turned, the rails are to be cast or made of the proper curvature, one of them only being provided with a groove, as the flanch is to run upon the other, upon the principle described in No. 37. Provision is to be made by scrapers or brushes, preceding the carriages, to clear the grooves of dust, ice, and other obstructions."

In 1835, the first mentioned of these letters, namely, for an "improvement in the mode of turning short curves on railroads," were surrendered on account of a defective specification; and on the 26th of September, 1835, a renewed patent was issued for the term of fourteen years from the 23d of August, 1831. The schedule referred to in this patent was as follows:

*"Short Curves. 23d August, 1831. Renewed 26th September, 1835.*

"To all whom these presents shall come: Be it known, that I, James Stimpson, of the city and county of Baltimore, and the State of Maryland, have invented a new and useful improvement in the mode of turning short curves upon railroads with railroad carriages, particularly those round the corners of streets, wharves, &c., and that the following is a full and exact description of said invention or improvement, as invented or improved by me, namely, I use or apply the common peripheries of the flanches of the wheels for the aforesaid purpose, in the following manner: I lay a flat rail, which, however, may be grooved, if preferred, at the commencement of the curvation, and in a position to be centrally under the flanches of the wheels upon the outer track of the circle, so that no other part of the wheels

which run upon the outer circle of the track rails shall touch or bear upon the rails, but the peripheries of the flanches, they bearing the whole weight of the load and carriage, while the opposite wheels, which run upon the inner track of the circle, are to be run and bear upon their treads in the usual way, and their flanches run freely in a groove or channel, which treads are ordinarily about three inches in diameter less than the peripheries of the flanches.

“Were the bearing surfaces of the wheels which are in contract with the rails while thus turning the curve, to be connected by the straight lines from every point, there would thus be formed the frustums of two cones, if there be four wheels and two axles to the carriage, or if but one axle and two wheels, then but one cone, which frustums, or the wheels representing their extremities, will, if the wheels are thirty inches in diameter, and are coupled about three feet six inches apart, turn a curve of about sixty feet radius of the inner track rail. The difference in diameter between the flanches and treads before stated, the tracks of the usual width, and the wheels coupled as stated, would turn a curve of a somewhat smaller radius, if the axles were not confined to the carriage in a parallel position with each other; but this being generally deemed necessary, the wheels run upon lines of tangents, and these upon the inner track, being as wide apart in the coupling as the outer ones, keep constantly inclining the carriage outwards, and thus cause the carriage to tend to run upon a larger circle than the difference in diameter of the treads and flanches would otherwise give; but the depth of the flanches and the couplings may be so varied as to turn any other radius of a circle desired.

“What I claim as my invention or improvement is the application of the flanches on the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn curves upon railways, particularly such as turning the corners of streets, wharves, &c., in cities and elsewhere, operating upon the principle herein set forth.

“JAMES STIMPSON.

“Witnesses: JAMES H. STIMPSON, GEORGE C. PENNIMAN.”

In October, 1840, Stimpson brought his action against the West Chester Railroad Company for a violation of this renewed patent, and laid the infringement to have taken place in 1839.

In April, 1842, the case came on for trial.

The plaintiff produced his patent, and gave evidence that the defendants had used upon their road several curves of this description.

The defendants disputed the originality of the invention of the thing patented, under which head of defense much evidence was

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given; and also contended that the groove was not claimed in the first patent of 1831, and, therefore, was not included in the renewed patent of 1835. The evidence of Dr. Jones upon this last head being referred to by the court below, it is proper to insert that part of it.

*“Interrogatory fifth.* What are the contents of the specification of the alleged improvement of August 23, 1831? What are your means of knowing what were their contents? If you know them, are they dissimilar or similar to those of the plaintiff's specification of September 26, 1835, a copy of which, marked A, is hereto annexed? If dissimilar, state in what particulars, and whether they are as to matters of form and substance, and particularly describe the difference, if any. Answer fully.

“To the fifth interrogatory, I answer, that the plaintiff exhibited to me the specification in question, previously to his filing the same in the Patent Office; as he likewise did at the same time the specification of a patent for ‘forming and using cast-iron plates or rails for railroad carriage-wheels to run upon,’ which last patent is noticed on page 125, vol. 9, second series, of the Journal of the Franklin Institute. I then examined them cursorily, and expressed an opinion that the improvements described in the two specifications might have been embraced in one, and that it would have been better to have pursued that course. The specification of the mode of turning short curves appeared to me incomplete, an essential feature of it being contained in that for ‘forming and using cast-iron plates,’ &c. The papers, however, remained as drawn up by Mr. Stimpson's legal adviser, and when the patents were subsequently surrendered, in 1835, it was thought best to preserve the division into two. It was probably in fact necessary to pursue this course, as I am not aware of any precedent for uniting two patents into one, although one may be divided into two or more.

“Nearly ten years have elapsed since I first saw the specifications upon which these patents were first issued, and nearly six years since I last read them; and my recollection of them extends to certain prominent points only. The claim under the patent for turning short curves, as given in vol. 9, p. 124, of my Journal, is, I have no doubt, literally correct. There has been an omission in the printing of inverted commas [“] after the word ‘turnabout,’ &c. In this specification it was proposed to make the extreme edges of the flanches flat, and of greater width than ordinary. This, however, did not enter in the claim, and it is not probable that I should have recollected the fact, had it not been noted in my Journal, or called up by some other collateral circumstance. The main defect, in my judgment, of

the original specification in the patent for turning short curves, was the omission of the mention of the groove in the inner rail. I believe, however, that it was alluded to in this specification, but the description of it was contained principally, if not wholly, in the specification of the patent for 'forming and using cast-iron or wrought plates,' &c., above noticed, as may be inferred from a reference to my Journal, vol. 9, p. 125, patent 39.

*"Cross-interrogatories.* 1. Did you or did you not prepare the papers of the plaintiff, when his patent for short curves was surrendered and renewed? What was the object of such surrender and renewal? Was it or was it not that the claim of running over or across tracks at right angles might not continue any longer to be incorporated in the same patent with the claim for short curves, as it had been theretofore?

"To the first cross-interrogatory, I answer, that I did prepare the papers of the plaintiff, when his patent for turning short curves was surrendered for reissue; that the object of such surrender and renewal was to limit and confine it to the turning short curves in streets, &c., by leaving out certain matters in it respecting the crossing of tracks or roads, and the passing over turnabouts; and to define the subject-matter of the patent more clearly, without its being necessary to refer to that, simultaneously obtained, for 'forming and using cast or wrought iron plates,' &c."

The bill of exceptions taken by the plaintiff was to the following part of the charge of the court to the jury, namely:

"Having thus presented you with a view of the rules and principles of the common law applicable to the renewal of patents, as laid down by the Supreme Court, together with the provisions of the different acts of Congress on this subject, we will now state to you what is, in our opinion, their legal result.

"To authorize the surrender of an old patent and issue of a new one, consistently with the provisions of the original Patent Law of 1793 and the decisions of the Supreme Court, independently of any act of Congress conferring such power, there are these requisites indispensable to the power arising: (1.) The original patent must be inoperative or invalid, for the causes set forth in the act of 1832—the non-compliance with the third section of the act of 1793, for the want of a proper specification of the thing patented, through inadvertence, accident, or mistake, without any fraudulent or deceptive intention; this being the only case embraced in the law to which the authority conferred applies. (2.) 1, The defect in the specification, which makes it incompetent to secure the rights of the patentee, must

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have arisen from inadvertence, accident, or mistake, and, 2, not from any fraud or misconduct. The reissue of the patent by the appropriate officer is presumptive evidence that the requisites of the law have been complied with, on the production of such evidence or proof otherwise as justified it; but the question of the validity of the new patent is a judicial one, depending on the fact of inadvertence or fraud, as you shall find it, and the opinion of the court on matters of law involved in the inquiry. 14 Peters, 458; 6 Peters, 243; 7 Peters, 321; act of 1839 (5 Little & Brown's edition, 353). The reason why there must be an inquiry into both the inadvertence and fraud, arises from the settled construction of the act of 1793, that where the defect is not owing to fraud, the defendant is entitled to a verdict and judgment in his favor, but not to a judgment that the patent is void for the defect, unless he shows that the defect was owing to fraud. 1 Bald.; 6 Peters, 246. You must then be satisfied, affirmatively, that the defect of the patent arose from the inadvertence of the patentee, and, negatively, that it did not arise from his fraud or misconduct, or, in the words of the acts of 1832 and 1836, 'without any fraudulent or deceptive intention.' The finding of the fact of inadvertence may negative the fact of fraud; but in this, as in other cases, fraud may be inferred from gross inadvertence or negligence, such as may be the indication of a design to deceive the public. The defects in the old patent must be in the specification, when it does not comply with the requisites of the third section of the act of 1793, calling for a correct description of the thing patented; (6 Peters, 247;) a new one may be issued on compliance with those requisites which are there prescribed. But the new patent must be confined to the thing patented by the old one—the thing invented or discovered—'*the same invention*;' it cannot embrace another substantive and essential matter, which was not before patented; the thing, the invention, must be the same in both patents; the only object in the renewal being to cure a defect in the description,—not to supply the omission of an essential part of the invention. The new patent cannot be broader than the old one. If the thing patented is the same in both patents, its public use did not, under the former laws, amount to an abandonment, or such an acquiescence as to affect the new patent on the ground of delay or negligence in the assertion of the right of the patentee, from the date of the old patent to its reissue. But when an essential part is omitted, and the patentee suffers it to remain unpatented until it has come into public use, before the new patent issues, it will be subject to the same rules which apply to an original patent, making it incompetent to protect the patentee in his claim to such part in virtue of the pat-

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ent reissued, if it was not described in the one surrendered. The thirteenth section of the act of 1836 authorizes a new improvement, invented since the first patent, to be added in a renewed one. No law gives any authority to add an improvement which had been invented by the patentee before the original grant; for it is not, and cannot be, any part of the description or specification of another distinct improvement. A patent for the combination of the parts of an old machine must show wherein such combination exists; what parts compose it; how they are combined in their action. If the description is defective, it may be corrected by a new one. The correction, however, must not extend beyond the combination of the parts first specified, as the introduction of other parts, not before specified, makes an entire new combination; consequently, the thing patented becomes essentially different, being not the same invention, but a new one, made by a combination of a part not combined before, which might be a proper subject of an original patent, yet would not be authorized in a renewed one.

“These are the tests which the law applies to the description of the thing patented, in order to ascertain whether, in the words of the act of 1832, the old patent was ‘invalid or inoperative’ by reason that the conditions of the former law not having been complied with, or, in the language of the Supreme Court, the patent ‘is found to be incompetent to secure the reward which the law intended to confer on the patentee for his invention.’ In such case, the patent may be surrendered for reissue, in order to correct the defects which invalidated the first, but the law expressly makes the new patent ‘in all respects liable to the same matter of objection and defense’ as the old one, and imposes on the patentee the obligation of ‘compliance with the terms and conditions prescribed by the third section of the act of 1793.’ This is done by showing, according to its requisitions, what was the invention, the thing patented, by a designation of the invention principally, made in fuller, clearer, and more exact terms than those used, so as to give it validity and effect, and secure the same invention, which is the only legitimate office of the renewed or reissued patent. A specification consists of two parts—description and claim. The descriptive part is the explanation of the improvement in all the particulars required by the law; the claim, or summary at the close of the description or specification, is the declaration of the patentee of what he claims as his invention, by which he is bound, so that he can claim nothing which is not included in the summary, and could disclaim nothing which was included in it, till the passage of the act of 1837. But the summary may be referred to the description,

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and both will be liberally construed, to ascertain what was claimed; and if the words will admit of it, both parts will be connected, in order to carry into effect the true intention of the patentee, as it may appear on a judicial inspection of the whole specification. This makes it a question of law what is the thing patented, depending not on the actual or supposed intention of the patentee, but the conclusion of the law on the language he has used to express it. A part of the description may be construed as a claim, and carried into the summary, and made a part of the thing patented, the effect of which is the same as if it was included in the summary in express terms. *Cooper v. Matheys*, C. C. MS. To authorize a recovery for the violation of a patent-right, the plaintiff must show that he is the inventor of everything he claims as new, that it is embraced in the patent, and that everything so claimed and patented has been infringed by the defendant. Thus, where the patent is for a particular combination of the parts of an old machine, and the defendant has not used the whole combination, as specified in the description and carried into the summary, the plaintiff cannot recover. *Prouty et al. v. Ruggles*, 16 Peters, 336."

The court then proceeded to state the substance of the plaintiff's declaration, and referred to the patent of 1835, and the specification thereto attached, in order to ascertain the thing patented by that patent, which was stated therefrom. They then inquired what was the thing patented in 1831, by referring to the evidence of Thomas P. Jones, contained in the deposition aforesaid, in connection with the Journal of the Franklin Institute, referred to by him. The court, remarking that there being in evidence no copy of the patent of 1831, any drawing or specification of the thing patented, or other proof of the contents of either than was contained in the deposition and Journal aforesaid, then gave their opinion to the jury, that, on this evidence, the use of grooves was not claimed, and was no part of the thing patented in 1831 for turning short curves, but was a part of the thing patented in 1835; that it was an essential part of this invention, as Jones testified, and without which all the witnesses agreed that the invention was useless, as without the groove the cars would run off the road; and that the patent was not for any parts of the machine which were new, but for a new combination of the old parts. It was then submitted to the jury, whether, on the evidence aforesaid, the omission of the groove in the patent of 1831 arose from inadvertence, and if it was done contrary to the advice of Jones, and in conformity with the opinion of the legal adviser of the plaintiff, and whether, without the groove, the description of the thing patented

was sufficient, under the third section of the act of 1793, which was read and commented on by the court, who then proceeded as follows:

"The Secretary of State is a ministerial officer, who must issue a patent if the requisites are performed. 6 Peters, 241. The question of inadvertence or mistake is a judicial one, which the Secretary cannot decide, nor those judicial questions on which the validity of the patent depends. He issues the patent without inquiry. The correct performance of all the preliminaries to the validity of the original patent are always examinable in the court where the fact is brought. 6 Peters, 6, 47, 242.

"In the application of the law to the evidence before you, the first inquiry is into the state of facts existing at the time of granting the patent of 1835: did they present a case for renewal, under the rules of law on which we have given you our instructions? Whether the original patent was invalid or inoperative, is more a question of law than fact, to be ascertained on a judicial inspection of the patent, specification, drawings, models, and the evidence of the contents. The court must construe all written evidence; but, as depositions are considered merely as oral testimony, a jury must decide what parts are proved by them. The court must take as true the statements of witnesses as they are made, and lay down the law on the assumption of their credibility, and both court and jury must take an agreed or admitted, uncontested state of facts to be their rule of action. A jury may deem a witness unworthy of credit, or not believe his statement, but ought to do neither without good cause. Whether the defects in the old patent arose from inadvertence or otherwise, is also a mixed question of law and fact: of law, so far as depends on written, and of fact, as to parol evidence. On this subject you have the evidence of Dr. Jones, who officially examined the old patent, &c., and made out the new, and we are mainly left to ascertain the facts in relation to both patents from him. In laying down the law to you, we assume his verity in all he says, and, taking his statement as proof of the facts there existing, our opinion is, that, connected with the publication in the Journal of the Franklin Institute, in 1832, when the matter was fresh in his recollection, and the specification in the new patent, the old one was invalid and inoperative, by reason of non-compliance with the requisites of the act of 1793; that it did not embrace the groove, which was essential to its validity; that the new patent is not for the same invention, and that the plaintiff has not made out a case of such inadvertence, accident, or mistake as justified the issue of the new patent, inasmuch as it appears—from the patent for plates on rail-



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roads, issued at the same time with the one for short curves—that he had known and described the grooves.

“It is for you to say whether you will take this evidence as we do. If you discredit it, in the whole or in part, you will find accordingly.

“Another important question arises in this case, on the construction of the seventh section of the act of 1839, taken in connection with former laws, which is, whether the plaintiff can sustain an action for the use of his invention in the construction of his curves, before the granting of the patent of 1835.

“This section provides: ‘That every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent.’

“Though this act is retrospective in its effects on then existing patents, it is not void on that account. It was within the constitutional power of Congress to enact it as a rule for all cases to which its words and intentions apply, by its fair and legal interpretation, which we must ascertain by looking at the old law, the mischief and the remedy, which must be traced through the decisions of the Supreme Court, and the acts of Congress on the same subject.

“In 1808, an act was granted to Oliver Evans, renewing his patent, which had expired by its own limitation. In the interval, the defendant had constructed a machine of his invention, and continued to use it. After the new patent issued, he was held liable, according to the words of the law, for such subsequent use; but the Supreme Court thus express their opinion of the case, had it rested on general principles: ‘The legislature might have proceeded still further, by providing a shield for persons standing in the situation of these defendants. It is believed that the reasonableness of such a provision could have been questioned by no one, &c. The argument, founded on the hardship of this and similar cases, would be entitled to great weight, if the words of this proviso were obscure and open to construction.’ *Evans v. Jordan*, 9 Cranch, 203.”

## Statement of the case.

And thereupon the counsel for the plaintiff did then and there except to the aforesaid charge and opinion of the said court.

The above not being enough of the charge of the court below to the jury, the counsel for the plaintiff in error applied for and obtained a writ of *certiorari* to bring up additional extracts.

The return was as follows :

On searching the record and proceedings of the Circuit Court of the United States in and for the Eastern District of Pennsylvania, in the third circuit, in a certain cause therein lately depending between James Stimpson, plaintiff, and the West Chester Railroad Company, defendants, we find the following omission in the charge of the judge to the jury, which, in obedience to the annexed writ of *certiorari*, is hereby certified, to wit :

“In *Morris v. Huntington*, Judge Thompson held, that after a patent was surrendered, the patent would be open to public use without hazard, so far as depends on such patent. 1 Paine, 355. In *Grant v. Raymond*, the court notice the case of the use of the invention between the date of the old and before the new patent, but remark that that defense is not made ; and the Circuit Court did not say that such defense would not be successful ; and they add : ‘The defense, when true in fact, may be sufficient in law, notwithstanding the validity of the new patent.’ 6 Peters, 244. The court, in this and the subsequent case of *Shaw v. Cooper*, held, that the new patent was a continuation of the old, but gave no opinion on the question whether damages could be recovered for the intermediate use of a machine constructed after the first.

“This question was, however, put at rest by the last clause of the act of 1832, which, assuming that damages could not be recovered for a use of the patented invention before the new patent, provides : ‘But no public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall in any manner prejudice his right of recovery for any use or violation of his invention, after the grant of such new patent as aforesaid.’ The act of 1836 is still more explicit, by providing for the right of recovering damages only for ‘causes subsequently accruing.’

“It thus appears, that the act of 1839 goes only one step beyond those of 1832 and 1836, and is a dead-letter, if it protects the person who has purchased, constructed, or used the machine invented by the patentee, no farther than from damages accruing prior to the new patent ; for the same protection is given by those laws.

## Statement of the case.

“To have any effect, it must be held to be, in the words of the Supreme Court, ‘a shield,’ which covers the party from all liability, and by so construing it, the act of 1839 embodies the very principle, and none other, which in *Evans v. Jordan*, 9 Cranch, 203, that court declared to be one which they believed that no one could question its reasonableness, in order to prevent the hardship of a case precisely similar in principle to that presented. Such construction is the more reasonable, when it is considered that the protection is confined to the specific machine used before the patent, and cannot be extended to protect the use of any new or other machine, or construed to invalidate the patent, or justify the subsequent use by any other persons than those so protected.

“That such was the intention of Congress in relation to an original patent, cannot be doubted, and we can perceive no reason why they should omit the very case on which the Supreme Court had so explicitly declared their opinions, if the words of the act of 1808 would have permitted them to apply an unquestionable principle. The act of 1839 not only does not exclude its application, but authorizes and requires it. In referring to the application for a patent, it was evidently intended to apply it to the patent on which the patentee sought to recover, the renewed one, on which alone his right rested; for the law cannot be presumed to be intended to apply to a patent which, being invalid or inoperative, as a ground of action, had been surrendered, cancelled, and cancelled by the act of the patentee himself, and was thus divested of all intrinsic efficiency by the acts of 1832 and 1836. It could have no effect without the aid of the new one, and it would be absurd to suppose that the law overlooked the application for the only effective patent, and looked only to that which derived new life from it. Besides, the act of 1839 would take from a defendant the protection of the acts of 1832 and 1836, by confining its operation to the old patent, for damages could then be recoverable for the use between the date and the renewal,—a conclusion wholly inadmissible, on a sound construction of either of the acts in question.

“The act of 1832 expressly declares that the new patent shall be subject in all respects to the same matters of objection and defense as the original one; from which it necessarily follows, that if the purchase or construction of a machine, before the application for an original patent, would protect a defendant from all liability to the patentee, the same defense is available when applied to the new one.

“This view of the act of 1839, suffices for the purposes of the present case. A broader one has been taken of it, in all its bearings, in

## Argument for the plaintiff in error.

another district in this circuit, which it is not now necessary to examine, to decide the point now under consideration.

"In the case before us, it clearly appears that the defendants constructed their railroad with the plaintiff's curves in 1834, one year or more before the plaintiff's application for his renewed patent; consequently, they may continue its use, without liability to the plaintiff."

The case was argued by *C. J. Ingersoll* and *J. R. Ingersoll*, for the plaintiff in error, and *Miles*, for the defendants in error.

The brief of the counsel on the part of the plaintiff in error was as follows:

This case comes up for argument upon a bill of exceptions taken by the plaintiff to the charge of the learned judge in the court below, by which, in effect, the jury were directed to find for the defendants, which they accordingly did.

The plaintiff took a patent the 23d of August, 1831, for an invention or improvement in the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn short curves upon railroads.

It was surrendered, in consequence of a defect in the specification, and a new patent taken by him the 26th of September, 1835.

"The object of such surrender and renewal (see deposition of Dr. Thomas P. Jones, a witness for the defendant, in answer to the first cross-interrogatory, *ante*) was to limit and confine it to the turning short curves in streets, &c., by leaving out certain matters in it respecting the crossing of tracks or roads, and the passing over turnabouts, and to define the subject-matter of the patent more clearly, without its being necessary to refer to that, simultaneously obtained, 'for forming and using cast or wrought iron plates,' &c."

The action was brought at the October session, 1840. The curves used by the defendants were said to have been constructed and first used by them between the dates of the first and second patents, the use being continued by them since the date of the second patent.

The learned judge, after considering at length the law touching this part of the case, said to the jury:

"It clearly appears that the defendants constructed their railroad with the plaintiff's curves in 1834, one year or more before the plaintiff's application for his renewed patent; consequently, they may continue its use, without liability to the plaintiff."

In *Grant v. Raymond*, 6 Peters, 244, the defendant made it a ques-

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Argument for the plaintiff in error,

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tion, whether the patentee who took an amended patent could recover damages for the defendant's use, subsequent to the amendment of the patent, of machinery which had been constructed prior to the amendment. The court did not decide the point, thinking it did not come directly up for decision. But they said of it, "This objection is more formidable in appearance than in reality. It is not probable that the defect in the specification can be so apparent as to be perceived by any but those who examined it for the purpose of pirating the invention."

*Grant v. Raymond* was decided early in 1832.

On the 3d of July, 1832, was passed (4 Little & Brown's ed., 559) the first act by which the amendment of patents for defective specifications was statutorily recognized. The third section of the act contains a proviso, that the new patent shall be open to all objections which existed against the old one, by virtue of which, if the phrase stood alone, a defendant in this case, for example, might say: I used your curves before 1835—before the date of your patent—that is, between the new patent and the old one; and as a use by the public prior to the date of the patent would be fatal as against the old patent, so it is against the new.

Now, to meet such an argument, the same proviso goes on to say that no use of the patented invention between the dates of the first and second patents, excepting under a surrender of the invention to public use, shall prejudice the patentee's right to recover damages "for any use" after the grant of the new patent.

We quote at length the proviso of the third section: "*Provided, however, That such new patent so granted shall, in all respects, be liable to the same matters of objection and defense as any original patent under the said first-mentioned act. But no public use or privilege of the invention so patented, derived from or after the grant of the original, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention after the grant of such new patent as aforesaid.*"

It is submitted, that, by the terms of this statute, to use, after date of the second patent, the patented machinery, even though the specific machine used had been constructed and used between the dates of the first and second patents, is expressly denied to the public.

On the faith of this statute of the 3d of July, 1832, the plaintiff, in September, 1835, surrendered the patent granted him the 23d of August, 1831, and took an amended one.

Has any act of Congress changed the law, in this particular, since 1832?

As any such law, so far as regards this plaintiff, would be retroactive, it ought to be clearly expressed.

On the 6th of July, 1836, was passed the new Patent Act, by which the whole system was recast; but the thirteenth section, which relates to amended patents, says in broad terms:

“And the patent so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced, for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing of the original patent.”

It is submitted, that the words “for causes subsequently accruing,” are not to be strained from their natural construction, in order to be made to retroact against the rights already vested under the protection of a statute; and that the cause of action against these defendants, as far as concerns their use of the patented invention since the 26th of September, 1835, is a cause subsequently accruing, within the just and obvious meaning of the act.

In 1837, the 3d of March, was passed an amendment to the law of 1836.

The plaintiff submits that the seventh and ninth sections of the act of 1837 bear on his case, by analogy. They permit a patentee who has patented too much, and more than he invented, to make disclaimer of the excess, with the same effect, as regards the validity of the patent, as if his disclaimer were part of his original specification—that is to say, the patentee shall recover as if his patent had been originally right, instead of wrong; and no exception is made in favor of parties who, like the defendants here, use, after disclaimer, one of the patented things which they had constructed and begun to use while the patent was too broad; the legislature being influenced, perhaps, by the suggestion of this court in *Grant v. Raymond*, that that party is not entitled to much favor who scans a specification in order to pirate it.

On the 3d of March, 1839, the latest amendment of the Patent Laws was passed.

The seventh section of this act is cited by the learned judge, who asks what this section means, if it do not mean that the use of a patented machine shall be free to a defendant after the patent, if he constructed it before. It reads thus:

“SEC. 7. *And be it further enacted*, That every person or corporation who has, or shall have, purchased or constructed any newly-invented

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machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and to vend to others to be used, the specific machine, or manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use, prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent."

It is admitted, in answer to the learned judge, that the seventh section of the act of 1839 was intended to protect defendants, constructors of machinery prior to the patent, in the use of such machinery after the grant to the patentee. This section, which has no reference to renewed or amended more than to all other patents, is believed to provide for a case till 1839 unprovided for, namely, the case in general, whether it arise under an original patent, or under one which has been amended, or which has been modified by disclaimer of the use by a defendant, after the issuing of the letters, of a machine such as they patent, but which specific machine was purchased or constructed before their date. But it is respectfully submitted that this prior use, meant a use prior to the first or original application of the inventor for his patent, and that the legislature had not in their contemplation the second application of the inventor, when they used the words "prior to the application of the inventor or discoverer for a patent." The last clause of the section has obvious reference to the original application alone, when it is declared that "such purchase, sale, or use, prior to the application for a patent," shall not (except under certain circumstances) make the patent invalid; for it was clear already, and quite independently of this statute, that no renewed or amended patent could be worth paying for, if the use of the patented machinery by third persons, prior to the renewal, could make it invalid.

*Grant v. Raymond*, however, furnishes the best answer to the learned judge's position, that the plaintiff's patent is liable to be damaged by what has taken place since the date of the original letters. At page 244, 6 Peters, the court says:

"It has also been argued, that the new patent must issue on the new specification, and on the application which accompanies it; consequently, it will be true that the machine was 'not known or used before the application.' But the new patent, and the proceedings on

which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original patent. The application may be considered as appended to the original application."

The plaintiff in error contends, that a true interpretation of the letter of these several acts, and a due regard to the spirit of all recent legislation on the subject of patent-rights, which has been kind and liberal towards patentees, enforce the conclusion that it was meant, when the new patent was granted, to give to the new, in all particulars, the charter of the old, unless when restrained by express words to narrower limits. And further, that while, for obvious reasons, the acts deny to the patentee a right to recover damages, under the new patent, for a use of the invention of earlier date than the patent itself, (which denial is in terms,) no express words of the statutes, or fair or necessary implication from them, or leaning, can be found, in the whole course of the legislation since 1832, to warrant the conclusion that the new patent does not confer upon the grantee an entire monopoly of the fruits of his invention from the date of the second letters to the expiration of the fourteen years from the date of the first.

The plaintiff in error therefore assigns for error the learned judge's instructions to the jury, recognizing the defendants' right to use the patented invention, after the date of the second patent, provided they had commenced its use prior to that date, and continued after that date to use only the specific machine at first used.

The learned judge also charged the whole case to be against the plaintiff upon another question, namely, that of the description of the "groove" in the original patent.

The judge was of opinion that the groove was not in the first patent, and was in the second; and, therefore, that the second was broader than the first, and not confined to the thing there patented, and thus was defective as an amended patent. The plaintiff's patent being, as he supposed, established fully by judicial sanction of the highest sort, in his contest with the Trenton Railroad Company, reported in 14 Peters, 448, had not even brought with him, when he came to try his cause in Philadelphia, the original letters patent, and the drawings which accompanied them. Nor was any notice given him by the defendant to produce them.

The result of his suit against the Baltimore and Susquehanna Railroad Company, tried in the Maryland District, in April Term, 1843, when both the original patent and the drawings were produced in court, proved to be quite ill founded, the attempt of the defendants,



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Argument for the plaintiff in error.

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in the present case, to criticise his second patent as actually varying from the first, by the addition of this new matter, the groove.

He is aware, however, that he must sustain his case as it appears by this record, and he proceeds to do so.

The whole invention of the plaintiff consisted of a new method of attaining conical action in turning short curves on railroads; and the groove had no more to do with it than this: that when, to attain this action, the outer wheel was mounted upon its flanch, the groove, by receiving the inner wheel, prevented the car from slipping off the track—a very material consideration, it is true—in turning the corner; and so was the car, or the steam-engine that drew the car; but neither of them had anything to do with the plaintiff's method of producing conical action. Without a groove,—just as without steam, a horse, or other power,—the corner could not be turned; and, therefore, in describing the plaintiff's invention, both this power and the groove must needs be referred to; but it is respectfully denied that more than the merest allusion to either is necessary, neither of them being any part of the invention, nor so occult as to demand, for even the most unenlightened observer, more than a mere allusion to it.

Now, it was in proof, from the witness called by the defendants to testify to the contents of the original specification, that it alluded to the groove.

"I believe, however, that it (the groove) was alluded to in this specification." Evidence of Dr. Jones.

This allusion to the groove in the first patent, the learned judge rules, in his charge, to be insufficient, and in the paragraph *ante*, after so holding, he goes on to declare that the groove should have been "claimed." It may be mentioned that it is not claimed in the new patent, nor even alluded to in the summary of the specification, so collateral is it to the invention.

The plaintiff in error further assigns for error, in this portion of the charge touching the groove, the learned judge's decision against the plaintiff's right to claim under his patent, because of his alleged omission in regard to the groove; and particularly to the judge's saying, that, assuming the truth of Dr. Jones' deposition, the opinion of the court was, that the old patent was "invalid and inoperative by reason of non-compliance with the requisition of the act of 1793; that it did not embrace the groove, which was essential to its validity; that the new patent is not for the same invention."

Also, the learned judge's taking from the jury the question, which came fairly up as a question of fact, namely, whether this mention of, or allusion to, the groove was or was not too slight a description of

that part of the combination to enable one skilled as an engineer to make a curve, or to stand for a compliance, by the patentee, with the requisition of the statute touching the proper description of the invention.

Also, the learned judge's deciding it to be a matter of law, and not of fact for the jury, what the thing patented in 1831 was, when the evidence of what it was lay not in a written paper, which the judge could read and construe, but in parol evidence and explanations *per testes*.

Also, the learned judge's not giving the due legal effect to the Secretary's seal and letters patent, as *prima facie* evidence that the second patent legitimately succeeded to the first, and to his assuming, on the contrary, that it was incumbent on the plaintiff, and not on the defendant, (who assailed it,) to show what the first patent contained, and what its character and defects were; and in the absence of the patent, and of any notice or call for it by the defendant, and in the absence of any satisfactory account of its contents to the learned judge, making the plaintiff, and not the defendant, responsible for the imperfectness of the proofs regarding the same.

The judge left nothing to the jury, as distinctly appears in his summing up, in regard to the groove, but the question whether Dr. Jones' testimony was to be believed or not. If believed, he told the jury they must find for the defendants, the old patent being defective, in not embracing the groove, and the new patent, which he said did embrace it, being therefore for a different invention altogether.

The plaintiff in error also assigns it for error, that the learned judge ruled "mistake," in the statute about amending patents; to mean inadvertence or accident only, and excluded cases of honest mistakes of judgment.

*Mr. Miles, for the defendants in error, filed the following brief:*

*Abstract of Case.*

1. This is a writ of error to the Circuit Court for the Eastern District of Pennsylvania. The plaintiff in the Circuit Court is the plaintiff in error in this court. The verdict in the Circuit Court was for the defendants.

2. The action was brought to recover damages for an alleged infringement by the defendants of an exclusive right, alleged to belong to the plaintiff, to make, use, construct, and vend an improvement "in the mode of turning short curves on railroads," of which he claimed to be the original inventor, and alleged to have been secured

to him by letters patent of the United States, according to the acts of Congress.

The plaintiff claimed under letters patent, dated September 26th, 1835, which recited that letters for the improvement were granted to him on August 23d, 1831, but which were "hereby cancelled, on account of a defective specification."

3. The plaintiff declared on the letters patent of September 26th, 1835, in four counts, (only varying in the allegation of different modes of infringement, namely, making, constructing, selling, and using,) all setting forth that "the said letters patent (that is, of August 23d, 1831) were cancelled in due form of law, on account of a defective specification."

4. The defendants pleaded not guilty, gave due notice to the plaintiff, under the acts of Congress, of a defense based upon the want of originality of invention of the thing patented on the part of the plaintiff, under the several patents of 1831 and 1835, said notice including the prior use and knowledge of other persons, and of prior printed and published descriptions of the same, &c., and under such plea and notice gave evidence to the jury.

The original letters of the 23d of August, 1831, were not in evidence, they having been destroyed in the conflagration of the Patent Office in December, 1836, nor was there any copy of them given in evidence.

Their loss or destruction having been proved, secondary evidence was given of their contents. (Journal of Franklin Institute, vol. 9, p. 124, No. 37; and by deposition of Dr. Thomas P. Jones.)

The claim by this evidence, under the patent of 1831, was "to the application of the flanches of railroad carriage-wheels to turn short curvatures upon railroads or tracks, particularly turning the corners of streets, wharves, crossings of tracks or roads, and passing over turnabouts," &c. No mention was made therein of the use of a groove upon the inner circle for the flanch to run in, so as to enable the wheel on the inner circle to run on its tread, without which there was evidence tending to show that the whole alleged invention was useless.

The claim under the patent of 1835 was to "the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn curves upon railways," &c., "operating upon the principles herein set forth." The specification referred to in this summary describes the use of the flanch running on the surface of the outer rail, and of the tread running on the inner rail, which is formed with a groove to receive the flanch of the

wheel on the inner rail, as the essential parts which, combined together, form the improvement.

5. Upon the trial, several questions of law and of fact arose. His honor, Mr. Justice BALDWIN, charged the jury upon the law, and left the facts falling within the scope of the principles of the law, as laid down by him, to the determination of the jury.

*Points of law, arising under the charge, contended for by defendants.*

The third section of the act of 21st February, 1793, in substance, provides that the applicant for a patent shall give a description, in full, clear, and exact terms, of the thing invented, and its modes of application.

By the sixth section of the same act, a defendant in a suit brought on letters patent may show that the description (that is, specification) does not contain the whole truth relative to his discovery, or that it contains more than is necessary to produce the desired effect, which concealment or addition shall fully appear to have been made for the purpose of deceiving the public, or that the thing secured by patent was not originally discovered by the patentee, &c.

The third section of the act of July 3, 1832, provides, in substance, that if any patent shall be invalid or inoperative by reason of non-compliance with the terms of the third section of 1793, by "inadvertence, accident, or mistake," and "without any fraudulent or deceptive intention," it may be lawful for the Secretary of State, on surrender of the original patent, to grant a new patent, on compliance with the conditions of the third section of the act of 1793, for the residue of the term unexpired.

The thirteenth and fifteenth sections of the act of 4th July, 1836, which supplied the former laws enacted on the subject, contain in substance the same provisions as to the inoperation of a patent by reason of the defective description, and allowing a surrender and regrant where the defect arose from "inadvertency, accident, or mistake, and without any fraudulent or deceptive intention."

The seventh section of the act of March 3, 1839, provides "that every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, &c., prior to the application by the inventor, &c., for a patent," may use and vend it at all times, without liability to the inventor, or any person, &c.

Under these acts, the following points are submitted to have been judicially decided:

1. That where a patentee, under the act of February 21, 1793, has not complied with the terms of its third section, even through inad-

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Argument for the defendants in error.

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vertence, accident, or mistake, the plaintiff cannot recover for an infringement prior to a surrender and new grant. *Grant v. Raymond*, 6 Peters, 244; *Shaw v. Cooper*, 7 Peters, 320; *Whitney v. Emmett*, 1 Bald., 303.

2. That if the patentee, under the act of 1793, has not complied with the terms of its third section, through fraudulent and deceptive intention, by the concealment of or addition to his real discovery, his patent, by the sixth section, is absolutely void. *Grant v. Raymond*, 8 Peters, 246, 247; *Whitney v. Emmett*, 1 Bald., 303.

3. (1.) That a surrender, under the act of 1832, and a new grant, are only sustainable where the defect in the description of the first patent was the result of inadvertence, accident, or mistake. *Grant v. Raymond*, 6 Peters, 246, 247. (2.) That a new grant, on such a surrender, is not sustainable, but is absolutely void, if it appear that the defect in the description of the first patent, whether of concealment or addition, was the result of a fraudulent and deceptive intention on the part of the patentee. (3.) That if a patentee surrendered his first patent, and, under pretense of an inadvertence, accident, or mistake in its description, obtained a new patent, adding thereto a new material or element of which he was not the original inventor, and which is necessary to make the thing patented useful, thus in the second patent specifying another combination; constituting a mode or a machine substantially different from that described and claimed in the first, it is fraud in the patentee, and the patent is void. *Grant v. Raymond*, 6 Peters, 218, 244; *Philadelphia Railroad v. Stimpson*, 14 Peters, 462; *Shaw v. Cooper*, 7 Peters, 292.

Note. The act of 1832, (July 3d,) authorizing a surrender and regrant, shortly followed the decision in *Grant v. Raymond*, 6 Peters, (January Term, 1832,) and, by express enactment, provided for that which had before been allowed by practice and judicial construction only.

4. That an original patent, as well as that granted on a surrender of the first under these acts, are *prima facie* evidence only of the novelty and utility of the alleged invention, and of the compliance by the patentee with the terms of the several acts of Congress entitling him to a patent; but their validity is examinable in a judicial proceeding upon any such patent, part of the inquiry being within the province of the court, where the construction of written documents is to be made, and part being for the determination of the jury, where questions of fact are involved. *Grant v. Raymond*, 6 Peters, 218; *Shaw v. Cooper*, 7 Peters, 292; *Philadelphia Railroad v. Stimpson*, 14 Peters, 448; *Prouty v. Ruggles*, 16 Peters, 336.

## Opinion of the court.

5. If a patentee's first patent be inoperative, for want of a full and exact description, and he stands by for a long and unreasonable period of time, without surrendering and remedying the defect, by furnishing such a description and obtaining a regrant, and in the meantime permits others to use what he subsequently claims to be his invention, with a knowledge of such use, without objection or asserting his right, this is evidence from which a jury may infer his acquiescence and abandonment to the public as a matter of fact. *Shaw v. Cooper*, 7 Peters, 320-322.

6. Under the act of 1839, if the defendants purchased or constructed this mode of turning curves before the application for the patent of 1835, and this combination or mode described in that patent was newly invented by the patentee, the plaintiff cannot recover, notwithstanding the act of 1839 was subsequent to the dates of such purchase or construction, and the patent of 1835. *Shaw v. Cooper*, 7 Peters, 320-322; *Mc Clurg v. Kingsland*, 1 How., 204; *Evans v. Jordan*, 9 Cranch, 201.

Note 1. This statute was intended to provide expressly, and in terms, (designating a specific point of time,) for all that class of cases of implied acquiescence and waiver in favor of the public, resulting from the negligence of the patentee, by which judicial construction held that the patentee had no claim against persons using or constructing the alleged invention under such circumstances.

Note 2. This action was brought in the Circuit Court after the passage of the act of 1839, to wit, at the October session, 1840.

The charge of the court left all the facts falling within the scope of the legal principles therein stated to the determination of the jury.

1. "The question of the validity of the new patent is a judicial one, depending on the fact of inadvertence or fraud, as you shall find it." "You must then be satisfied affirmatively," &c. "The finding of the fact of inadvertence may negative the fact of fraud," &c.

2. "It was then submitted to the jury, whether, on the evidence aforesaid, the omission in the patent of 1831 arose from inadvertence," &c.

3. "Depositions are considered merely as oral testimony. A jury must decide what facts are proved by them; \* \* \* a mixed question of law and fact: of law, so far as depends on written, and of fact, as to parol, evidence," &c.

4. "It is for you to say whether you will take the evidence as we do. If you discredit it, in whole or in part, you will find accordingly."

Mr. Justice M'LEAN delivered the opinion of the court.

The plaintiff brought an action against the defendant for an in-

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fringement of his patent for a "new and useful improvement in the mode of turning short curves on railroads." The questions for decision arise on exceptions to the charge of the court to the jury. And here it may be proper to remark that the exceptions are to the charge as published at length, and not to the points ruled by the court, as is the correct practice. Under the peculiar circumstances of this case, the court will not dismiss the writ of error upon this ground, but it is expected that a different course will hereafter be pursued.

On the 21st of August, 1831, the plaintiff obtained a patent for an invention or improvement in the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn short curves upon railroads. The specification of this patent being defective, it was surrendered the 26th of September, 1835, and a renewed one obtained, in order, as proved, "to limit and confine it to the turning short curves in streets, &c., by leaving out certain matters in it respecting the crossing of tracks or roads, and the passing over turnabouts, and to define the subject-matter of the patent more clearly, without its being necessary to refer to that, simultaneously obtained, for forming or using cast or wrought iron plates," &c.

In his charge, the judge said to the jury: "It clearly appears that the defendants constructed their railroad with the plaintiff's curves, in 1834, one year or more before the plaintiff's application for his renewed patent; consequently, they may continue its use, without liability to the plaintiff."

The patent was surrendered, and a new one obtained, under the third section of the "Act concerning Patents," of the 3d of July, 1832, and the correctness of the above opinion is to be ascertained by a reference to the proviso of that section. It is there declared: "No public use or privilege of the invention so patented, derived from or after the grant of the original patent, either under any special license of the inventor, or without the consent of the patentee that there shall be a free public use thereof, shall, in any manner, prejudice his right of recovery for any use or violation of his invention, after the grant of such new patent as aforesaid."

The charge of infringement, in the declaration, is laid some years after the new patent; so that the question does not arise, whether an action could be sustained for a violation of the right prior to the corrected patent. The above proviso would seem to be susceptible of but one construction, and that is, that the patentee may sustain an action "for any use or violation of his invention after the grant of a new patent." Now, it is plain that no prior use of the defective pat-

ent can authorize the use of the invention after the emanation of the renewed patent under the above section. To give to the patentee the fruits of his invention, was the object of the provision; and this object would be defeated, if a right could be founded on a use subsequent to the original patent, and prior to the renewed one.

The thirteenth section of the act of the 4th of July, 1836, which remodelled the Patent Law in this respect, made no material change in the act of 1832. The words in the latter act are: "And the patent so reissued, together with the corrected description and specification, shall have the same effect and operation in law, on the trial of all actions hereafter commenced, for causes subsequently accruing, as though the same had been originally filed in such corrected form, before the issuing out of the original patent." Now, any person using an invention protected by a renewed patent, subsequently to the date of this act, is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent.

The Circuit Court relied upon the seventh section of the act of the 3d of March, 1839, as sustaining their construction in regard to the use of the invention after the renewed patent. But that section has exclusive reference to an original application for a patent, and not to a renewal of it. We think the court erred in their instruction to the jury, above stated.

In their charge, the court said: "The use of grooves was not claimed, and was no part of the thing patented in 1831, for turning short curves, but was a part of the thing patented in 1835." "That it was an essential part of the invention." And further, "in taking the statement" of Dr. Jones, "as proof of the facts there existing, our opinion is, that, connected with the publication in the Journal of the Franklin Institute, in 1832, when the matter was fresh in his recollection, and the specification in the new patent, the old one was invalid and inoperative, by reason of non-compliance with the requisites of the act of 1793; that it did not embrace the groove, which was essential to its validity; that the new patent is not the same invention, and that the plaintiff has not made out a case of such 'inadvertence, accident, or mistake,' as justified the issue of the new patent, inasmuch as it appears, from the patent for plates on railroads, issued at the same time with the one for short curves, that he had known and described the grooves."

The original patent, as proved by Dr. Jones, was burnt with the Patent Office, and no part of the specifications is preserved, except that which was published by the witness in the Franklin Journal. That publication does not purport to give the whole of the specifica-



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tions, and, consequently, the claim is not limited by the notice in that journal. Doctor Jones, speaking of the patent issued in 1831, says: "The main defect, in my judgment, of the original specifications in the patent for turning short curves, was the omission of the mention of the groove in the inner rail. I believe, however, that it was alluded to in the specifications, but the description of it was contained principally, if not wholly, in the specification of the patent for forming and using cast-iron or wrought plates," &c.

That there was a defect in regard to the grooves in the specifications of the first patent, is shown, and, also, that the patent was surrendered in order to remedy that defect. But whether this vitiated the patent, is not a question in this case, as it does not affect the right now asserted, if the first patent were void. Whether the new patent was substantially for a different invention from the first one, was a question for the jury on the evidence. But the court ruled this point, withdrawing the facts from the jury. The witness thinks "that in the first patent the grooves were alluded to," but the terms used are not recollected by him; and, as the patent has been burnt, they cannot now be proved. We think the Circuit Court erred in not leaving the jury to act upon the facts, as regards the difference between the original and the renewed patent. On the facts, we should draw a different conclusion from that which was given to the jury by the Circuit Court. An allusion to the grooves in this specification, as more particularly described in the other patent, would, at least, show the intention of the patentee, if it did not make good his patent.

By the thirteenth section of the act of 1836, "if the patent shall be inoperative or invalid, by reason of a defective or insufficient description or specification," &c., "if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful" to surrender it, &c. Now, as in granting the renewed patent, the officers of the government act under the above provisions, their decisions must, at least, be considered as *prima facie* evidence that the claim for a renewal was within the statute. But this would not be conclusive against fraud in the surrender and renewal, which, on the evidence, would be a matter for the jury. And we suppose that the inquiry in regard to the surrender is limited to the fairness of the transaction. In whatever manner the mistake or inadvertence may have occurred, is immaterial. The action of the government, renewing the patent, must be considered as closing this point, and as leaving open for inquiry, before the court and jury, the question of fraud only.

The judgment of the Circuit Court is reversed, and the cause re-

manded to that court, with instructions to award a *venire facias de novo*.

JAMES G. WILSON, PLAINTIFF, v. LEWIS ROUSSEAU AND CHARLES EASTON.

(4 Howard, 646.)

1. The eighteenth section of the Patent Act of 1836 authorized the extension of a patent on the application of the executor or administrator of a deceased patentee.
2. Such an extension does not inure to the benefit of assignees under the original patent, but to the benefit of the administrator, (when granted to an administrator,) in his capacity as such. But those assignees who were in the use of the patented machine at the time of the renewal have still a right to use it.
3. The extension could be applied for and obtained by the administrator, although the original patentee had, in his lifetime, disposed of all his interest in the then existing patent. Such sale did not carry anything beyond the term of the original patent.
4. A covenant by the patentee, made prior to the law authorizing extensions, that the covenantee should have the benefit of any improvement in the machinery, or alteration or renewal of the patent, did not include the extension by an administrator, under the act of 1836. It must be construed to include only renewals obtained upon the surrender of a patent on account of a defective specification. Parties to contracts look to established and general laws, and not to special acts of Congress.
5. A plaintiff, therefore, who claims under an assignment from the administrator, can maintain a suit against a person who claims under the covenant.
6. An assignee of an exclusive right to use two machines within a particular district, can maintain an action for an infringement of the patent within that district, even against the patentee.
7. In the case of Woodworth's planing-machine, the patent granted to the administrator was founded upon a sufficient specification and proper drawings, and is valid.
8. The decision of the Board of Commissioners, to whom the question of renewal is referred, by the act of 1836, is not conclusive upon the question of their jurisdiction to act in a given case.
9. The Commissioner of Patents can lawfully receive a surrender of letters patent for a defective specification, and issue new letters patent upon an amended specification, after the expiration of the term for which the original patent was granted, and pending the existence of an extended term of seven years. Such surrender and renewal may be made at any time during such extended term.

THIS case and the three subsequent ones, namely, *Wilson v. Turner*, *Simpson et al. v. Wilson*, and *Woodworth & Bunn v. Wilson*, were argued together, being known as the patent cases. Many of the points of law involved were common to them all, and those which were fully argued in the first case which came up were but incidentally

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touched in the discussion of the subsequent cases. They all related to the rights which were derived under a patent for a planing machine taken out by Woodworth, and renewed and extended by his administrator. The validity of the original patent was questioned only in one case, namely, that which came from Kentucky, which was the last argued. There were four cases in all, namely, one from New York, one from Maryland, one from Louisiana, and one from Kentucky. In the course of the argument, counsel referred indiscriminately to the four records, as some documents were in one which were not to be found in another.

The cases will be taken up and reported *seriatim*, and the documents which are cited in the first will not be repeated in the others.

The first in order was the case from New York, the titling of which is given at the head of this report.

It came up from the Circuit Court of the United States for the Northern District of New York, on a certificate of division in opinion.

On the 26th of November, 1828, William Woodworth presented the following petition:

*"To the Hon. Henry Clay, Secretary of State of the United States.*

"The petition of William Woodworth, of the city of Hudson, in the county of Columbia, and State of New York, respectfully represents:

"That your petitioner has invented a new and improved method of planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances, not known or used before the application by him, the advantages of which he is desirous of securing to himself and his legal representatives. He therefore prays that letters patent of the United States may be issued, granting unto your petitioner, his heirs, administrators, or assigns, the full and exclusive right of making, constructing, using, and vending to others to be used his aforesaid new and improved method, agreeably to the acts of Congress in such case made and provided; your petitioner having paid thirty dollars into the treasury of the United States, and complied with the other provisions of the said acts.

WILLIAM WOODWORTH.

"November 26, 1828."

On the 4th of December, 1828, Woodworth executed to James Strong the following assignment:

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"Whereas I, William Woodworth, of the city of Hudson, in the State of New York, heretofore, to wit, on the 13th day of September, 1828, assigned and transferred, for a legal and valuable consideration, the one equal half of all my right, title, claim, and interest in and to the invention or improvement mentioned and intended in the foregoing petition, oath, and specification, to James Strong, of the city of Hudson;

"And whereas, also, the subjoined assignment is intended only to convey and assign the same interest transferred and assigned in the assignment of the 13th of September above mentioned, without any prejudice to my one equal half part of said invention or improvement, which is expressly reserved to myself and my legal representatives:

"Now, know all men, that I, the said William Woodworth, for and in consideration of the sum of ten dollars, and other valuable considerations me moving, have, and do hereby, for myself and legal representatives, give, assign, transfer, and assure to the said James Strong and his legal representatives the one full and equal half of all my right, title, interest, and claim in and to my new and improved method of planing, tonguing, grooving, and cutting into mouldings, either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances, mentioned and intended to be secured by the foregoing petition, oath, and specification, together with all the privileges and immunities, as fully and absolutely as I do or shall enjoy or possess the same; to have and to hold and enjoy the same, to the said James Strong and his legal representatives, do or may.

"In witness whereof, I have hereunto set my hand and seal, the 4th day of December, 1828.

"WILLIAM WOODWORTH. [SEAL.]

"Witnesses: HENRY EVERTS, DAVID GLEASON."

On the 6th of December, 1828, Woodworth took the following oath:

*"State of New York, Rensselaer County, ss.:*

"On this sixth day of December, A. D. 1828, before the subscriber, a justice of the peace in and for the county of Rensselaer aforesaid, personally appeared the aforesaid William Woodworth, and made solemn oath, according to law, that he verily believes himself to be the true and original inventor of the new and improved method, above described and specified, for planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other mate-

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rial, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances; and that he is a citizen of the United States.

“JOHN THOMAS, *Justice of the Peace.*”

The above documents appear to be recorded in the third volume of Transfers of Patent-Rights, pages 155, 156, in the Patent Office of the United States.

On the 27th of December, 1828, a patent was issued as follows:

“Letters Patent to W. Woodworth. The United States of America to all to whom these letters patent shall come:

“Whereas, William Woodworth, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances, which improvements, he states, have not been known or used before his application; hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement; hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvements, and praying that a patent may be granted for that purpose: These are, therefore, to grant, according to law, to the said William Woodworth, his heirs, administrators, or assigns, for the term of fourteen years from the 27th of December, 1828, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said William Woodworth himself, in the schedule hereto annexed, and is made a part of these presents.

“In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed.

“Given under my hand, at the city of Washington, this 27th day of December, in the year of our Lord 1828, and of the independence of the United States of America the fifty-third.

[SEAL]

“(Signed,)

J. Q. ADAMS.

“By the President.

“(Signed,)

H. CLAY, *Secretary of State.*”

*Certificate of William Wirt, Attorney-General of the United States.*

*“City of Washington, to wit:*

“I do hereby certify, that the foregoing letters patent were delivered to me on the 27th day of December, in the year of our Lord 1828, to be examined; that I have examined the same, and find them conformable to law; and I do hereby return the same to the Secretary of State, within fifteen days from the date aforesaid, to wit, on this 27th day of December, in the year aforesaid.

“WILLIAM WIRT,

*“Attorney-General of the United States.”*

*Schedule.*

“The schedule referred to in these letters patent, and making part of the same, containing a description, in the words of the said William Woodworth himself, of his improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances.

“The plank, boards, or other material, being reduced to a width by circular saws or friction-wheels, as the case may be, is then placed on a carriage, resting on a platform, with a rotary cutting-wheel in the center, either horizontal or vertical. The heads or circular plates, fixed to an axis, may have one of the heads movable, to accommodate any length of knife required; the knife fitted to the head with screws or bolts, or the knives or cutters for moulding, fitted by screws or bolts to logs, connecting the heads of the cylinder, and forming, with the edges of the knife or cutters, a cylinder. The knives may be placed in a line with the axis of the cylinder, or diagonally. The plank or other material, resting on the carriage, may be set so as to reduce it to any thickness required; and the carriage, moving by a rack and pinion, or rollers, or any lateral motion, to the edge of the knives or cutters on the periphery of the cylinder or wheel, reduces it to any given thickness. After passing the planing and reducing wheel, it then approaches, if required, two revolving cutter-wheels, one for cutting the groove, and the other for cutting the rabbets that form the tongue; one wheel is placed directly over the other, and the lateral motion moving the plank or other material between the grooving and rabbeting wheels, so that one edge has a groove cut the whole length, and the other edge a rabbet cut on each side, leaving a tongue to match the groove. The grooving-wheel is a circular plate, fixed on an axis, with a number of cutters attached to it, to project beyond

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the periphery of the plate, so that when put in motion it will perform a deep cut or groove, parallel with the face of the plank or other material. The rabbeting-wheel, also of similar form, having a number of cutters on each side of the plate, projecting like those on the grooving-wheel, cuts the rabbet on the side of the edge of the plank, and leaves the tongue or match for the groove. By placing the planing-wheel axis and cutter-knives vertical, the same wheel will plane two planks or other material in the same time of one, by moving the plank or other material opposite ways, and parallel with each other, against the periphery of the planing or moulding wheel. The groove and tongue may be cut in the plank or other material at the same time, by adding a grooving and rabbeting wheel.

"Said William Woodworth does not claim the invention of circular saws or cutter-wheels, knowing they have long been in use; but he claims as his invention the improvement and application of cutter or planing wheels to planing boards, plank, timber, or other material; also his improved method of cutters for grooving and tonguing, and cutting mouldings on wood, stone, iron, metal, or other material, and also for facing and dressing brick; as all the wheels may be used single and separately for moulding, or any other purpose before indicated. He also claims, as his improved method, the application of circular saws for reducing floor-plank and other materials to a width.

"Dated Troy, December 4, 1828.

"WILLIAM WOODWORTH.

"Witnesses: HENRY EVERTS, D. S. GLEASON."

On the 25th of April, 1829, one Uri Emmons obtained a patent for a new and useful improvement in the mode of planing floor-plank, and grooving and tonguing and straightening the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called the cylindrical planing machine; the said letters patent, and specification attached thereto, being in the following words and figures:

*Uri Emmons' Patent.*

"United States of America to all to whom these letters patent shall come:

"Whereas, Uri Emmons, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the mode of planing floor-plank, and grooving and tonguing the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called 'the cylindrical planing machine,' which improvement, he states, has not been known or used

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before his application; hath made oath that he does verily believe that he is the true inventor or discoverer of the said improvement; hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a petition to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: These are, therefore, to grant, according to law, to the said Uri Emmons, his heirs, administrators, or assigns, for the term of fourteen years from the twenty-fifth day of April, one thousand eight hundred and twenty-nine, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said Uri Emmons himself, in schedule hereto annexed, and is made a part of these presents.

"In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed.

"Given under my hand, at the city of Washington, this twenty-fifth day of April, in the year of our Lord one thousand eight hundred and twenty-nine, and of the independence of the United States of America the fifty-third.

[SEAL.]

"(Signed,)

ANDREW JACKSON.

"By the President.

"(Signed,) M. VAN BUREN."

"*City of Washington, to wit:*

"I do hereby certify that the foregoing letters patent were delivered to me on the twenty-fifth day of April, in the year of our Lord one thousand eight hundred and twenty-nine, to be examined; that I have examined the same, and find them conformable to law; and I do hereby return the same to the Secretary of State, within fifteen days from the date aforesaid, to wit, on the twenty-fifth day of April, in the year aforesaid.

"(Signed,)

J. MACPHERSON BERRIEN,

"*Attorney-General of the United States.*"

*Schedule.*

"The schedule referred to in these letters patent, and making part of the same, containing a description, in the words of the said Uri Emmons himself, of his improvement in the mode of planing floor-plank, and grooving and tonguing and straightening the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called the cylindrical planing machine.



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“The machinery for the improvement consists—

“1st. Of a frame of wood or metal.

“2d. Of the gear and fixtures combined and connected together for the above-named operation, the principle of which consists in running the plank, boards, or timber over, under, or at the sides of a cylinder of wood or metal, on which knives are placed, straight or spiral, with their edges exactly corresponding with each other, having from two to twelve knives or edges; also burrs or saws, similar to those used for cutting teeth in brass wheels, to groove and tongue the edge of the boards or plank as they pass through between rollers, or on a carriage, by the surface of the cylinder. The shape, form, and construction of the above principle may be varied in shape and position, dimensions, &c., still the same in substance,—the same principle producing the same effect. I have, by experimental operation, found that the following mode, in form, is the best:

“1st. A frame composed of two pieces of timber, from twelve to eighteen feet long, about six to ten inches broad, placed about fifteen inches apart, framed together with four girths, one at each end, and at equal distances from the center, and flush with the under side. This frame is supported by posts of a proper length, framed into the under side of the above pieces of timber, and braced so as to be of sufficient strength to maintain the operative posts. There is placed a roller in the center, of metal or hard wood, across the frame, the surface of the roller being even with the surface of the frame; directly above and parallel with this roller is hung the cylinder, with two or four spiral edges or knives, six to ten inches diameter, and hung on a cast-steel arbor, resting in movable boxes attached to the sides of the frame, so as to set the cylinder up and down from the roller, to give the thickness of the timber to be planed. On each side of the cylinder is placed a pair of feeding-rollers, of hard wood or metal, the under one of each pair being level with the center one. The upper ones are hung in boxes, which are pressed down with springs or weights, so that, when the timber comes between them, they will hug and carry it through. These rollers are connected and turned by wheels, at a velocity of about twelve feet surface of the roller per minute; the cylinder, with two edges, to make about two thousand five hundred revolutions per minute, cutting five thousand strokes every twelve feet. This can be varied, according to the number of edges, power, and velocity of the different parts. The power is attached to the cylinder by a bolt running on a pulley, on the outward end of the cylinder shaft. Each way from the feeding-rollers

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is placed rollers, about two feet apart, for the timber to rest on while running through. On one side of the frame is fastened a straight edge, to serve as a guide, lined with metal; on the other side, rollers are placed in a piece of timber, which is pressed up to the plank or board, to keep it close to the guide or straight edge, by a spring. The grooving and tonguing is done by burrs or circular cutters similar to a saw; these burrs are hung on perpendicular spindles, the arbors of which rest in boxes attached to the inward side of the frame, a burr on one side to cut the groove, and on the other is placed two burrs, just as far apart as the thickness of the above one, for cutting the groove. At or near one end of the frame is hung a shaft, with a drum or roller, from which belts pass over to pulleys on each spindle of the burrs or circular cutters, which must have about the same velocity of the cylinder. These burrs are placed on one side of the cylinder, opposite to each other, so as to cut the tongue to match the groove; on the other side of the cylinder is an arbor parallel with the cylinder, on which is placed circular cutters, for planing the edges of the board or plank as they pass through. The cutter on the side next to the guide is stationary on the arbor; the opposite one is movable in the arbor, but fastened with screws, to set it for different widths. A belt runs from a pulley on the end of the arbor, outside the frame, to the said drum, as also the same from the cylinder, each having about the same motion. The feeding-rollers are put in motion by a belt from the slow part of the driving power. I have also put in operation a carriage for feeding, but rollers save the time of running the carriage back.

"Now, what I, the said Uri Emmons, consider and claim as my improvement, and for which I solicit a patent, is as follows, namely:

"1st. The principle of planing boards and plank with a rotary motion, with knives or edges on a cylinder, placed on the same, straight or spiral, as before described, which I put in operation at Syracuse, in the county of Onondaga, in the State of New York, in the early part of the year 1824.

"2d. The burrs for grooving and tonguing, in contradistinction from the mode used by William Woodworth, he using the duck-bill cutters.

"3d. The feeding, by running the timber through on a carriage, or between feeding-rollers, guided by a straight edge, as before described.

"In testimony that the foregoing is a true specification of my said improvement, as before described, I have hereunto set my hand and

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seal, the eighth day of April, in the year of our Lord one thousand eight hundred and twenty-nine.

“(Signed,)

URI EMMONS..

“Witnesses: THOS. THOMAS, SILAS HATHAWAY.”

On the 16th of May, 1829, the said Emmons sold his entire interest in the last-mentioned patent to Daniel H. Toogood, Daniel Halstead, and William Tyack, by the following instrument:

*Deed from Emmons to Toogood, Halstead, and Tyack.*

“Whereas, Uri Emmons, of the State of New York, machinist, has received letters patent of the United States of America, dated April 25th, one thousand eight hundred and twenty-nine, [for] the full and exclusive right and liberty of making, constructing, using, and vending to others to be used a new and useful improvement in the mode of planing floor-plank, and grooving and tonguing and straightening the edges of the same, planing boards, straightening and planing square timber, &c., by machinery, at one operation, called the cylindrical planing-machine :

“Now, know all men by these presents, that I, Uri Emmons, of the city of New York, in consideration of five dollars to me in hand paid by Daniel H. Toogood, Daniel Halstead, and William Tyack, all of said city of New York, who fully viewed and considered the said improvement, and the said patent and specifications therein contained, have granted, sold, and conveyed, and by these presents do grant, sell, and convey, to the said Daniel H. Toogood, Daniel Halstead, and William Tyack, their heirs, executors, administrators, and assigns, the full and exclusive right and liberty derived from the said patent, of making, using, and vending to others to be made, used, and sold the said improvement, within and throughout the United States of America. To have and to hold and enjoy all the privileges and benefits which may in any way arise from the said improvement by virtue of said letters patent. And I do hereby empower the said Daniel H. Toogood, Daniel Halstead, and William Tyack, their heirs, executors, administrators, and assigns, to commence and prosecute to final judgment and execution, at their own cost, any suit or suits against any person or persons who shall make, use, or vend the said improvement, contrary to the intent of the said letters patent and law in such case made and provided, and to receive, for their own benefit, the avails thereof, in such manner as I might do. .

“In witness whereof, I have hereunto set my hand and seal, this

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sixteenth day of May, in the year of our Lord one thousand eight hundred and twenty-nine.

“URI EMMONS. [SEAL.]

“Witnesses: THOMAS AP THOMAS, ALEX. DEDDER.”

“*City and County of New York, ss.:*

“Be it remembered, that on the sixteenth day of May, in the year of our Lord one thousand eight hundred and twenty-nine, before me, personally appeared Uri Emmons, known to me to be the person described in and who executed the within deed, and acknowledged that he executed the same for the purposes therein mentioned; and there being no material alterations, erasures, or interlineations, I allow the same to be recorded.

“THOMAS THOMAS, *Commissioner, &c.*”

On the 28th of November, 1829, the following mutual deed of assignment was executed between Woodworth and Strong, on the one part, and Toogood, Halstead, Tyack, and Emmons, on the other part, by which Woodworth and Strong convey to Toogood, Halstead, and Tyack all their interest in the patent of December 27th, 1828, in the following places, namely: In the city and county of Albany, in the State of New York; in the State of Maryland, except the western part which lies west of the Blue Ridge; in Tennessee, Alabama, South Carolina, Georgia, the Floridas, Louisiana, Missouri, and the territory west of the Mississippi;—and Toogood, Halstead, Tyack, and Emmons conveyed to Strong and Woodworth all their interest in Emmons' patent of 25th April, 1829, for the rest and residue of the United States; by which mutual deed of assignment the parties agreed that any improvement in the machinery, or alteration or renewal of either patent, such improvement, alteration, or renewal should accrue to the benefit of the respective parties in interest, and might be applied and used within their respective districts.

*Mutual Deed between Woodworth, Strong, Toogood, Halstead, Tyack, and Emmons.*

“Know all men by these presents, that William Woodworth, now of the city of New York, the patentee of an improved method of planing, tonguing, grooving, &c., plank, boards, &c., by letters patent from the United States, dated December 29th, 1828, and James Strong, of the city of Hudson, in the State of New York, the assignee of one equal half of the rights and interests secured by the afore-said letters patent, of the one part, and Uri Emmons, of the city of New York, the patentee of an improvement in the mode of planing floor-plank, and grooving, tonguing, and straightening the edges of the same, &c., by letters patent from the United States, dated April

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25th, 1829, and Daniel H. Toogood, Daniel Halstead, and William Tyack, of the city of New York, the assignees, by deed dated the 16th day of May, 1829, of all the rights and interest secured by the last aforesaid patent to said Emmons, of the other part, in consideration of the following covenants and agreements, do hereby covenant and agree as follows:

"First. The said Woodworth and Strong, and their assigns, have, and hereby do assign to the said Toogood, Halstead, and Tyack, and their assigns, all their right and interest in the aforesaid patent to William Woodworth, to be sold and used, and the plank or other materials prepared thereby to be vended and used, in the following places, namely: In the city and county of Albany, in the State of New York; in the State of Maryland, except the western part thereof which lies west of the Blue Ridge; in Tennessee, Mississippi, Alabama, South Carolina, Georgia, the Floridas, Louisiana, and the territory west of the river Mississippi, and not in any other State or place within the limits of the United States or the Territories thereof. To have and to hold the rights and privileges hereby granted to them and their assigns for and during the term of fourteen years from the date of the patent. And they are also authorized to prosecute, at their own costs and charges, any violation of the said patent, in the same manner as the patentee, Woodworth, might lawfully do.

"Secondly. The said Emmons, Toogood, Halstead, and Tyack, in consideration aforesaid, have, and hereby do covenant and agree to assign, and do assign, for themselves and assigns, to the said Woodworth and Strong and their assigns, all their right and interest in the aforesaid patent granted to the said Uri Emmons, to be sold and used, and the plank or other material prepared thereby to be vended and used, in all and singular the rest and residue of the United States and the Territories thereof; that is to say, in all places other than in those especially assigned to the said Toogood, Halstead, and Tyack, as aforesaid. To have and to hold the said rights and privileges hereby granted to them and their assigns for and during the term of fourteen years from the date of the said letters patent to the said Uri Emmons. And they are also authorized to prosecute, at their own costs and charges, any violation of the said patent, in the same manner as the patentee, Uri Emmons, might lawfully do.

"Thirdly. And the two parties further agree, that any improvement in the machinery, or alteration or renewal of either patent, such alteration, improvement, or renewal shall accrue to the benefit of the respective parties in interest, and may be applied and used within their respective districts, as hereinbefore designated.

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"Witness our hands and seals, at the city of New York, the 28th of November, 1829.

"WILLIAM WOODWORTH. [SEAL.]

"JAMES STRONG. [SEAL.]

"WILLIAM TYACK. [SEAL.]

"D. H. TOOGOOD. [SEAL.]

"DANIEL HALSTEAD. [SEAL.]

"URI EMMONS. [SEAL.]

"Sealed and delivered in presence of THOMAS AP THOMAS, witness to the signing of Toogood, Tyack, Halstead, and Emmons."

Under this mutual assignment, the respective parties and their assignees would possess the following rights, namely: If they claimed under Woodworth's patent, to use the same for fourteen years from the 29th of December, 1828, that is to say, until the 29th of December, 1842; and if they claimed under Emmons' patent, to use the same for fourteen years from the 25th of April, 1829, that is to say, until the 25th of April, 1843.

On one or the other of these days, therefore, if things had remained in the same condition, all rights, either in the patentees or their assignees, would have ceased, as far as respected an exclusive use of the thing patented.

In 1836, Congress passed an act from which the following is an extract, and the construction of which was the chief controversy (Act approved July 4th, 1836, ch. 357, 5 Little & Brown's ed., 117, sec. 18): "And be it further enacted, that whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof; and the Commissioner shall, on the applicant's paying the sum of forty dollars to the credit of the treasury, as in the case of an original application for a patent, cause to be published, in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent, a notice of such application, and of the time and place when and where the same will be considered, that any person may appear and show cause why the extension should not be granted. And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them, both for and against the extension, and shall sit, for that purpose, at the time and place designated in the

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published notice thereof. The patentee shall furnish to the said board a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear, to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault upon his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the term,—which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interest therein: Provided, however, that no extension of a patent shall be granted after the expiration of the term for which it was originally issued."

On the 3d of February, 1839, William Woodworth, the patentee, died; and on the 14th of February, 1839, William W. Woodworth took out letters of administration upon his estate, in the county of New York.

In 1842, William W. Woodworth, the administrator, applied for an extension of the patent under the above-recited act of 1836, and on the 16th of November, 1842, the board issued the following certificate:

"In the matter of the application of William W. Woodworth, administrator of the estate of William Woodworth, deceased, in writing, to the Commissioner of Patents, for the extension of the patent for a new and useful improvement in the method of planing, tonguing, and grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances, granted to the said William Woodworth, deceased, on the 27th day of December, 1828, for fourteen years from said 27th day of December.

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“The applicant having paid into the treasury the sum of forty dollars, and having furnished to the undersigned a statement in writing, under oath, of the ascertained value of the invention, and of the receipts and expenditures thereon, sufficiently in detail to exhibit a true and faithful account of loss and profits in any manner accruing to said patentee from or by reason of said invention; and notice of application having been given by the Commissioner of Patents according to law, said board met at the time and place appointed, namely, at the Patent Office, on the 1st September, 1842, and their meetings having been continued by regular adjournments until this 16th day of November, 1842, they, on that day, heard the evidence produced before them, both for and against the extension of said patent, and do now certify, that, upon hearing of the matter, it appears, to their full and entire satisfaction, having due regard to the public interest therein, that it is just and proper that the term of the said patent should be extended, by reason of the patentee, without neglect on his part, having failed to obtain from the use and sale of his invention a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use.

“Washington city, Patent Office, November 16th, 1842.

DANIEL WEBSTER,

*Secretary of State.*

CHAS. B. PENROSE,

*Solicitor of the Treasury.*

HENRY L. ELLSWORTH,

*Commissioner of Patents.”*

And on the same day the Commissioner of Patents issued the following certificate:

“Whereas, upon the petition of William W. Woodworth, administrator of the estate of William Woodworth, deceased, for an extension of the within patent, granted to William Woodworth, deceased, on the 27th day of December, 1828, the Board of Commissioners, under the eighteenth section of the act of Congress approved the 4th day of July, 1836, entitled ‘An act to promote the progress of useful arts, to repeal all acts and parts of acts heretofore made for that purpose,’ did, on the 16th day of November, 1842, certify that the said patent ought to be extended:

“Now, therefore, I, Henry L. Ellsworth, Commissioner of Patents, by virtue of the power vested in me by said eighteenth section, do renew and extend said patent, and certify that the same is hereby extended for the term of seven years from and after the expiration



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of the first term, namely, the 27th day of December, 1842, which certificate of said Board of Commissioners, together with this certificate of the Commissioner of Patents, having been duly entered of record in the Patent Office, the said patent now has the same effect in law as though the term had been originally granted for the term of twenty-one years.

"In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed, this 16th day of November, 1842.

[SEAL.]

"HENRY L. ELLSWORTH,

*"Commissioner of Patents."*

On the 2d of January, 1843, William W. Woodworth, the administrator, filed the following disclaimer:

"To all men to whom these presents shall come: I, William W. Woodworth, of Hyde Park, in the county of Dutchess, and State of New York, Esq., as I am administrator of the goods and estate which were of William Woodworth, deceased, hereinafter named, send greeting:

"Whereas letters patent, bearing date on the twenty-seventh day of December, in the year of our Lord eighteen hundred and twenty-eight, were granted by the United States to Wm. Woodworth, now deceased, for an improvement in the method of planing, tonguing, grooving, and cutting into mouldings, or either boards, plank, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on or facing metallic, mineral, or other substances; and whereas, before the term of fourteen years, for which the said letters patent were granted, had fully expired, such proceedings were had that, pursuant to the act of Congress in such case made and provided, the said letters patent were renewed or extended for the term of seven years from and after the expiration of the said term of fourteen years, and to the certificate granting the said extension and renewal unto me, in my said capacity, bearing date on the sixteenth day of November now last past, and which is duly recorded according to act of Congress in that behalf, reference is hereby made, as showing my title and interest in and to the said letters patent;

"And whereas the said William Woodworth, through inadvertence, accident, or mistake in his application for letters patent, made his specification of claim too broad, in this, namely, that he, the said William Woodworth, claimed as his improved method the application of circular saws for reducing floor-plank and other material to width, of which he was not the original and first inventor; and

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whereas some material and substantial part of the said patented thing was justly and truly the invention and improvement of the said William Woodworth:

"Now, therefore, know ye, that I, the said William W. Woodworth, in my capacity aforesaid, and as the person to whom the said certificate was granted as aforesaid, have disclaimed, and do by these presents, for myself and for all claiming under me, disclaim, all and any exclusive right, title, property, or interest of, in, or to the application of circular saws for reducing floor-plank or other materials to a width, by reason of the aforesaid letters patent, and the aforesaid renewal or extension thereof.

"In testimony whereof, I have hereto, in my capacity aforesaid, set my hand and seal, on this second day of January, in the year eighteen hundred and forty-three.

[SEAL.]

"WILLIAM W. WOODWORTH,  
Administrator of W. Woodworth, deceased.

"Executed in presence of CHAS. W. EMESN, B. R. CURTIS."

In March, 1843, Woodworth, the administrator, made an assignment of his patent-rights in some of the States to James G. Wilson, the plaintiff. At what time the assignment was made for New York, the record in that case did not state; but it was one of the admitted facts that he was the grantee. The assignment first referred to was recorded in the Patent Office, in Liber 4, pages 291, 292, on the 20th of March, 1843.

On the 9th of August, 1843, the administrator assigned his right to Wilson in and for the State of Maryland.

On the 26th of February, 1845, Congress passed the following act:

*"An Act to extend a Patent heretofore granted to William Woodworth.*

"Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the patent granted to William Woodworth on the twenty-seventh day of December, in the year one thousand eight hundred and twenty-eight, for his improvement on the method of planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings on and facing several other substances, a description of which is given in a schedule annexed to the letters patent granted as aforesaid, be, and the same is hereby, extended for the term of seven years from and after the 27th day of December, in the year one thousand eight hundred and forty-nine; and the Commissioner of Patents is hereby directed

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to make a certificate of such extension, in the name of the administrator of the said William Woodworth, and to append an authenticated copy thereof to the original letters patent, whenever the same shall be requested by the said administrator or his assigns.

“Approved February 26, 1845.

“A true copy from the roll of this office.

“R. K. CRALLE, *Chief Clerk.*

“*Department of State, March 3, 1845.*”

And on the 3d of March, 1845, the following certificate was issued:

“In conformity, therefore, with the directions in the said act contained, I, Henry L. Ellsworth, Commissioner of Patents, do hereby certify that the patent therein described is, by the said act, extended to William W. Woodworth, administrator of said William Woodworth, for the term of seven years from and after the twenty-seventh day of December, in the year one thousand eight hundred and forty-nine; and this certificate of such extension is made on the original letters patent, on the application of William W. Woodworth, the administrator of the said William Woodworth.

“In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed, this 3d day of March, 1845.

[SEAL.]

“HENRY L. ELLSWORTH,

“*Commissioner of Patents.*”

On the 8th of July, 1845, a new patent was issued, with an amended specification, as follows:

“The United States of America to all to whom these letters patent shall come:

“Whereas, William W. Woodworth, administrator of William Woodworth, deceased, of Hyde Park, N. Y., has alleged that said William Woodworth invented a new and useful improvement in machines for planing, tonguing, and grooving and dressing boards, &c., for which letters patent were granted, dated the 27th day of December, 1828, which letters patent have been extended (as will appear by the certificates appended thereto, copies of which are hereunto attached) for fourteen years from the expiration of said letters patent; and which letters patent are hereby cancelled, on account of a defective specification, which he states has not been known or used before said William Woodworth's application; has made oath that he is, and that said William Woodworth was, a citizen of the United States; that he does verily believe that said William Woodworth was the original and first inventor or discoverer of the said improvement, and that the

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same hath not, to the best of his knowledge and belief, been previously known or used; has paid into the treasury of the United States the sum of fifteen dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose:

"These are, therefore, to grant, according to law, to the said William W. Woodworth, in trust for the heirs at law of said W. Woodworth, their heirs, administrators, or assigns, for the term of twenty-eight years from the twenty-seventh day of December, one thousand eight hundred and twenty-eight, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said William W. Woodworth, in the schedule hereunto annexed, and is made part of these presents.

"In testimony whereof, I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed.

"Given under my hand, at the city of Washington, this eighth day of July, in the year of our Lord one thousand eight hundred and forty-five, and of the independence of the United States of America the seventieth.

[SEAL.]

"JAMES BUCHANAN,

*Secretary of State."*

"Countersigned, and sealed with the seal of the Patent Office.

"HENRY H. SYLVESTER,

*Acting Commissioner of Patents."*

"The schedule referred to in these letters patent, and making part of the same:

"To all whom it may concern: Be it known that the following is a full, clear, and exact description of the method of planing, tonguing, and grooving plank or boards, invented by William Woodworth, deceased, and for which letters patent of the United States were granted to him on the 27th day of December, in the year one thousand eight hundred and twenty-eight, the said letters patent having been surrendered for the purpose of describing the same invention, and pointing out in what it consists, in more clear, full, and exact terms than was done in the original specification.

*"Amended Specification.*

"The plank or boards which are to be planed, tongued, or grooved are first to be reduced to a width, by means of circular saws, by reducing-wheels, or by any other means. When circular saws are used

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for this purpose, two such saws should be placed upon the same shaft, on which they are to be capable of adjustment, so that they may be made to stand at any required distance apart; under these, the board or plank is to be forced forward, and brought to the width required. This apparatus and process do not require to be further explained, they being well understood by mechanics.

“When what has been above denominated reducing-wheels are used, these are to consist of revolving cutting-wheels, which resemble in their construction and action the planing and reducing wheel to be presently described; these are to be made adjustable, like the circular saws, but the latter are preferred for this purpose. The plank may be reduced to a width on a separate machine.

“When the plank or boards have been thus prepared, (on a separate machine,) they may be placed on or against a suitable carriage, resting on a frame or platform, so as to be acted upon by a rotary cutting or planing and reducing wheel, which wheel may be made to revolve either horizontally or vertically, as may be preferred. The carriage which sustains the plank or board to be operated upon may be moved forwards, by means of a rack and pinion, by an endless chain or band, by geared friction-rollers, or by any of the devices well known to machinists for advancing a carriage, or materials to be acted upon, in machines for various purposes. The plank or board is to be moved on towards the cutting edges of the cutters or knives on the planing-cylinder, so that its knives or cutters, as they revolve, may meet and cut the plank or board in a direction contrary to that in which it is made to advance; the edges of the cutters are, in this method, prevented from coming first into contact with its surface, and are made to cut upwards from the reduced part of the plank towards said surface, by which means their edges are protected from injury by gritty matter, and the board or plank is more evenly and better planed than when moved in the reversed direction.

“After the board or plank passes the planing-cylinder, and as soon or fast as the planing-cylinder has done its work on any part of the board or plank, the edges are brought into contact with two revolving cutter-wheels, one of which wheels is adapted to the cutting of the groove, and the other to the cutting of the two rebates that form the tongue. When the axis of the planing and reducing wheel stands vertically, the grooving and tonguing wheels are placed one above the other, with the plank edgewise between them. When the axis of the planing-wheel stands horizontally, these wheels are on the same horizontal plane with each other, standing on perpendicular spindles.

“The grooving-wheel consists of a circular plate fixed on an axis,

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and having one, two, three, four, or more cutters, which are to be screwed, bolted, or otherwise attached to it, the edges of which cutters project beyond the periphery of the plate to such distance as is required for the depth of the groove. Their thickness may be such as is necessary for its width. They are, of course, so situated as to cut the groove in the middle of the edge of the board, or as nearly so as may be required. The tonguing-wheel is similar in form to the grooving-wheel, but it has cutters on each of its sides, or otherwise so formed and arranged as to cut the two rebates which are necessary to the formation of the tongue.

“The grooving and tonguing cutters, at the same time, and by the same operation, reduce the board or plank to an exact width throughout. When the axis of the planing-wheel is placed vertically, the knives or cutters may be made to plane two planks at the same time, the planks being in this case moved in contrary directions, and so as to meet the edges of the revolving knives or cutters. When the machine is thus constructed, a second pair of grooving and tonguing wheels may be made to operate in the same way with those above described. A machine to operate upon a single plank or board, and having the axis of the planing-wheel placed horizontally, will, however, be more simple and less expensive than that intended to operate on two planks simultaneously.

“In the accompanying drawing, fig. 1 is a perspective representation of the principal operating parts of the machine, when arranged and combined for planing, tonguing, and grooving, and when so arranged as to be capable of planing two planks at the same time, the axis of the planing-wheel being placed vertically. A A is a stout, substantial frame of the machine, which may be of wood or iron, and may be varied in length, size, and strength, according to the work to be done. B B are the heads of the planing-cylinder, and C C the knives or cutters, which extend from one to the other of said heads, to the peripheries of which they may be attached, by means of screws. The knives, C C, with the faces forming a planing angle, may be placed in a line with the axis, J, of the cylinder, or they may stand obliquely thereto, as may be preferred; but in the latter case the edge should form the segment or portion of a helix; *b* represents a pulley near to the upper end of the axis, J; and I, a pulley, or drum, which may be made to revolve by horse, steam, or other motive power, and from which a belt may extend around the pulley, *b*, to drive the planing-cylinder and other parts of the machinery. G is the carriage which is represented as being driven forward by means of a rack and pinion, H; against this carriage, the plank, K, which is to be planed, tongued,

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and grooved, is placed, and is made to advance with it. It will be manifest, however, that the plank may be moved forward by other means, as, for example, by an endless chain or band passing around drums or chain-wheels, or by means of geared friction-wheels borne up against it. To cause the carriage and plank to move forward readily, there may be friction-rollers, *f f f*, placed horizontally, and extending under them; the rollers, *f f f*, which stand vertically, are to be made to press against the plank and keep it close to the carriage, and thus prevent the action of the cutters from drawing the plank up from its bed, in cutting from the planed surface upwards; they may be borne against it by means of weights or springs, in a manner well known to machinists. In a single horizontal machine, the horizontal friction-rollers may be geared, and the pressure-rollers placed above them, to feed the board, with or without the carriages, a bed-plate being used directly under the planing-cylinder.

"Fig. 2 is a separate view of the planing-cylinder, with its knives or cutters, and fig. 3 an end view of one of the heads. *E E* are the revolving cutters, or tonguing and grooving wheels, and *D D* whirls upon their shafts, which may be driven by bands, or otherwise, so as to cause said wheels to revolve in the proper direction.

"Fig. 4 is a side view of one of these wheels; fig. 5 is an edge view of the tonguing-wheel; and fig. 6 an edge view of the grooving-wheel, the latter being each shown with two cutters in place. The number of cutters on these wheels may be varied, but they are represented and furnished with four. The cutters may be fixed on the sides of circular plates, with their edges projecting beyond the periphery of said plate.

"The edges of the plank, as its planed part passes the planing-cylinder, are brought in contact with the above-described tonguing and grooving wheels, which are so placed upon their shafts as that the tongue and groove shall be left at the proper distance from the face of the plank, the latter being sustained against the planing-cylinder by means of the carriage or bed-plate, or otherwise, so that it cannot deviate, but must be reduced to a proper thickness, and correctly tongued and grooved.

"In fig. 1, above referred to, only one carriage and one pair of cutter-wheels are shown, it not being deemed necessary to represent those on the opposite side, they being similar in all respects.

"Fig. 7 represents the same machine, with the axis of the planing-cylinder placed horizontally, and intended to operate on one plank only at the same time. *A A* is the frame; *B B*, the heads of the planing-cylinder; *C C*, the knives or cutters attached to said heads. To

meet the different thicknesses of the planks or boards, the bearings of the shaft or cylinder may be made movable, by screws or other means, to adjust it to the work; or the carriage or bed-plate may be made so as to raise the board or plank up to the planing-cylinder. E and E' are the revolving cutters, or tonguing and grooving wheels, which are placed upon vertical shafts, having upon them pulleys, D D, around which pass belts or bands from the main drum, I, to which a revolving motion may be given by any adequate motive power.

"From the drum, I, a belt, L, passes also around the pulley, b, on the shaft of the planing-cylinder, and gives to it the requisite motion. There may, in this machine, be a horizontal carriage, moved forward by a rack and pinion, in a manner analogous to that represented in fig. 1; but, in the present instance, the plank is supposed to be advanced by means of one or two pairs of friction or feed rollers, shown at *f f'*; the uppermost, *f' f'*, of the pairs of rollers may be held down by springs or weighted levers, which it has not been thought necessary to show in this drawing, as such are in common use. The lowermost of these rollers may be fluted, or made rough on their surfaces, so as to cause friction on the under side of the plank. M M' are pulleys on the axles of these lower rollers, which are embraced by bands, N N', which also pass around a pulley, O, on a shaft which crosses the frame, A A, and has a pulley, T, on it, which is embraced by the belt, P, on a pulley, Q, on the shaft of the main drum, I. These bands and pulleys serve to give motion to the feed-rollers, as will be readily understood by inspecting the drawing. R R are guide-strips, used in place of the rollers used for the same purpose, and also for bearing or friction rollers, when the machine is vertical, to direct one edge of the plank, and against its opposite edge. Any pressure may be used, equal to the weight of the board or plank, when worked in a vertical position. One of the cutter-wheels should be made adjustable, to adapt it to stuff of different widths.

"The planing-cylinder, and, likewise, the cutter, or tonguing and grooving wheels, may be constructed in the manner represented in figures 2, 3, 4, 5, and 6, and hereinbefore fully described. One of the heads of the planing-wheel may be made movable, to accommodate its width to the width of the boards or plank to be planed.

"The respective parts of this machine may be varied in size, as may also the velocity of the motion of the planing-cylinders and cutter-wheels; but the following has been found to answer well in practice: The planing-cylinder, having four knives or cutters, may be twelve inches in diameter, and may make two thousand and upwards revolutions in a minute. In a machine like that shown in fig. 7, the



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main drum, I, may be two feet in diameter, and may be driven with the speed of five hundred and upwards revolutions in a minute. The pulleys on the planing-cylinder, and on the cutter-wheels, may be six inches in diameter. The plank should be moved forward at the rate of about one foot for every hundred revolutions of the cutter-wheel; and, of course, the diameter of the feed-rollers, and of the pulleys by which they are turned, must be so graduated as to produce this result. The size and speed of the above parts of this machine may be, in some degree, varied; but the above have been found to work well.

“Having thus fully described the parts, and combination of parts, and operation of the machine for planing, tonguing, and grooving boards or plank, and shown various modes in which the same may be constructed and made to operate, without changing the principle or mode of operation of the machine, what is claimed therein as the invention of William Woodworth, deceased, is the employment of rotating planes, substantially such as herein described, in combination with the rollers, or any analogous device, to prevent the boards from being drawn up by the planes, when cutting upwards, or from the reduced or planed to the unplanned surface, as described.

“And, also, the combination of the rotating planes with the cutter-wheels for tonguing and grooving, for the purpose of planing, tonguing, and grooving boards, &c., at one operation, as described. And, also, the combination of the tonguing and grooving cutter wheels for tonguing and grooving boards, and at one operation, as described.

“And, finally, the combination of either the tonguing or the grooving cutter-wheel for tonguing or grooving boards, &c., with the pressure-rollers, as described, the effect of the pressure-rollers in these operations being such as to keep the boards, &c., steady, and prevent the cutters from drawing the boards towards the center of the cutter-wheels, whilst it is moved through by machinery. In the planing operation, the tendency of the plane is to lift the boards directly up against the rollers; but in the tonguing and grooving, the tendency is to overcome the friction occasioned by the pressure of the rollers.

“WILLIAM W. WOODWORTH,

*“Administrator of William Woodworth, deceased.”*

“Witnesses: JAMES MILHOLLAND, CHAS. M. KELLER.”

The above papers show the title of the administrator, who was the grantor of Wilson, the plaintiff in the suit. The record in the New York case was exceedingly brief, and contained neither the declara-

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tion nor pleas, but only the state of the pleadings and the existence of demurrers. But from the eighth fact in the statement of facts, in which it is said that "the defendants trace no title to themselves to a right to use said machines from the assignment made by William Woodworth and James Strong to Halstead, Toogood, and Tyack," the inference must be, that their defense was in showing an outstanding title.

The following is the entire case presented by the New York record:

*"United States of America, Northern District of New York:*

"At a Circuit Court of the United States, begun and held at Albany, for the Northern District of New York, on Tuesday, the twenty-first day of October, in the year of our Lord one thousand eight hundred and forty-five, and in the seventieth year of American independence—

"Present: Hon. Samuel Nelson and Hon. Alfred Conkling.

"JAMES G. WILSON

v.

LEWIS ROUSSEAU AND CHARLES EASTON. }

*"State of the Pleadings.*

"This is an action on the case to recover damages for the alleged infringement of letters patent issued to William Woodworth, on the 27th day of December, 1828, for the term of fourteen years, for an improvement in machinery for planing, tonguing, and grooving boards and plank at one operation, which letters patent were, on the 16th day of November, 1842, extended for seven years more, such extension being granted to William W. Woodworth, as administrator of said William Woodworth.

"To the first count of the plaintiff's declaration, the defendants interposed three several special pleas in bar, to each of which pleas the plaintiff demurred, and the defendants joined in demurrer. To the second count of the plaintiff's declaration, the defendants demurred, and the plaintiff joined in demurrer.

"The case coming on to be argued at this term, the following questions occurred for decisions, to wit:

"1. Whether the eighteenth section of the Patent Act of 1836 authorized the extension of a patent, on the application of the executor or administrator of a deceased patentee.

"2. Whether, by force and operation of the eighteenth section of the act of July 4, 1836, entitled 'An act to promote the progress of the useful arts,' &c., the extension granted to William W. Woodworth, as administrator, on the 16th day of November, 1842, inured

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to the benefit of assignees under the original patent granted to William Woodworth, on the 27th day of December, 1828, or whether said extension inured to the benefit of the administrator only, in his said capacity.

“3. Whether the extension specified in the foregoing second point inured to the benefit of the administrator, to whom the same was granted, and to him in that capacity exclusively, or whether, as to the territory specified in the contract of assignment made by William Woodworth and James Strong to Toogood, Halstead, and Tyack, on the 28th day of November, 1829, (and set forth in the second plea of the defendants to the first count of the declaration,) and by legal operation of the covenants contained in said contract, the said extension inured to the benefit of the said Toogood, Halstead, and Tyack, or their assigns.

“4. Whether the plaintiff, claiming title under the extension from the administrator, can maintain an action for an infringement of the patent-right within the territory specified in the contract of assignment to Toogood, Halstead, and Tyack, against any person not claiming under said assignment, or whether the said assignment be, of itself, a perfect bar to the plaintiff's suit.

“5. Whether the extension specified in the second point could be applied for and obtained by William W. Woodworth, as administrator of William Woodworth, deceased, if the said William Woodworth, the original patentee, had, in his lifetime, disposed of all his interest in the then existing patent, having, at the time of his death, no right or title to, or interest in, the said original patent, or whether such sale carried with it nothing beyond the term of said original patent; and if it did not, whether any contingent rights remained in the patentee, or his representatives.

“6. Whether the plaintiff, if he be an assignee of an exclusive right to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within said town, or whether, to maintain such action, the plaintiff must be possessed, as to that territory, of all the rights of the original patentee.

“7. Whether the letters patent of renewal, issued to William W. Woodworth, as administrator aforesaid, on the 8th day of July, 1845, upon the amended specification and explanatory drawings then filed, be good and valid in law, or whether the same be void for uncertainty, ambiguity, or multiplicity of claim, or any other cause.

“8. Whether the court can determine, as matter of law, upon an inspection of the said two patents and their respective specifications,

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that the said new patent of the 8th of July, 1845, is not for the same invention for which the said patent of 1828 was granted.

"9. Whether the decision of the Board of Commissioners who are to determine upon the application for the extension of a patent, under the eighteenth section of the act of 1836, is conclusive upon the question of their jurisdiction to act in the given case.

"10. Whether the Commissioner of Patents can lawfully receive a surrender of letters patent for a defective specification, and issue new letters patent upon an amended specification, after the expiration of the term for which the original patent was granted, and pending the existence of an extended term of seven years, or whether such surrender and renewal may be made at any time during such extended term.

"On which questions the opinions of the judges were opposed.

"Whereupon, on a motion of the plaintiff, by William H. Seward, his counsel, that the points on which the disagreement hath happened may, during the term, be stated under the direction of the judges, and certified under the seal of the court to the Supreme Court, to be finally decided—

"It is ordered that the foregoing state of the pleadings, and the following statement of facts, which is made under the direction of the judges, be certified, according to the request of the plaintiff, by his counsel, and the law in that case made and provided, to wit:

"1. That William Woodworth, as the inventor of a machine, or improvement in machinery, for planing, tonguing, and grooving boards and plank at one operation, on the 27th day of December, in the year 1828, applied to the proper department of the government for a patent for said invention, and upon the same day, on filing his specifications and explanatory drawings, and complying with the other legal prerequisites, letters patent, signed by the President, and under the seal of the United States, were duly issued to the said William Woodworth, granting to him the exclusive right throughout the United States to construct and use, and vend to others to be used, the machine or improvement patented, for and during the term of fourteen years from the said 27th day of December, 1828.

"2. That subsequently, to wit, on the 28th day of November, 1829, the said William Woodworth and James Strong, who had become jointly interested with said Woodworth in the rights secured by the said letters patent, by contract of assignment of that date, transferred to Daniel H. Toogood, Daniel Halstead, and William Tyack all their right and interest in and to the said patent for certain parts and portions of the United States, in said contract specifically set forth, inclu-

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ding the city and county of Albany, in the State of New York, which is the domicile of the defendants.

"3. That the *habendum* in said contract of assignment is in the words following, to wit:

"'To have and to hold the rights and privileges hereby granted for and during the term of fourteen years from the date of the patent.'

"And that the third clause in said contract of assignment is in the following words, to wit:

"'And the two parties further agree, that any improvement in the machinery, or alteration or renewal of either patent, such improvement, alteration, or renewal shall inure to the benefit of the respective parties interested, and may be applied and used within their respective districts, as hereinbefore designated.'

"4. That previous to the expiration of the fourteen years' limitation of said patent, William Woodworth, the patentee, died, to wit, on the 9th day of February, 1839; that William W. Woodworth was thereupon duly appointed, and now is, administrator of the estate of the said William Woodworth, and that the said Woodworth, in his lifetime, had sold all his interest in the said original patent.

"5. That William W. Woodworth, as administrator aforesaid, on the 16th day of November, 1842, under the eighteenth section of the act of Congress of July 4th, 1836, applied to the Board of Commissioners created by the said section for an extension of said patent; and that, upon complying with the requisites in said section prescribed, an extension of said patent was granted by said board to William W. Woodworth, as administrator of the estate of William Woodworth, on said 16th day of November, 1842, and letters patent of extension were on said day duly issued to him, granting to him, in his aforesaid capacity, the exclusive right to make and use, and vend to others to be used, the said invention or improvement, for the term of seven years from and after the term of limitation of said original patent.

"6. That on the 8th day of July, 1845, the said William W. Woodworth, in his capacity as administrator aforesaid, and in accordance with the provisions of the thirteenth section of the said act of July 4th, 1836, made a surrender to the Commissioner of Patents of the letters patent to him granted on the 16th day of November, 1842, for an insufficiency of the specification upon which the said original patent was issued, and upon filing a corrected and amended specification, with explanatory drawings, a copy of which is annexed hereto and made a part of this statement, the said Commissioner, on the said 8th day of July, 1845, issued to the said William W. Woodworth new letters patent of said invention for the unexpired term of the first extension

thereof, and of the extension granted by special act of Congress on the 26th day of February, 1845.

"7. That the defendants in this action have erected and put in operation, in the town of Watervliet, which is within the county of Albany and State of New York, one or more machines for planing, tonguing, and grooving boards and plank, substantially the same in principle and mode of operation as that the subject of the patent granted to William Woodworth.

"8. That the defendants trace no title to themselves, to a right to use said machines, from the assignment made by William Woodworth and James Strong to Halstead, Toogood, and Tyack.

"9. That the plaintiff in this action is the grantee of William W. Woodworth, as administrator, of the exclusive right to construct and use, and vend to others to be used, two of said patented machines within the said town of Watervliet, in said county of Albany and State of New York."

The case was argued by *Mr. Seward*, *Mr. Latrobe*, and *Mr. Webster*, (the latter two dividing the points,) on behalf of the plaintiff, and *Mr. Stevens*, for the defendants. The reporter has been kindly furnished with the arguments of these gentlemen, but his limits will not permit their publication *in extenso*, and he is unwilling to take the responsibility of condensing them.

Mr. Justice NELSON delivered the opinion of the court.

The questions in this case come before us on a certificate of division of opinion from the Circuit Court of the United States for the Northern District of New York, involving the construction of various provisions of the act of Congress to promote the progress of useful arts, commonly called the Patent Act. We shall examine the questions in the order in which they appear on the record. The first is as follows:

1. Whether the eighteenth section of the act of 1836 authorized the extension of a patent on the application of the executor or administrator of a deceased patentee.

The eighteenth section provides, in substance, that whenever any patentee of an invention or discovery shall desire an extension of his patent beyond the term of its limitation, he may make application therefor, in writing, to the Commissioner of the Patent Office, setting forth the grounds thereof. That the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the application. The pat-

entee shall furnish to the board a statement in writing, under oath, of the value and usefulness of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of the invention; and if, upon a hearing of the matter, it shall appear, to the satisfaction of the board, having a due regard to the public interest, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension for the term of seven years from and after the expiration of the first term, &c.

This is the substance of the section, so far as is material to the consideration of the question; and it will be seen, that, according to the words of the provision, the application is to be made by, and the new term to be granted to, the patentee himself; and hence the objection on account of its having been granted to the administrator.

The main argument relied on to support the objection is, that the patentee had no interest or right of property in the extended term at the time of his death. That all he had was a mere possibility, too remote and contingent to be regarded as property, or any right of property, in the sense of the law, and therefore not assets or rights in the hands of the administrator which would authorize an application within the meaning of the statute.

At common law, the better opinion probably is, that the right of property of the inventor to his invention or discovery passed from him as soon as it went into public use with his consent. It was then regarded as having been dedicated to the public, as common property, and subject to the common use and enjoyment of all.

The act of Congress for the encouragement of inventors, and to promote the progress of the useful arts, and for the purpose of remedying the imperfect protection, or rather want of protection, of this species of property, has secured to him, for a limited term, the full and exclusive enjoyment of his discovery.

The law has thus impressed upon it all the qualities and characteristics of property, for the specified period; and has enabled him to hold and deal with it the same as in case of any other description of property belonging to him, and on his death it passes, with the rest of his personal estate, to his legal representatives, and becomes part of the assets.

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Congress have not only secured to the inventor this absolute and indefeasible interest and property in the subject of the invention for the fourteen years, but have also agreed, that upon certain conditions occurring, and to be shown, before the expiration of this period, to the satisfaction of a Board of Commissioners, an indifferent tribunal designated for the purpose, this right of property in the invention shall be continued for the further term of seven years. Subject to this condition, the right of property in the second term is as perfect, to the extent of the intent, as the right of property in the first.

The circumstances upon which the condition rests, and the occurrence of which gives effect and operation to the further grant of the government, are by no means uncommon or difficult to be shown. They have often happened to inventors, in the course of their dealings with this species of property. The act of Congress contemplates their occurrence again, and has therefore provided further security and protection, by enlarging the interest and right of property in the subject of their invention.

The provision is founded upon the policy of the government, to encourage genius and promote the progress of the useful arts, by holding out an additional inducement to the enjoyment of the right secured under the first term, and as an act of justice to the inventors for the time, ingenuity, and expense bestowed in bringing out the discovery, frequently of incalculable value to the business interests of the country. And it is apparent, therefore, unless the executor or administrator is permitted to take the place of the patentee in case of his death, and make application for the grant of the second term, which continues the exclusive enjoyment of the right of property in the invention, the object of the statute will be defeated, and a valuable right of property, intended to be secured, lost to his estate.

The statute is not founded upon the idea of conferring a mere personal reward and gratuity upon the individual, as a mark of distinction for a great public service, which would terminate with his death, but of awarding to him an enlarged interest and right of property in the invention itself, with a view to secure to him, with greater certainty, a fair and reasonable remuneration. And to the extent of this further right of property, thus secured, whatever that may be, it is of the same description and character as that held and enjoyed under the patent for the first term. In its nature, therefore, it continues, and is to be dealt with, after the decease of the patentee, the same as an interest under the first, and passes, with other rights of property belonging to him, to the personal representatives, as part of the effects of the estate.



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It would seem, therefore, from the nature of this interest in an extended term itself, as well as from a consideration of the object and purpose of the statute, plainly expressed upon its face, in providing for the prolonged enjoyment and protection of this species of property, that the Board of Commissioners were well warranted in making the renewed grant to the administrator, upon his complying with the conditions.

An argument has been urged against this conclusion, grounded upon the tenth and thirteenth sections of the Patent Law. The former provides in express terms for the issuing of a patent to the executor or administrator, in case of the death of the inventor before it is taken out; and the latter, for the surrender of a patent defective by reason of an insufficient description, and the reissuing of a new one. These are supposed to be analogous cases, and manifest the sense of Congress, that, without the express provisions of law, the patent in the one case, and the surrender in the other, could not be issued to or be made by the legal representative. The argument is no doubt a proper one, and entitled to consideration; but it is not necessarily conclusive.

As it respects the provision for a surrender by the executor or administrator, which is most analogous to the question in hand, we think there could be no great doubt that the right would exist in the absence of any such express authority, regard being had to the nature of the property, and the rights and duties of the legal representative, within the spirit and object of the Patent Law. It would be the surrender of a patent, the legal interest and property in which had become vested in him as part of the assets, which he was bound to take care of and protect against waste. A step necessary to perfect the title and give value to the property, would seem to be not only directly within the line of his duty, but in furtherance of the chief object of the law, namely, to secure remuneration to the meritorious inventor.

It has also been argued, that the executor or administrator could not comply with the terms and conditions of the eighteenth section, upon which the right of property in the extended term is made to depend. In other words, that he would be unable to furnish to the Board of Commissioners a statement, under oath, of the usefulness of the invention, and of the receipts and expenditures of the patentee, exhibiting a true and faithful account of the loss and profit in any manner accruing from and by reason of the invention. This argument assumes, as a matter of fact, that which may well be denied. Suppose the dealings of the patentee in the subject of his discovery have been carried on through the instrumentality of agents or

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clerks, or, if not, that the patentee himself, as business men usually do, has kept an accurate account of his receipts and expenditures, all difficulty at once disappears. The account-books of a deceased party, in many of the States of the Union, identified, and the handwriting proved, are received as legal evidence of the demand in the courts of justice, and afford full authority, upon legal principles, for the admission of the books before the board, in support of the application. We perceive no great difficulty in a substantial compliance with the terms of the section on the part of the executor or administrator.

The second question is, whether, by force and operation of the eighteenth section, already referred to, the extension granted to W. W. Woodworth, as administrator, on the 16th day of November, 1842, inured to the benefit of assignees under the original patent granted to William Woodworth, on the 27th day of December, 1828, or whether said extension inured to the benefit of the administrator only, in his said capacity.

The most of this section has already been recited in the consideration of the first question, and it will be unnecessary to repeat it. It provides for the application of the patentee to the commission for an extension of the patent for seven years; constitutes a board to hear and decide upon the application; and if his receipts and expenditures, showing the loss and profits accruing to him from and on account of his invention, shall establish, to the satisfaction of the board, that the patent should be extended, by reason of the patentee, without any fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for his time, ingenuity, and expense bestowed upon the same, and the introduction of it into use, it shall be the duty of the Commissioners to extend the same, by making a certificate thereon of such extension for the term of seven years from and after the first term; "and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years." And then comes the clause in question: "*And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein.*"

The answer to the second question certified, depends upon the true construction of the above clause, respecting the rights of assignees and grantees.

Various and conflicting interpretations have been given to it by the learned counsel, on the argument, leading to different and opposite results, which it will be necessary to examine.

On one side, it has been strongly argued, that the legal operation

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and effect of the clause save and protect all the rights and interests of assignees and grantees in the patent existing at the time of the extension; and thus secure and continue the exclusive use and enjoyment of these rights and interests for the seven years, to the same extent, and in as ample a manner, as held and enjoyed under the first term. That if A holds an assignment of a moiety of the patent, he will hold the same for the new term of seven years; if of the whole patent, then the whole interest for that period; and that as soon as the new grant is made to the patentee the interest therein passes, by operation of this clause, to the assignees of the old term, in proportion to their respective shares.

On the other side, it has been argued, with equal earnestness, that, according to the true construction and legal effect of the clause, protection is given, and intended to be given, only to the rights and interests of assignees and grantees acquired and held by assignments and grants from the patentee in and under the second or new term; and that it does not refer to or embrace, or in any way affect, the rights and interests of assignees or grantees holding under the old.

In connection with this view, it is said that the rights thus protected in the new term may be acquired by means of the legal operation of the clause, either from a direct assignment or grant after the extension of the patent, or by an appropriate provision for that purpose, looking to an extension, contained in the assignment or grant under the old.

It is not to be denied, but that, upon any view that has been taken or that may be taken of the clause, its true meaning and legal effect cannot be asserted with entire confidence; and, after all, must depend upon such construction as the court can best give to doubtful phraseology and obscure legislation, having a due regard to the great object and intent of Congress, as collected from the context and general provisions and policy of the Patent Law.

The rule is familiar and well settled, that, in case of obscure and doubtful words of phraseology, the intention of the law-makers is to be resorted to, if discoverable from the context, in order to fix and control their meaning, so as to reconcile it, if possible, with the general policy of the law.

Now, the serious difficulty in the way, and which renders the first interpretation inadmissible, except upon the most explicit and positive words, is, that it subverts at once the whole object and purpose of the enactment, as is plainly written in every line of the previous part of the section. It gives the assignees and grantees of the patent, as far as assigned under the old term, the exclusive right and enjoyment of

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the invention—the monopoly—in the extended term for the seven years; when, by the same provision, it clearly appears that it was intended to be secured to the patentee, as an additional remuneration for his time, ingenuity, and expense in bringing out the discovery, and in introducing it into public use. It gives this remuneration to parties that have no peculiar claims upon the government or the public, and takes it from those who confessedly have.

The whole structure of the eighteenth section turns upon the idea of affording this additional protection and compensation to the patentee, and to the patentee alone; and hence the reason for instituting the inquiry before the grant of the extension, to ascertain whether or not he has failed to realize a reasonable remuneration from the sale and use of the discovery,—the production of an account of profit and loss, to enable the board to determine the question; and as it comes to the one or the other conclusion, to grant the extended term or not.

It is obvious, therefore, that Congress had not at all in view protection to assignees; that their condition, on account of dealing in the subject of the invention, whether successful or otherwise, was not in the mind of that body; nor can any good reason be given why it should have been.

They had purchased portions of the interest in the invention, and dealt with the patent-rights as a matter of business and speculation; and stood in no different relation to the government or the public than other citizens engaged in the common affairs of life.

Nothing short of the most fixed and positive terms of a statute could justify an interpretation so repugnant to the whole scope and policy of it, and to wise and judicious legislation.

We think this construction not necessarily required by the language of the clause, and is altogether inadmissible.

Then, as to the second interpretation, namely, that the clause refers to and includes assignees and grantees of interests acquired in the new term, either by an assignment or grant from the patentee after the extension, or by virtue of a proper clause for that purpose in the assignment under the old term.

The difficulty attending this construction lies in the uselessness of the clause upon the hypothesis—the failure to discover any subject-matter upon which to give reasonable operation and effect to it; and hence, to adopt the construction is to make the clause virtually a dead-letter, the grounds for which conclusion we will proceed to state.

The eleventh section of the Patent Act provides that every patent shall be assignable in law, either as to the whole interest or any un-

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divided part thereof, by an instrument in writing, which assignment, and also every grant and conveyance of the exclusive right under any patent, &c., shall be recorded in the Patent Office. And the fourteenth section authorizes suits to be brought in the name of the assignee or grantee, for an infringement of his rights, in a court of law.

One object of these provisions found in the general patent system, is to separate the interest of the assignee and grantee from that which may be held by the patentee, and to make each fractional interest held under the patent distinct and separate; in other words, to change a mere equitable into a legal title and interest, so that it may be dealt with in a court of law.

Now, in view of these provisions, it is difficult to perceive the materiality of the clause in question, as it respects the rights of assignees and grantees, held by an assignment or grant in and under the new term, any more than in respect to like rights and interests in and under the old.

The eleventh and fourteenth sections embrace every assignment or grant of a part or the whole of the interest in the invention, and enable these parties to deal with it, in all respects, the same as the patentee. They stand upon the same footing, under the new term, as in the case of former assignments under the old. Nothing can be clearer. It is impossible to satisfy the clause by referring it to these assignments and grants, or to see how Congress could, for a moment, have imagined that there would be any necessity for the clause, in this aspect of it. It would have been as clear a work of supererogation as can be stated.

The only color for the argument in favor of the necessity of this clause, in the aspect in which we are viewing it, is as respects the contingent interest in the new term, derived from a provision in an assignment under the old one, looking to the extension. As the right necessarily rested on contract, at least till the contingency occurred, there may be some doubt whether, even after its occurrence, the eleventh and fourteenth sections had the effect to change it into a vested legal interest, so that it could be dealt with at law; and that a new assignment or grant from the patentee would be required, which could be enforced only in a court of equity. To this extent, there may be some color for the argument—some supposed matter to give operation and effect to the clause.

But what is the amount of it? Not that the clause creates or secures this contingent interest in the new term, for that depends upon the contract between the parties, and the contract alone, and which, even if the general provisions of the law respecting the rights of assignees

and grantees could not have the effect to change into a legal right, might be enforced in a court of equity.

The only effect, therefore, of the provision, in respect to assignees and grantees of this description, would be to change the nature of the contingent interest, after the event happened, from a right resting in contract to a vested legal interest; or, to speak with more precision, to remove a doubt about the nature of the interest in the new term, after the happening of a certain contingency, which event in itself was quite remote. This seems to be the whole amount of the effect that even ingenious and able counsel have succeeded in finding, to satisfy the clause. It presupposes that Congress looked to this scintilla of interest in the new term, which might or might not occur, and cast about to provide for it, for fear of doubts as to its true nature and legal character, and the effect of the general system upon it.

We cannot but think a court should hesitate before giving a construction to the clause so deeply harsh and unjust in its consequences, both as it respects the public and individual rights and interests, upon so narrow a foundation.

But there are other difficulties in the way of this construction.

The eleventh section, regulating the rights of assignees and grantees, provides "that every patent shall be assignable at law," &c., "which assignment, and also every grant and conveyance of the exclusive right under any patent to make and use, and to grant to others to make and use, the thing patented within and throughout any specified part or portion of the United States," &c., "shall be recorded."

Now, it will be apparent, we think, from a very slight examination of the clause in question, that it does not embrace assignees or grantees, in the sense of the eleventh section, at all; nor in the sense in which they are referred to, when speaking of these interests generally, under the Patent Law, without interpolating words or giving a very forced construction to those composing it.

The clause is as follows: "And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein."

It will be seen that the word "exclusive," used to qualify the right of a grantee in the eleventh section, and, indeed, always when referred to in the Patent Law, (sec. 14,) and also the words "to make," "and to grant to others to make and use," are dropped; so that there is not only no exclusive right in the grantee, in terms, granted or secured by the clause, but no right at all—no right whatever—to make, or to grant to others to make and use, the thing patented; in other words, no exclusive right to make or vend. And it is, we think, quite ob-

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vious, from the connection and phraseology, that assignees and grantees are placed, and were intended to be placed, in this respect, upon the same footing. We should scarcely be justified in giving to this term a more enlarged meaning as to the right to make and sell, as it respects the one class, than is given to the others, as they are always used as correlative in the Patent Laws, to the extent of the interests held by them. The clause, therefore, in terms, seems to limit studiously the benefit or reservation, or whatever it may be called, under or from the new grant, to the naked right to use the thing patented; not an exclusive right even for that, which might denote monopoly, nor any right at all, much less exclusive, to make and vend. That seems to have been guardedly omitted. We do not forget the remaining part of the sentence, "to the extent of their respective interests therein," which is relied on to help out the difficulty. But we see nothing in the phrase, giving full effect to it, necessarily inconsistent with the plain meaning of the previous words. The exact idea intended to be expressed may be open to observation; but we think it far from justifying the court in holding that the grant or reservation of a right to use a thing patented, well known and in general use at the time, means an exclusive right to make and use it; and not only this, but an exclusive right to grant to others the right to make and use it, meaning an exclusive right to vend it.

The court is asked to build up a complete monopoly, in the hands of the assignees and grantees, in the thing patented, by judicial construction, founded upon the grant of a simple right to use it to the extent of the interest possessed; for the argument comes to this complexion. A simple right to use is given, and we are asked to read it an exclusive right; and not only to read it an exclusive right to use, but an exclusive right to make and vend the patented article.

Recurring to the Patent Law, it will be seen that Congress, in granting monopolies of this description, have deemed it necessary to use very different language. The grant in the patent must be in express terms, for "the full and exclusive right and liberty of making, using, and vending," in order to confer exclusive privileges. The same language is also used in the act, when speaking of portions of the monopoly in the hands of assignees and grantees. Sections 11, 14.

We cannot but think, therefore, if Congress had intended to confer a monopoly in the patented article upon the assignees and grantees, by the clause in question, the usual formula in all such grants would have been observed, and that we should be defeating their understanding and intent, as well as doing violence to the language, to sanction

or uphold rights and privileges of such magnitude, by the mere force of judicial construction.

We conclude, therefore, that the clause has no reference to the rights or interest of assignees and grantees under the new and extended term—

1. Because, in that view, giving to the words the widest construction, there is nothing to satisfy the clause, or upon which any substantial effect and operation can be given to it. It becomes virtually a dead-letter, and work of legislative superfluity. And,

2. Because the clause in question, upon a true and reasonable interpretation, does not operate to vest the assignees and grantees named therein with any exclusive privileges whatever, in the extended term, and therefore cannot be construed as relating to or embracing such interests, in the sense of the law.

The extension of the patent under the eighteenth section is a new grant of the exclusive right or monopoly in the subject of the invention for the seven years. All the rights of assignees or grantees, whether in a share of the patent, or to a specified portion of the territory held under it, terminate at the end of the fourteen years, and become reinvested in the patentee by the new grant.

From that date, he is again possessed of “the full and exclusive right and liberty of making, using, and vending to others the invention,” whatever it may be. Not only portions of the monopoly held by assignees and grantees as subjects of trade and commerce, but the patented articles or machines, throughout the country, purchased for practical use in the business affairs of life, are embraced within the operation of the extension. This latter class of assignees and grantees are reached by the new grant of the exclusive right to use the thing patented. Purchasers of the machines who were in the use of them at the time are disabled from further use immediately, as that right became vested exclusively in the patentee. Making and vending the invention are prohibited by the corresponding terms of this grant.

Now, if we read the clause in question with reference to this state of things, we think that much of the difficulty attending it will disappear. By the previous part of the section, the patentee would become reinvested with the exclusive right to make, use, and vend the thing patented; and the clause in question follows, and was so intended, as a qualification. To what extent, is the question. The language is, “And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein,”—naturally, we think, pointing to those who were in the use of the patented article at the time of the renewal,



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and intended to restore or save to them that right which, without the clause, would have been vested again exclusively in the patentee. The previous part of the section operating in terms to vest him with the exclusive right to use as well as to make and vend, there is nothing very remarkable in the words, the legislature intending thereby to qualify the right in respect to a certain class only, leaving the right as to all others in the patentee, in speaking of the benefit of the renewal extending to this class. The renewal vested him with the whole right to use, and therefore there is no great impropriety of language, if intended to protect this class, by giving them in terms the benefit of the renewal. Against this view, it may be said that "the thing patented" means the invention or discovery, as held in *Mc Clurg v. Kingsland*, 1 How., 202, *ante*, and that the right to use the "thing patented" is what, in terms, is provided for in the clause. That is admitted, but the words, as used in the connection here found, with the right simply to use the thing patented, (not the exclusive right, which would be a monopoly,) necessarily refer to the patented machine, and not to the invention; and, indeed, it is in that sense that the expression is to be understood generally throughout the Patent Law, when taken in connection with the right to use, in contradistinction to the right to make and sell.

The "thing patented" is the invention; so the machine is the thing patented; and to use the machine is to use the invention, because it is the thing invented, and in respect to which the exclusive right is secured, as is also held in *Mc Clurg v. Kingsland*. The patented machine is frequently used as equivalent for the "thing patented," as well as for the invention or discovery, and, no doubt, when found in connection with the exclusive right to make and vend, always means the right of property in the invention—the monopoly. But when in connection with the simple right to use, the exclusive right to make and vend being in another, the right to use the thing patented necessarily results in a right to use the machine, and nothing more. Then, as to the phrase "to the extent of their respective interests therein," that, obviously enough, refers to their interests in the thing patented, and, in connection with the right simply to use, means their interests in the patented machines, be that interest in one or more at the time of the extension.

This view of the clause, which brings it down, in practical effect and operation, to the persons in the use of the patented machine or machines at the time of the new grant, is strengthened by the clause immediately following, which is, "that no extension of the patent shall be granted after the expiration of the term for which it was

originally issued." What is the object of this provision? Obviously, to guard against the injustice which might otherwise occur to a person who had gone to the expense of procuring the patented article, or changed his business, upon the faith of using or dealing with it after the monopoly had expired, which would be arrested by the operation of the new grant. To avoid this consequence, it is provided that the extension must take place before the expiration of the patent, if at all. Now, it would be somewhat remarkable if Congress should have been thus careful of a class of persons who had merely gone to the expense of providing themselves with the patented article for use or as a matter of trade after the monopoly had ceased, and who would be disappointed and exposed to loss if it was again renewed, and at the same time had overlooked the class who, in addition to this expense and change of business, had bought the right from the patentee, and were in the use and enjoyment of the machine, or whatever it might be, at the time of the renewal. These provisions are in juxtaposition, and we think are but parts of the same policy, looking to the protection of individual citizens from any special wrong and injustice on account of the operation of the new grant.

The consequences of any different construction than the one proposed to be given, are always to be regarded by courts, when dealing with a statute of doubtful meaning; for between two different interpretations, resting upon judicial expositions of ambiguous and involved phraseology, that which will result in what may be regarded as coming nearest to the intention of the legislature should be preferred.

We must remember, too, that we are not dealing with the decision of the particular case before us, though that is involved in the inquiry; but with a general system, of great practical interest to the country; and it is the effect of our decision upon the operation of the system that gives to it its chief importance.

The eighteenth section authorizes the renewal of patents in all cases where the Board of Commissioners is satisfied of the usefulness of the invention, and of the inadequacy of remuneration to the patentee. Inventions of merit only are the subject of the new grant,—such as have had the public confidence, and which it may be presumed to have entered largely, in one way and another, into the business affairs of life.

By the report of the Commissioner of Patents, it appears that five hundred and two patents were issued in the year 1844,—for the last fourteen years, the average issue yearly exceeded this number,—and embrace articles to be found in common use in every department of labor or art, on the farm, in the workshop and factory. These arti-

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cles have been purchased from the patentee, and have gone into common use. But if the construction against which we have been contending should prevail, the moment the patent of either article is renewed, the common use is arrested, by the exclusive grant to the patentee. It is true, the owner may repurchase the right to use, and doubtless would be compelled, from necessity; but he is left to the discretion or caprice of the patentee. A construction leading to such consequences, and fraught with such unmixed evil, we must be satisfied, was never contemplated by Congress, and should not be adopted, unless compelled by the most express and positive language of the statute.

The third question certified is, whether the extension of the patent granted to W. W. Woodworth, as administrator, on the 16th of November, 1842, inured to the benefit of the administrator exclusively, or whether, as to certain territory specified in the contract of assignment made by W. W. Woodworth and James Strong to Toogood, Halstead, and Tyack, on the 28th of November, 1829, and by legal operation of the covenants contained in said contract, the said extension inured to the benefit of said Toogood, Halstead, and Tyack, or their assigns.

William Woodworth was the original patentee, and took out letters patent on the 27th of December, 1828, and soon after conveyed a moiety of the same to James Strong. One Uri Emmons also obtained a patent for a similar machine on the 25th of April, 1829, and soon after conveyed all his interest in the same to Toogood, Halstead, and Tyack. With a view to avoid litigation, both parties mutually assigned to each other their interests in the respective patents to different and separate portions of the United States; and in the assignment from Woodworth and Strong to Toogood, Halstead, and Tyack, the following covenant was entered into by the parties: "And the two parties further agree, that any improvement in the machinery, or alteration or renewal of either patent, such improvement, alteration, or renewal shall inure to the benefit of the respective parties interested, and may be applied and used within their respective districts, as hereinbefore designated."

At the time this covenant was entered into, there was no provision in the Patent Laws authorizing an extension or renewal of the same beyond the original term of fourteen years. The first act providing for it was passed in July, 1832. Before this time, the only mode of prolonging the term beyond the original grant was by means of private acts of Congress, upon individual applications.

A construction had been given by the Circuit Court of the United

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States, in New York, as early as 1824, by which the patentee, on surrendering his patent on account of a defective specification, would be entitled to take out a new patent correcting the defect, which construction was afterwards upheld by this court in *Grant v. Raymond*, 6 Peters, 218, and the principle since ingrafted into the Patent Law by the act of 1832.

The court is of opinion, that the covenant in question should be construed as having been entered into by the parties, with a reference to the known and existing rights and privileges secured to patentees under the general system of the government established for that purpose; that the parties would naturally look to the established system of law on the subject of arranging their several rights and obligations, in dealing with property of this description, rather than to any possible change that might be effected by private acts of Congress, upon individual application. Contracts are usually made with reference to the established law of the land, and should be so understood and construed, unless otherwise clearly indicated by the terms of the agreement. If the parties in this case contemplated any alteration or modification of their rights, more advantageous, by the further legislation of Congress, we think some more specific provision, having reference to it, should have been inserted in their covenant. The term renewal may be satisfied by a reference to the law as it then stood. The patentee might surrender his patent, and take out a new one, within the fourteen years; and the term was used, probably, to guard against any question that might be raised as to the right under the assignment in the new patent, if a surrender and new issue should become necessary. The specification accompanying the patent was a complicated one, and has been the subject of much controversy, and the necessity of a surrender for correction and amendment might very well have been anticipated.

We think this view satisfies the use of the term, and that no right is acquired in the new grant by virtue of the assignment or covenant.

The fourth and fifth questions certified are answered by the opinion of the court upon the first and second questions.

The sixth question certified is as follows: Whether the plaintiff, if he be an assignee of an exclusive right to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within the said town, or whether, to maintain such action, the plaintiff must be possessed, as to that territory, of all the rights of the original patentee.

The plaintiff is the grantee of the exclusive right to construct and

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use, and to vend to others to be used, two of the patented machines within the town of Watervliet, in the county of Albany.

The fourteenth section of the Patent Law authorizes any person, who is a grantee of the exclusive right in a patent within and throughout a specified portion of the United States, to maintain an action in his own name for an infringement of the right.

The plaintiff comes within the very terms of the section. Although limited to the use of two machines within the town, the right to use them is exclusive. No other party, not even the patentee, can use a right under the patent within the territory, without infringing the grant.

The seventh question certified is as follows: Whether the letters patent of renewal issued to W. W. Woodworth, as administrator, on the 8th of July, 1845, upon the amended specification and explanatory drawings then filed, be good and valid in law, or whether the same be void for uncertainty, ambiguity, or multiplicity of claim, or any other cause.

The court is satisfied, upon an examination of the specification and drawings referred to in the question certified, that it is sufficiently full and explicit, and is not subject to any of the objections taken to it.

The remaining questions will be sufficiently answered by the certificate sent to the court below.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and on the points and questions on which the judges of the said Circuit Court were opposed in opinion, and which were certified to this court for its opinion, agreeably to the act of Congress in such case made and provided, and was argued by counsel; on consideration whereof, it is the opinion of this court—

1. That the eighteenth section of the Patent Act of 1836 did authorize the extension of a patent on the application of the executor or administrator of a deceased patentee.

2. That, by force and operation of the eighteenth section of the act of July 4, 1836, entitled "An act to promote the progress of the useful arts," &c., the extension granted to William W. Woodworth, as administrator, on the 16th day of November, 1842, did not inure to the benefit of assignees under the original patent granted to William Woodworth, on the 27th day of December, 1828, but that the said extension inured to the benefit of the administrator only, in his said capacity.

3. That the extension specified in the foregoing second point did

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inure to the benefit of the administrator, to whom the same was granted, and to him, in that capacity, exclusively; and that, as to the territory specified in the contract of assignment made by William Woodworth and James Strong to Toogood, Halstead, and Tyack, on the 28th day of November, 1829, (and set forth in the second plea of the defendants to the first count of the declaration,) and by legal operation of the covenants contained in said contract, the said extension did not inure to the benefit of the said Toogood, Halstead, and Tyack, or their assigns.

4. That the plaintiff, claiming title under the extension from the administrator, can maintain an action for an infringement of the patent-right within the territory specified in the contract of assignment to Toogood, Halstead, and Tyack, against any person not claiming under said assignment; and that the said assignment is not, of itself, a perfect bar to the plaintiff's suit.

5. That the extension specified in the second point could be applied for and obtained by William W. Woodworth, as administrator of William Woodworth, deceased, although the said William Woodworth, the original patentee, had, in his lifetime, disposed of all his interest in the then existing patent, having at the time of his death no right or title to or interest in the said original patent; and that such sale did not carry anything beyond the term of said original patent; and that no contingent rights remained in the patentee or his representatives.

6. That the plaintiff, if he be an assignee of an exclusive right to use two of the patented machines within the town of Watervliet, has such an exclusive right as will enable him to maintain an action for an infringement of the patent within said town.

7. That the letters patent of renewal issued to William W. Woodworth, as administrator as aforesaid, on the 8th day of July, 1845, upon the amended specification and explanatory drawings then filed, are good and valid in law; and are not void for uncertainty, ambiguity, or multiplicity of claim, or any other cause.

8. That the question involved in the eighth point propounded does not present any question of law which this court can answer.

9. That the decision of the Board of Commissioners, who are to determine upon the application for the extension of a patent under the eighteenth section of the act of 1836, is not conclusive upon the question of their jurisdiction to act in a given case.

10. That the Commissioner of Patents can lawfully receive a surrender of letters patent for a defective specification, and issue new letters patent upon an amended specification, after the expiration of

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the term for which the original patent was granted, and pending the existence of an extended term of seven years; and that such surrender and renewal may be made at any time during such extended term.

It is thereupon now here ordered and adjudged by this court, that it be so certified to the said Circuit Court.

M'LEAN, J. As I dissent from the opinion of the court, in their answer to the second question certified, I will state, in few words, the reasons of my dissent.

The question is, whether the extension of the patent, under the act of 1836, to William W. Woodworth, the administrator, inured to the benefit of the assignees of the first patent.

I had occasion to consider this question in the case of *Brooks & Morris v. Bicknell & Jenkins*, on my circuit, and, on a deliberate examination of the eighteenth section of the above act, I came to the conclusion that, unless the assignment gave to the assignee the right in the extended or renewed patent, his interest expired with the limitation of the original patent.

The lamented Justice STORY, without any interchange of opinion between us, about the same time, gave the same construction to the section. The late Mr. Justice THOMPSON, and several of the district judges of the United States, have construed the act in the same way.

The eleventh section of the act makes the patent assignable in law, either as to the whole interest or any undivided part thereof, by any instrument of writing, which is required to be recorded in the Patent Office within three months from the date.

By the eighteenth section, the patentee may make application for the extension of his patent to the Commissioner, who is required to publish a notice of such application "in one or more of the principal newspapers in the city of Washington, and in such other paper or papers as he may deem proper, published in the section of country most interested adversely to the extension of the patent." "And the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them, both for and against the extension, and shall sit for that purpose at the time and place designated in the published notice thereof. The patentee shall furnish to said board a statement in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention.

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And if, upon a hearing of the matter, it shall appear, to the full and entire satisfaction of the said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent," &c.; "and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years. And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein."

This section embraces patents previously issued, and the construction now to be given to it operates on all cases of extensions under it, whether the assignments were made before or after the passage of the act.

The object of this section is so clearly expressed as not to admit of doubt. It was for the exclusive benefit of the patentee; for the extension can only be granted when it shall be made to appear that the patentee, "without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for his time, ingenuity, and expense," &c. This, then, being the clear intent of Congress, expressed in this section, it must have a controlling influence in the construction of other parts of the section. A statute is construed by the same rule as a written contract. The intent of law-makers, and of the persons contracting, where that intent clearly appears, must be carried into effect. Where the statute or the contract is so repugnant in its language as not to show the intent, then no effect can be given to it. If the words used be susceptible of such a construction as not only to show the intent, but to enable the court to give effect to it, it is the duty of the court so to construe it.

Bacon, on the construction of statutes, says: "The most natural and genuine way of construing a statute, is to construe one part by another part of the same statute; for this best expresseth the meaning of the makers." And, "If any part of a statute be obscure, it is proper to consider the other parts; for the words and meaning of one part of a statute frequently lead to the sense of another." "A statute ought, upon the whole, to be so construed, that, if it can be prevented, no clause, sentence, or word shall be superfluous, void, or insignificant."

That the patentee may have his patent extended, though the assignee



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held the entire interest in it, is undoubted. He has only to show that he has not been reimbursed, &c., within the meaning of the section, to establish his claim for an extension. And in such a case, if the benefit of the extension go to the assignee, he having the entire interest in the patent, how is the patentee benefited? And yet the law was enacted exclusively for his benefit. Does not such a construction defeat the object of the law? And if it does, can it be maintained? Where the assignment of the patent has been for less than the whole, the same objection lies, though the object of the law is subverted only to the extent of the assignment.

The interest of the assignee, it is supposed, is protected by the provision that "the benefit of such renewals shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein." There can be no doubt that the words, "to the extent of their respective interests therein," refer to their right to use the thing patented; and this, it is contended, is the benefit which results to the assignee from the renewal. That this would seem to be the import of these words, disconnected from other parts of the section, is admitted; but such a construction is wholly inadmissible, when the object of the section is considered.

The patent is extended for the benefit of the patentee. This is so obvious that no one will deny it. And the above construction gives the benefit to the assignee. Here is a direct repugnancy, and there is no escape from it; for the same repugnancy exists, though in a less degree, where a part of the patent only has been assigned. Under such circumstances, we must inquire whether this repugnancy may not be avoided by giving another and a different application to the provision, of which the words may be susceptible.

The benefit of the renewal is given to the assignees; but to what extent? To the extent of their interest in the renewal. But it is said that this cannot be the true construction, as it renders the provision inoperative. If, by the assignment, there was an express contract that the assignee should enjoy the same interest in the renewal or extension of a patent, this would secure such interest without the provision.

To this it may be answered, that such an assignment of a thing not *in esse* would, at most, only be a contract to convey the legal right. But, under the eighteenth section, the assignment, after the extension, becomes a legal transfer. In addition to this, the right under the extension being legal, all purchasers would be affected with notice, where the assignment had been recorded in the Patent Office. This view gives effect to the section, and harmonizes its provisions. The

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other construction makes the parts of the section repugnant, and nullifies the whole of it. Now, which is the more reasonable view? But, in addition to this, what conceivable motive could Congress have had to give a boon to the assignee? How is he injured by the extension?

Without the extension, the assignee would only have a right, in common with all others, to use the invention. This could be of no more value to him than the worth of his machinery; for competition equally open to all cannot be estimated of any value. Under the assignment, the assignee claims a monopoly. Now, did Congress intend to give him this boon? Why should he be an object of public munificence? He laid out his money, in the purchase of the patent-right, because he believed it would be profitable. And, in most cases, the assignee speculates upon the poverty of the inventor. Inventors are proverbially poor and dependent. The history of this patent illustrates strongly this fact. Half of the right was originally assigned to pay the expense and trouble of taking out the patent. Another part of the patent was assigned to compromise a pretended claim to a similar invention.

The hardship complained of by the assignee is more imaginary than real. If the patentee takes all the benefit of the extension, the assignee loses, it is said, the value of his machinery. This does not necessarily follow; for if the machinery has been judiciously selected, and put in operation at a proper place, it will sell for its value generally, if not always. If the invention be of great value, as is undoubtedly the case in this instance, the machinery will be wanted by any one who may wish to continue the business, under the extended patent. So that the loss in the sale of the machinery would not be greater than would have been suffered by a sale if the patent had not been extended.

This construction, then, inflicts little or no injury on the assignee, whilst the other construction, as has been shown, defeats the object of the statute. But this inconvenience or loss to the assignee is duly considered and weighed, under the statute, as the board, in granting the extension, must have a due regard to the public interest. Notice is to be given, as far as practicable, to all persons interested against the extension of the patent, who may appear before the board and oppose it; and it was stated in the argument that the assignees of this patent did oppose the extension of it. Little did they suppose, at the time, that they were resisting a boon secured to them by the above section. Whatever loss, real or imaginary, the assignee may suffer from the extension of the patent, is a loss or inconvenience which results from the general advancement of the public good, and for

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which society does not, and indeed cannot, make compensation. The price of property is affected by general legislation. An embargo is laid, and ships, during its continuance, are valueless. The increase or diminution of the tariff affects beneficially or injuriously the value of machinery used in manufactures. The reduction of the price of the public lands affects the price of lands generally in the new States. An act authorizing a company or individual to construct a railroad, renders useless turnpike roads in its neighborhood, and the public houses established thereon. But for these injuries, no compensation is made. Indeed, it is difficult to find any great public enterprise which does not, in a greater or less degree, affect injuriously private rights. But these must yield to the general welfare of society.

All enlightened governments reward the inventor. He is justly considered a public benefactor. Many of the most splendid productions of genius, in literature and in the arts, have been conceived and elaborated in a garret or hovel. Such results not only enrich a nation, but render it illustrious. And should not their authors be cherished and rewarded?

If the assignee, under the eighteenth section, take anything, in my judgment, he takes the whole extent of his interest,—the whole or nothing. And it appears to me the construction given by the court is, if possible, less warranted by the section, than to hold that the assignee takes under the extension the entire interest assigned.

The words, “and the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein,” cannot, it seems to me, by any known rule of construction, be held to give to the assignee or grantee the right to use the machine he may have had in operation at the time the extension took effect. The words, “to use the thing patented,” are descriptive of the right assigned or granted, and refer to such right,—not to the mere use of the machine. “The extent of their respective interests therein” undoubtedly covers the whole interest, and cannot refer merely to the number of machines the individual may have in operation.

Mr. Justice WAYNE expressed his dissent from that part of the opinion of the court which, in answer to the second question, gave a right to an assignee to continue the use of the patented machine, and said he would probably file his reasons with the clerk.

WOODBURY, J. There is one of the leading questions certified to us in this cause, in the decision of which I have the misfortune to differ from a majority of the court.

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As that decision bears on several of the other questions, and also disposes entirely of some of the four causes connected with this matter, which have been so long and so ably under argument before us, I consider it due to the importance of this subject, to the parties and the public, as well as just to myself, to state the reasons for my dissent.

The difference in our views arises in the construction of the eighteenth section of the Patent Law of July 4, 1836, and relates to the benefits which may be enjoyed under it by assignees and grantees.

Before the passage of that law, a patent could not, under any circumstances, be extended in its operation, for the benefit of anybody, beyond its original term, except by a special act of Congress. But this section allowed a patentee to apply to a board of officers and obtain from them a renewal of his patent for seven years longer, provided he offered to them satisfactory proofs that his expenses and labor in relation to the patent had not been indemnified. It provided, further, that the renewal be indorsed on the back of the original patent; "and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years." It then added: "And the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein." This last clause creates the chief embarrassment. In this case, the patentee having died, and we having just decided that a renewal was legally granted to his administrator, the controverted question about which we differ is, whether that renewal inures exclusively to the use of the patentee, through his administrator, or goes, either in full or in part, to his assignees and grantees under the old patent. In the present case, it is conceded that, by the contract of assignment or grant, nothing is expressly conveyed but the old patent, and in words only, for the original term of "fourteen years."

The question is not, then, whether, when assigning an interest in the old term, before or after the passage of the act of 1836, it might not be competent and easy to use language broad and explicit enough to transfer an interest in any subsequent extension by means of the contract of assignment, and this be confirmed by the words of the eighteenth section; but whether those words alone transfer it, or were intended to transfer it, when the contract of assignment, as in this case, was made before the act of 1836 passed, and referred *eo nomine* only to the old patent, and expressly limited the time for which the patent was assigned to the old term.

In such case, it seems to me that both the language and spirit of this section restrain its operation to the patentee or his legal repre-

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sentatives, and convey no rights in the extension to assignees or grantees, whether prior or subsequent, except where the patentee had clearly contracted that they should have an interest beyond the original term.

But the majority of the court hold here that this clause, independent of any expression in the assignment, transfers an interest in the extension to all assignees and grantees, so that they may continue to use any machine already in operation during the new term, without any new contract, or any new compensation for such farther use.

The argument on the part of the assignees, in all the cases before us, on this subject, has been, that, by force of this section, all assignees before authorized to make, vend, or use these machines for fourteen years, could continue to make and vend, as well as use them, for seven more, without any new contract or new consideration; and that "grantees of the right to use" should have a like prolongation of all their interests. And such seems to have been the opinion of the Circuit Court in Maryland, in *Wilson v. Turner*, October Term, 1844, Chief Justice TANEY presiding, though other points arose there, and were disposed of in that opinion.

But now, for the first time, it is believed, since the passage of the Patent Law, this court, by force of the last clause in the eighteenth section, not only give to assignees and grantees a greater or longer interest in the thing patented than was given in the contract of assignment to them, but undertake to introduce a novel discrimination, not seeming to me to be made in the clause itself, and give to assignees of the patent-right itself an extension of only a part of their former interest, but to "grantees of the right to use" the patent, an extension of all their former interests.

We propose to examine the objections to this decision of the court, first, on the principle of giving to old assignees and grantees an extension of their interests to the new patent at all, unless the contract of assignment to them was manifestly meant to embrace any new term; and, after that, to examine the propriety of the discrimination in allowing a right in the renewed patent to grantees of the use, to the extent of all their old interests, and withholding a like privilege from assignees of the patent itself.

First, it has been repeatedly decided, that "a thing which is in the letter of a statute is not within the statute, unless it be within the intention of the makers." Dwarrris on Statutes, 692; Bac. Abr. Statute, T; 2 Instit., 107, 386.

Here, the great design of the whole section was to extend assistance to an unfortunate and needy class of men of genius, who had failed

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to realize any profits from their valuable inventions during the first term of their patents. The intention of the makers of this law is usually conceded to have been relief to such patentees, and not to assignees or grantees.

It was the former, and not the latter, who were sufferers, and whom Congress had before, by special acts of extension, occasionally tried to indemnify for their losses; and to whom now, in a more summary way, on application and proof by them alone, an extension was authorized to be given by a board of officers, in order that they, and not others, might reap the profits of such extension.

But, by allowing the benefit of it to go to the former assignees of only the old patent, the intention of the makers appears to be defeated, and those profited who have not proved any loss or suffering, but, on the contrary, may have already derived great advantages from the assignment.

It might thus happen, likewise, where, in a case like this, the patentee has assigned all his old patent before the extension, and the use of it under the extension would constitute all or its chief value, that neither he nor his representatives—he whose genius had produced the whole invention, at the sacrifice of time and toil, and whose sufferings, losses, and disappointments the law is expressly made to indemnify—would receive the smallest pittance from it; but those reap all its advantages who may already have grown rich by the assignment to them of the old patent, and who nobody can pretend were the particular or principal objects of relief. Under such a construction, how absurd would it be for such a patentee ever to apply for an extension, when he must do it at new cost and expense, and then have the whole fruits of it stripped from him by persons who had neither paid for the extension nor had it conveyed to them. It is an equal violation of the leading intention of this section, and of most of these principles and of much of this reasoning, to allow, as the opinion of the court does, such persons to take, unpaid for and unbought, a *part* of the benefits of the renewal, as to take the *whole* of them.

Secondly, by the construction of the court, contracts and vested rights seem to be radically encroached upon. Under it, an assignee of an old patent, limited in the contract conveying it to fourteen years, will, for some purposes, get it for twenty-one years, directly in conflict with the express stipulation of the parties. Congress will, in this way, be made unworthily to tamper with the private obligations of individuals, and will impair them by taking from the rights of one, and enlarging or adding to the rights of the other; and this without any new consideration or new engagement passing between them,

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but, on the contrary, against the wishes, assent, and interests of one. That view, also, involves us in the unreasonable inference, that Congress intended to violate a solemn compact, to disturb the vested rights and written agreements of parties, when the language used is susceptible of a different construction, and one that is consistent with what is just, and with the spirit of the whole section.

By that view, an assignee or grantee will obtain "a right to use the thing patented" for a term of seven years longer than he contracted or paid for; while the patentee, without any such agreement in his contract assigning or granting the right to use, and without any new consideration, will be deprived of all his new and vested rights in the extension, so far as regards that use, and will have his former contract impaired virtually in its whole vitality, by making him part with the use for a term of twenty-one years, when the contract says but fourteen, and making him do it, also, without any application by others for the extension, any proof by others of not being indemnified, any payment by others of the cost and expenses for procuring the additional seven years, and when the avowed and cardinal object of the renewal was to indemnify him alone for losses which he, and not others, had sustained. Well may he say, as to these new and extended interests attempted to be conferred on assignees and grantees beyond the contract of assignment, *in hæc federa non veni*.

Thirdly, the construction I contend for seems to me the only one consistent with the language used in the latter portion of the eighteenth section. By this, no part of those troublesome four lines is senseless, or expunged, or ungrammatical, or contradictory to the object of the previous portion of the section; while the construction opposed to this must, in my view, require interpolations or extirpations of words, and a violation of the object of the rest of the section, in order to give to the clause the meaning the advocates of that construction impute to it. Look at the phraseology of the clause: "*The benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein,*"—but surely to no more than that *extent*. It would violate both the words and design to have them enjoy more than the extent of their interests therein, quite as much as not to let them enjoy all of the extent of them. In the construction of statutes, it is a well-settled axiom, that, "to bring a case within the statute, it should be not only within the mischief contemplated by the legislature, but also within the plain, intelligible import of the words of the act of Parliament." *Brandling v. Barrington*, 6 Barn. & Cressw., 475. In this case, the assignees and grantees were not within either the mischief intended

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to be remedied, that is, a want of indemnity for losses by the patentee, or within the "plain, intelligible import of the words," as their contract of assignment or grant did not extend to the renewed term at all, for any purpose whatever, but was expressly limited to the fourteen years of the original patent.

There must be some measure of their respective interests, when the act passed. What was it? Clearly, the contracts under which they had been acquired. Nothing had been done, either in other acts or previous portions of this, to increase those interests beyond the contracts, but merely to enable assignees and grantees of exclusive rights to protect them by suits in their own names. The present clause, also, does not profess to increase those interests, but simply to let assignees and grantees enjoy them under the renewal, if by their extent by the contract which limits and defines them they run into the extended term. Various hypotheses and metaphysical refinements have been resorted to, for the purpose of putting a meaning on the words of this clause differing from this, which is so plain and so consistent with the spirit of the section; and virtually making it provide that assignees and grantees shall have more benefits under the renewal in the thing patented than the "extent of their respective interests therein."

But before testing more critically the extent of those interests by the only standard applicable to them, it will be necessary to consider separately the true meaning of two of the words employed in this clause, namely, "*renewal*" and "*therein*."

Much research has been exhibited in attempting to draw distinctions in this case between the words *renewal* and *extension*. But I am not satisfied that any exist, when these words are employed as in this act of Congress, or in contracts relating to this subject. It is true, that some "renewals" are not "extensions," in the sense of prolonging the term of the patent,—that is, when an old patent is surrendered and a new one taken out, or a renewal made for the rest of the term,—while all *extensions* prolong the term. But, still, "renewals" are as often used for a prolongation of the term, or for a new term, as *extensions* are; and in this very section "*to renew and extend*" is used as if synonymous, and this in sound analogy to the use of the word *renewal* on several other subjects. Thus, to renew a lease, is to extend it another term; to renew an office, is to extend it another term; to renew griefs, *revocare dolores*, is to extend them. Again, the second "*therein*," at the close of the clause, has been considered by some as meaning "in the *renewal*," and by others, "in the *right to use*," and by others still, "in the thing patented." But, grammatically, it refers to



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the "thing patented," and hence "the interests therein" are "the interests in the *thing patented*."

Phillips treats it as a matter of course to mean in the "*patent*," and uses that as synonymous to "therein"; and though, in regard to my construction of the whole clause, the result is much the same, whether "therein" is considered to mean in "the thing patented," or "the patent," or "the renewal," yet I incline to the first view of it as that most strictly grammatical and the most natural, as well as coming nearest to the views of this court in *McClurg v. Kingsland*, 1 How., 210. Further objections to its meaning "in the right to use" will be stated hereafter, under another head. Passing, then, to a more careful scrutiny of the whole clause, it would seem that there could be but one rational test of "the extent" of the interests of assignees and grantees in the thing patented, and that such test must be the previous contract of assignment or grant under which alone they hold any interests.

If that contract grants to them one-fourth or one-half of the old patent, or the use of it in one State or county, and for a term of five years, or ten, or fourteen, from the issue of the patent, then such, and such alone, is the extent of their interests, and they will not run into the new term. But if the contract goes further, and grants one-half or all of the old patent to assignees, and for a term not only of fourteen years, but twenty-one years, or any number to which the patentee may afterwards become entitled by any extension or new grant, then such is the extent of their interests, and they will in such case run into the new term. This view gives meaning and spirit to every word, and excludes or alters none. This, too, conforms to the design of the section in taking away no part of the benefit intended to be conferred by it on the patentee, unless he has chosen to dispose of it clearly and deliberately, and receive therefor, either in advance or after actually granted, such additional consideration as he deemed adequate and contracted to be sufficient.

If after the word "*extent*," in this clause, there had been added, what is the legal inference, *both in time and quantity*, this meaning might have been still more clear to some. But without those words, the extent of interest seems to me to depend as much on the length of time the patent is granted to the assignee, as on the dimensions of territory over which he may use it, or the proportion of the whole patent he is authorized to use. It is like a leasehold interest in land, or a grant of it. The extent of interest by such a grant of land is more or less, as the term is shorter or longer, quite as much as if the land conveyed is more or less in quantity.

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The word "extent," in common parlance, varies somewhat in meaning, according to the subject to which it is applied, and as that changes, it may as well refer to time as to space or proportion; and more especially so, when applied to interests, as in patents, for a particular term of years.

There is another analogy in support of this view, that has not been urged in the ingenious arguments offered, but has struck me with some force. A patent was the description once applied to commissions for office; and the records of this court at first speak of the commissions of the judges as patents.

Now, what is the extent of interest the incumbent has in any office under his commission or patent? Clearly, in part, the length of time it is to run, whether four years, during good behavior, or for life, and in part only its yearly profits, often quite as much depending on that length of time, as the amount of the salary or fees annually attached to the office.

What is the chief objection in reply to all this? Nothing, except that the assignee could get protected to the extent of his interest, in this view, by the contract alone, without the aid of the provision at the close of the eighteenth section, and hence that the provision is in this view unnecessary or nugatory, and must have been inserted for some other purpose. But were it in reality unnecessary, that would not require us to consider it as intending something different from its words, or different from the previous contracts of the parties. Legislatures often add clauses to acts, which do not prove to be in reality necessary, but are inserted from abundant caution and to remove future doubts or litigation. So, in this very act, in the eleventh section, it is declared that a patent may be assigned. Yet this is probably unnecessary, as an interest like that of a patentee can, of course, be assigned, on common-law principles, without the aid of a statute.

When we look, however, to another circumstance,—that, though a contract of assignment would, without any clause in the statute, pass the interest to the assignee, yet it would not enable him to sue in his own name,—we can discover another reason for this provision, still more effective. A clause had been inserted in a previous part of the act to enable the assignee to sue in his own name on the old patent, if violated; and, probably in doubt whether such provision would be extended to assignees under the renewal, when having any interest therein, it was provided further, that "the benefit of the renewal" should reach them to the extent of their interests therein—a part of which benefit would be to sue in their own name for any infringement on their rights to it, as fully as they could do for a violation of

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their rights in the original patent, and as if that had been for twenty-one years. The provision thus would be far from nugatory, by clearly conferring on them every power and privilege to sue, under the extension, which they possessed under the original patent.

By means of this provision, also, in another view, the condition of the parties might be changed, from a reliance on a contract alone that they should have a certain interest in the new patent, to a vested interest in it; or, in another view still, from an executory to an executed right.

There is, in the construction given by some of the majority of the court to the clause immediately preceding this, another ample reason for inserting such a provision.

The previous clause, stating that "thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years," would, it is argued, if the section had there ended, have conferred on any assignee or grantee of the old patent, or any part of it, the extended term, so as to enable them to use the patent as if it originally had been granted for twenty-one years instead of fourteen.

Suppose, then, for a moment, that this construction was considered by Congress proper, or only possible, it is manifest that the additional clause which follows had a second and most pregnant object,—no less than to prevent that consequence, so hostile to the design of inserting the whole section,—to grant an extended term for the benefit and indemnity of the patentee, and not of the assignee. In this view, the last clause might well be added, as a limitation on what would otherwise be the inference from that just preceding it; and might well declare, instead of this inference, that assignees of the old patent should not hold it, in all cases, as if originally granted for twenty-one years, though patentees might; but that assignees should hold only in conformity to "the extent of their respective interests" in the thing patented. In other words, if by contract they had acquired clearly an interest for twenty-one years, they should hold for that time; but if by contract they had acquired an interest for only five or fourteen years, they should hold it only to that extent. This is rational, consistent with the great object of the section, and gives new and increased force and necessity to the clause. The assignees would then, after the renewal, hold the patent for all the time they had stipulated, and for all they had paid, but for no more.

It will be perceived, that very few assignees or grantees, prior to the passage of the act of 1836, would, in this view, be likely to come under this provision, and be benefited by it; because, not knowing

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that any future law would pass allowing an extension, very few would be likely to anticipate one, and provide in their contract and pay for a contingent interest in its benefits.

This would make the provision, in practice, apply chiefly to future assignees, who, knowing that such a provision existed, might be willing to give something for a right to any extension which might ever take place under it; and, therefore, might expressly stipulate in the assignment for that right. Indeed, the arguments on the part of the patentee in this case have mostly proceeded on the ground that this provision was intended to apply solely and exclusively to future assignees. Considering that any other construction is in some degree retrospective, and that this would give force to the provision as well as preserve the spirit of the section, I should be inclined to adopt it, if mine did not produce a like effect, and was not alike free from objection, as limited by me; because I do not make the provision retrospective, except in cases where the parties had expressly contracted that the prior assignee should receive the benefit of any extension, and in that case it has the preference in its operation over the other view, as it carries into effect that express compact, and does not cramp the force of it to the future alone, where the language and the consideration are equally applicable to past engagements of this character.

This conclusion is also strengthened by being in harmony with all the leading rules of construction applicable to statutes, while that adopted by the court seems, to my mind, to violate some of the most important of them.

Besides those already referred to, it is well settled, that, "if a particular thing be given or limited in the preceding parts of a statute, this shall not be taken away or altered by any subsequent general words of the same statute." Dwarria, 658; *Standen v. The University of Oxford*, 1 Jones, 26; 8 Coke, 118, *b*. Here a particular benefit is, by the former part of the eighteenth section, conferred on a patentee, for reasons applicable to him alone; and yet, in this case, by the opposite construction, a few general words towards the close are construed so as in some respects to destroy entirely all those benefits of the patentee; and that, too, when the language is susceptible of a different construction, more natural and perfectly consistent with the previous particular grant to the patentee.

Some collateral considerations have been urged, in support of the conclusions of the court on this branch of the construction, which deserve notice. On a close scrutiny, they appear to me to amount to less, in any respect, than is supposed, and in some particulars strengthen

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the grounds of dissent. Thus, it has been said that the English Act of the fifth and sixth of William the Fourth, passed September 18, 1835, was before Congress in 1836, and was intended to be copied or adopted; and as, under that, assignees have been allowed to participate in the extended time, it has been argued that such was the intention here. But it is doubtful whether that act was before the committee when they reported the bill in 1836, as the intervening time had been short, and the eighteenth section, on examining the journals and files, appears not to have been in the bill at all as originally introduced, or as originally reported; but was afterwards inserted as an amendment in the Senate. The consideration of this section, therefore, does not seem to have been so full as of the rest of the bill; and it is very far, in language, from being a copy of the English act. Assignees are not named at all in that act; and though, in extensions under it, assignees have, in two or three cases, been allowed to participate, it has only been where an enlarged equity justified it—as where the patentee consented, or was to receive a due share in the benefits, or had clearly conferred a right in the extension by the assignment; and where, also, the assignees are expressly named in the new grant or patent as entitled to a share of it. See Webster's Patent Cases, 477.

There, also, an assignee, under like circumstances, would doubtless benefit by the renewal, under its ordinary operations; and the practice in England, thus limited, will fortify rather than weaken the construction I adopt of the true design of the last clause in our own law.

There is much, also, in another collateral consideration here, which does not apply in Great Britain, and which restricts conferring the benefit of an extension, or an extension itself, on an assignee by or under any statute, if it goes beyond what a patentee had himself contracted to do.

Here the Constitution limits the powers of Congress to give patents to inventors alone.

"The Congress shall have power to promote the progress of science and the useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." Article I, section 8.

No authority is conferred to bestow exclusive rights on others than "authors and inventors" themselves.

Hence a patent could not probably be granted to an assignee, nor an extension bestowed on one, independent of the assent or agreement of the patentee, or of its inuring to his benefit, without raising grave doubts as to its being a violation of the Constitution. But so

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far as inventors have expressly agreed that assignees shall be interested in their patents, or in the extensions of them, the latter may well be protected; and so, as far as administrators represent the inventor or patentee, when deceased, the grant to them is substantially a grant to the inventor, as the benefit then inures to his estate and heirs. But to grant an exclusive right to an assignee would confer no benefit on the patentee or his estate; and it would violate the spirit as well as letter of the Constitution unless the inventor had himself agreed to it, and had substituted the assignee for himself by plain contract, whether for the original term or any extension of it.

Cases have been cited in this country, likewise, where Congress, in ten or twelve instances, have renewed patents to the inventors; but they have never done it to assignees. And though in two out of the whole which were renewed after the term had expired and the assignees and the public were in the free use of the patent, some limitations have been imposed on requiring further payments from the assignees for the longer use of the old patent, yet in these only, and under such peculiar circumstances, has it been done, and in these no term was granted by Congress directly to the assignee rather than the patentee; and this limitation or condition in favor of the assignee, in the grant to the patentee, is of very questionable validity, unless it was assented to by the patentee. In this case, it is most significant of the views of Congress to relieve the patentee rather than assignees, that by a special law, passed February 26, 1845, they have conferred on the representative of the original patentee still another term of seven years, without mentioning the assignees in any way, and without any pretense that the benefits of this extension were designed for them.

The argument, that the assignee is sometimes a partner and makes liberal advances, furnishes a good reason, in a pecuniary view, why an assignment should be made to him of such an interest in the old patent as will indemnify him, but furnishes none for giving him, even if he regards money above public spirit or benevolence, more than an indemnity, or for giving him a benefit in any renewal, which it has never been agreed he should have, and for which he never has paid.

So, the reasoning that the assignee stands in the shoes or in the place of the patentee, and represents him, and therefore should have an interest in the extension, applies very well, so far as he is assignee, or so far as the contract extends; but he no more stands in the shoes of the patentee, beyond the extent of his contract, than an entire stranger does. Such are the cases of *Herbert v. Adams*, 4 Mason, 15, and that cited in 1 Hawk. P. C., 477, note.

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In one, the assignee of the old patent represented the patentee as to that, and that only; and in the other, where by law a further copyright was authorized in all cases, and the patentee assigned his whole interest, the second term passed also, because the law had previously given it absolutely, without contingency or evidence of losses, but in connection with or appurtenant to the first copyright.

Again, it has been urged that the assignee should have the benefit of the extension; otherwise he may have made large expenditures, in preparing for a free use of the patent after the original term expires, and will lose them in a great degree, or be obliged to pay largely for the continued use of the patent. But this same reasoning applies equally well to the whole world as to the assignee, because any individual, not an assignee, may have incurred like expenditures in anticipation of the expiration and free use of the old patent. In fact, the argument is rather a legislative than judicial one, and operates against the policy of the whole section, rather than the construction put on the last clause.

But the hardship to any person, in such case, is more apparent than real. The price to be paid for the new patent is not so much as the gain by it, and hence those who have proposed to use it, and do use it, after the extension, and pay anew for a new or further term, gain rather than lose, or they would have employed the old machinery in operation before this invention.

Nor is it any relief to the community at large, as seems by some to have been argued, to hold that the renewal, or a large part of it, vests in the assignee and grantee rather than in the patentee; for the great mass of the people must still purchase the patent, or the right to use it, of some one, and must pay as much for it to the assignee as to the patentee.

Finally, the construction of the court, by conferring any privilege whatever on assignees and grantees beyond the extent of their interests in the thing patented, when those interests, as in this case, were expressly limited in the contract to the term of the old patent, goes, in my view, beyond the language of the act, beyond the contract of assignment, beyond the consideration paid for only the old term, and beyond any intention of the legislature for relief or indemnity to others than unfortunate patentees.

I feel not a little fortified in these views on the case by several decisions and opinions that have heretofore been made, in substantial conformity to them. Indeed, independent of opinions in some of the actions now before us, (from which an appeal has been taken, or the cause has come up on a certificate of division,) every reported case on

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this subject has been settled substantially in accordance with these views. See *Woodworth v. Sherman*, and *Woodworth v. Cheever et al.*, Circuit Court for Massachusetts, May Term, 1844, decided by Justice STORY; *Van Hook v. Wood*, Circuit Court for New York, October Term, 1844, by Justice BETTS; *Wilson v. Curties & Grabon*, Circuit Court for Louisiana, by Justice McCaleb; *Brooks & Morris v. Bicknell et al.*, Circuit Court for Ohio, July Term, 1844, by Justice McLEAN (Western Law Journal, October, 1845); Butler's opinion, as Attorney-General, in Blanchard's case (Opinions of Attorneys-General, pages 1134 and 1209).

All that remains for me is to advert a moment to that branch of the construction adopted by the majority of the court, which, after giving to both assignees and grantees a benefit in the new patent or term beyond "the extent of their interests" under the contract of assignment, undertakes to go still farther, and make a discrimination between assignees and grantees, as to the enjoyment, under the renewal, of their different original interests. It gives to the latter, the grantees, by the mere force of this last clause in the eighteenth section, the enjoyment of all their old interests during the whole of the new term; but it gives to the former, the assignees, the enjoyment of only about a third portion of their old interests, during that term. In other words, it gives to "grantees of the right to use the thing patented" a continuance of all their interests; but to assignees, whose interests extended to the right to make and to vend, as well as use, the thing patented, a continuance of only a part of theirs. In such a discrimination, uncountenanced and unwarranted, as it seems to me, by either the words or the spirit of the act of Congress, I am sorry to find another strong ground of dissent to the opinion of the court. The act does not say, as is their construction, that "the benefit" of only "the right to use the thing patented" shall extend to any one, whether an assignee or grantee; but that the benefit of the renewal shall extend to both, "to the extent of their respective interests," though differing clearly in extent as they do, and as will soon be more fully shown.

"Judges are bound to take the act of Parliament as the legislature have made it." 1 D. & E., 52, and Dwarries on Statutes, 711.

But the words in this act, "the right to use the thing patented," must be transposed, and other words altered in their ordinary meaning, to make these a description of the interests conferred.

They are now a description of one kind of purchasers, that is, "grantees of the right to use the thing patented," to whom the renewal should extend, if they had stipulated for any interest therein by their



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contracts. The clause refers to two classes, who may in such case be benefited by the renewal. "Assignees" are one class, and "grantees of the right to use the thing patented" are the other class. This accords with the language itself, and also with the punctuation of this clause, as examined by me in manuscript on file in the Senate, and as printed by the State Department, having no comma or other pointing in it except after the word "patented." It accords, too, with what is well understood to be the fact, that assignees and grantees usually constitute two distinct classes of purchasers, the former being those who buy a part or all of the patent-right itself, and can protect their interests by suits in their own name; and the latter being those who buy only "the right to use the thing patented," and generally, except where the use is exclusive, (fourteenth section,) cannot institute suits in their own name for encroachments upon it. In the face of this, to hold that assignees and grantees mean the same thing here, and that the words "of the right to use the thing patented" apply equally to both, is a departure from the above established usage in employing those terms, and gives a different meaning to them from what is previously twice given in this very act. Thus, in the eleventh section, an "assignment" is mentioned as one thing, and "a grant and conveyance of the exclusive right," &c., as another; and in the fourteenth section, "assigns" are spoken of as if one class, and "grantees of the exclusive right," &c., as if another. And why does the conclusion to this clause say "to the extent of their *respective* interests therein," if such assignees and grantees as to patents were not in this very clause considered by Congress as having different interests, and that these were to be protected according to their *respective* extents? It would have said, and must be made to say, if sustaining the construction of the court, "to the extent of that *right*," or "to the extent of that *interest*," and there stop. Manifestly, then, there is not conferred on these two clauses, by this clause, either in its spirit or *in totidem verbis*, merely "the right to use the thing patented," but, on the contrary, "the benefit of the renewal," "to the extent of their respective interests in the thing patented." The interests of the grantees may be limited to the use, and those of the assignees may not be, but include the right to make and vend as well as use; yet large or long as may be the interests of either, the benefit of the renewal is to cover them, if *the extent* of them, under the original assignment or grant, reached to the new term. One is not to have the whole of his interests protected and the other a part only, when their equities are the same. But the assignee is to have to the extent of his, which is to make, vend, and use; and the grantee only "of the right to use" is to have to the extent of his.

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This, to my apprehension, is unquestionably the substance of what Congress has said on this topic; and yet it is only by supposing new language not in the act, or by transposing some of the old, so as not to be in harmony with the original structure of the sentence, or by giving a meaning to words different from what has been established, and, in my view, only by doing this, that any foundation can be laid in support of this part of the construction approved by the court. But "it is safer," said Mr. J. Ashhurst, "to adopt what the legislature have actually said, than to suppose what they meant to say." 1 D. & E., 52; 6 Adolph. & Ellis, 7.

It may be well, also, not to forget, that it is always more judicial, and less like legislation, to adhere to what Congress have actually said, and that it is more imperative to do this when, by adhering to it, you carry out, as in this case, the manifest intention of the previous part of the section. Nor can the inconsistency produced by the construction of the court be without influence in creating doubts as to its correctness; as by it "the benefit of the renewal" will be extended to assignees and grantees not in ratio with "their respective interests," (the words of the law,) nor in conformity with their respective contracts, nor according to the respective considerations they have paid, nor in proportion to the respective losses they have sustained, but, under the same general permission as to the extent of the "respective interests" of both, one class will be allowed to the full extent of his previous interest, and the other to only a part of that extent.

By what authority, let me respectfully ask, is this general permission thus divided, and in one class or case limited, and in the other not? By what legal authority are assignees cut off from a valuable portion of their interests in a patent, while grantees to use the thing patented are allowed to exercise the whole of theirs, and both under one and the same general permission, covering all "their *respective* interests"? To make this discrimination, and allow to one class the full extent of their interests, and to the other not the full extent of theirs, when the law says it shall be "to the extent of their *respective* interests," and when their respective contracts and equities show that this should include both the duration and quantity of their interests, looks like a distinction in a great degree arbitrary, and not a little in conflict with the plain words and design of the act of Congress.

But, beside this further departure from what seems to me the obvious meaning of the eighteenth section, caused by this branch of the construction of the court, it will fail, I fear, as any compromise of the difficulties arising under the section, if any compromise be expected from it. It is not likely to avert ruin from most of those indigent

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inventors who have, in their distresses, resorted for aid to the delusive provisions of that section. Their very necessities and embarrassments, which are the justification for granting the renewal to them, have usually forced them to sell and assign all the original patent, as was the case with Woodworth, in this instance; and if in such circumstances the law is to strip them of all benefits under the renewal, and, without any contract to that effect, confer those benefits on the assignees and grantees of the old patent, the law is perfectly suicidal as to the only design to be effected by its bounty. But if, seeing this, the construction is modified, as here, by the court, so as to deprive the patentee in such cases of only the benefits of the use of his old patent or old machines during the new term, this qualification in the operation of the law will, it is apprehended, usually prove a mere mockery, working, in most cases, as fully as the court's construction without the qualification would, the entire defeat of the laudable object of the renewal towards patentees. In one or two of the cases now before us, the patentee, under this construction, will still be subjected to defeat and burdensome costs. In relation to its effect on the present patent as a whole, all the consequences cannot now be ascertained. But it is admitted that the inventor had assigned the whole of the old patent, so that no right whatever to use will remain in his representatives to dispose of; or if a right remains where machines are not now in actual use, probably enough are now in use to supply, for some time, the public wants in most parts of the United States.

The right to continue to use them will probably last during the whole seven years the renewal runs, as the machine will usually, with proper repairs, do service beyond that time. It will not, then, be very difficult to calculate what value, during the seven years, will be derived from the right to make and vend machines, when the use of others already in existence is scattered over every section of the country, and they may be employed all the time of the extended patent, without the assignees or grantees ever having paid, or being obliged to pay, a dollar for that extended use.

Looking, then, to the beneficent design of the eighteenth section, to enforce the Constitution, by advancing science and the arts, and protecting useful inventions, through the security for a longer term to men of genius of a property in their own labors, in cases where they had not been already remunerated for their time and expenses, I cannot but fear that the construction given by the majority of the court will prove most unfortunate. It will tend to plunge into still deeper embarrassment and destitution, by losses in litigation and by depriva-

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tion of a further extended sale of their inventions, those whose worth and poverty induced Congress to attempt to aid them.

Nor would a different construction tie up, as some suppose, the future use of numerous patents. Of the fourteen thousand five hundred and twenty-six heretofore issued, since the Constitution was adopted, I am enabled, by the kindness of the Commissioner of Patents, to state that only ten have been renewed under the eighteenth section during nearly ten years it has been in operation.

And if the individuals who use the improved machines, the fruit of the toil and expense and science of others, were obliged in but one case in a year, over the whole country, to pay something for that further use, is it a great grievance? They are not obliged to employ the patent at all, and will not, unless it is better by the amount they pay than what was in use before. And is it a great hardship, or inequitable, where they are benefited by another's talents, money, and labor, to compensate him in some degree therefor?

While other countries, and Congress, and our State courts are adopting a more liberal course yearly towards such public benefactors as inventors, I should regret to see this high tribunal pursue a kind of construction open to the imputation of an opposite character, or be supposed by any one to evince a feeling towards patentees which belongs to other ages rather than this, (and which I am satisfied is not cherished,) as if patentees were odious monopolists of the property and labors of others, when in truth they are only asking to be protected in the enjoyment and sale of their own,—as truly their own as the wheat grown by the farmer, or the wagon built by the mechanic.

Nor should we allow any prejudices against the utility of patents generally, and much less against the utility of the invention now under consideration, to make our constructions more rigid in this case. The settled doctrine of the courts now, under the lights of longer experience, though once otherwise, is, in doubtful cases, to incline to constructions most favorable to patentees. *Grant et al. v. Raymond*, 6 Peters, 218; 1 Sumner, 485; *Wyeth v. Stone*, 1 Story's Rep., 287; *Blanchard v. Sprague*, 2 Story's Rep., 169. Nor is it strange that this should be the case in the nineteenth century, however different it was some generations ago, when we daily witness how the world has been benefited since by the patented inventions and discoveries in steam, in all its wonderful varieties and utilities, and in cleaning, spinning, and weaving cotton by machinery for almost half the human race, and in myriads of other improvements in other things, shedding so benign a light over the age in which we live, and most

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of them excited and matured only under the protection secured to their inventions by an enlightened government.

Some estimate can be formed of the usefulness of the present patent, and its title to favor, when one machine is computed to perform the labor of planing and grooving in one day that would require fifty days by a man, and which is supposed to reduce near seven-tenths of the expense of such work in every building where the improved method is used,—as it ere long will be by the many millions of our own population; and in time over the civilized world. Every honest social system must shield such inventions, and every wise one seeks undoubtedly to encourage them.

To be liberal, then, in the protection of patentees, is only to be just towards the rights of property. To stimulate them in this and other ways to greater exertions of ingenuity and talent, is to increase the public wealth, and hasten the progress of practical improvements, as well as of science. And to discountenance encroachments on their rights, and defeat piracies of their useful labors, is calculated in the end to better the condition of every rank in society, and introduce wider and faster all the benefits of a superior state of civilization and the arts.

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ANDREW P. SIMPSON, JOSEPH FORSYTH, AND BAGDAD MILLS, APPELLANTS, v. JAMES G. WILSON.

(4 Howard, 709.)

1. The decision of the court in the preceding case of *Wilson v. Rousseau et al.*, namely, that when a patent is renewed, under the act of 1836, an assignee under the old patent has a right to continue the use of the patented machine, but not to vend others, again affirmed.
2. An assignment of an exclusive right to use a machine, and to vend the same to others for use, within a specified territory, authorizes the assignee to vend elsewhere, out of the said territory, the product of said machine.
3. The restriction upon the assignee is only that he shall use the machine within the specified territory. There is none as to the sale of the product.

THIS case came up on a certificate of division in opinion between the judges of the Circuit Court of the United States for the District of Louisiana, sitting as a court of equity.

Wilson was the complainant below, who filed a bill, and obtained an injunction against Simpson, Forsyth, and Mills. After sundry proceedings in the case, Forsyth put in a plea, and a rule was obtained that the plaintiff should show cause why the injunction should not be

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dissolved. Upon argument, the court dismissed the rule, and the case was set down for hearing, by consent of parties, the complainants not admitting the facts alleged in the plea, but for the purpose of raising the questions of law which they involved, and obtaining a speedy decision of the same.

Upon the argument, the division of opinion arose which will be presently stated.

The facts in the case were these:

The patent for planing, &c., having been obtained by Woodworth in 1828, as has been particularly mentioned in the report of the preceding case of *Wilson v. Rousseau et al.*, Forsyth, one of the defendants below, became an assignee under that patent for all its rights within the county of Escambia, in West Florida. This took place in 1836.

Woodworth, the patentee, having died, his administrator, in 1842, obtained a renewal of the patent under the act of 1836, and, in 1843, assigned to Wilson, the complainant below, all the rights under the extended patent for the States of Louisiana, Alabama, and the Territory of Florida.

On the 13th of April, 1844, the said Wilson instituted proceedings in equity, in the Circuit Court of Louisiana, against the defendants, on the ground that they infringed on his just rights, by setting up and putting in operation the said patented machines in the Territory of Florida, and by vending in New Orleans large quantities of dressed lumber, plank, &c., the product of the machines there established.

In May, 1845, the cause came up for hearing, as above stated, when the following points were ordered to be certified to this court, namely:

“J. G. WILSON  
v.  
SIMPSON ET AL. } No. 1,225.

“This case coming on to be heard, on demurrer filed to the plea of Joseph Forsyth, one of the defendants, set down for hearing by consent, and the matters of law arising on said plea, the following points became material to the decision, and, being considered, the court were divided in opinion on the following points:

“1. Whether, by law, the extension and the renewal of the said patent, granted to William Woodworth, and obtained by William W. Woodworth, his executor, inured to the benefit of said defendant, to the extent that said defendant was interested in said patent before such renewal and extension.

“2. Whether, by law, the assignment of an exclusive right to the defendant, by the original patentee, or those claiming under him, to

## Order.

use said machine, and to vend the same to others for use, within the county of Escambia, in the Territory of West Florida, did authorize said defendant to vend elsewhere than in said county of Escambia, to wit, in the city of New Orleans, State of Louisiana, plank, boards, and other materials product of a machine established and used within the said county of Escambia, in the Territory of West Florida.

“Wherefore, upon the request of defendants’ counsel, it is ordered and directed that the foregoing points of law be certified for the opinion of the Supreme Court of the United States.”

The case was argued by *Gilpin* and *Westcott*, for the defendants below, who were the appellants in this court, and by *Henderson* and *R. Johnson*, for Wilson.

Mr. Justice NELSON delivered the opinion of the court.

The questions in this case come up on the certificate of a division of opinion in the court below. The judgment of this court in the previous case of *Wilson v. Rousseau et al.*, upon the second question certified in that case, disposes of the first question certified here, and is answered accordingly.

The second question certified involves the point, whether or not the assignment of an exclusive right to make and use, and to vend to others, planing-machines, within a given territory only, authorizes the assignee to vend elsewhere, out of the said territory, the plank, boards, and other materials the product of said machines.

The court have no doubt but that it does; and that the restriction in the assignment is to be construed as applying solely to the using of the machine. There is no restriction as to place of the sale of the product. Certificate accordingly to the court below.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Louisiana, and on the points and questions on which the judges of the said Circuit Court were opposed in opinion, and which were certified to this court for its opinion agreeably to the act of Congress in such case made and provided, and was argued by counsel; on consideration whereof, it is the opinion of this court—1. That, by law, the extension and renewal of the said patent granted to William Woodworth, and obtained by William W. Woodworth, his executor, did not inure to the benefit of said defendant to the extent that said defendant was interested in said patent before such renewal and extension; but the law saved to persons in the use of machines at the time the extension

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Opinion of the court.

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takes effect the right to continue the use. 2. That an assignment of an exclusive right to use a machine, and to vend the same to others for use, within a specified territory, does authorize an assignee to vend elsewhere, out of the said territory, plank, boards, and other materials the product of such machine.

It is, therefore, now here ordered and decreed by this court, that it be so certified to the said Circuit Court.

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JAMES G. WILSON, COMPLAINANT AND APPELLANT, v. JOSEPH TURNER, JUNIOR, AND JOHN C. TURNER, DEFENDANTS.

(4 Howard, 712.)

The decision of the court in the two preceding cases, namely, that where a patent is renewed, under the act of 1836, an assignee under the old patent has a right to continue the use of the machine which he is using at the time of the renewal, again affirmed.

THIS case came up by appeal from the Circuit Court of the United States for the District of Maryland, sitting as a court of equity.

The bill was filed by Wilson, as the assignee of William W. Woodworth, the administrator of Woodworth, the patentee, as stated in the report of the preceding case. It set out the patent and assignment, and then prayed for an injunction and account.

The answer referred to the mutual assignment made between Woodworth and Strong on the one part, and Toogood, Halstead, Tyack, and Emmons of the other part, which was recited in the preceding case, and traced title regularly down from these latter parties to the defendants.

A statement of these facts was agreed upon by counsel, and all the documents set forth at length; and upon this statement, together with the bill and answer, the cause was argued.

At April Term, 1845, the court dismissed the bill, and from this decree the case was brought up by appeal to this court.

It was argued by *Phelps* and *Webster*, for Wilson, the appellant, and *Schley*, for the appellees, who were the defendants below.

Mr. Justice NELSON delivered the opinion of the court.

The judgment of the court in the previous case of *Wilson v. Rousseau et al.* disposes of the question in this case, and affirms the decree of the Circuit Court.



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Statement of the case.

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WILLIAM W. WOODWORTH, ADMINISTRATOR, &C., AND E. V. BUNN, ASSIGNEE, COMPLAINANTS AND APPELLANTS, v. JAMES, BENJAMIN, AND ALPHEUS WILSON.

(4 Howard, 712.)

1. An objection to the validity of Woodworth's patent for a planing-machine, namely, that he was not the first and original inventor thereof, is not sustained by the evidence offered in this case.
2. Nor is the objection well founded, that the specifications accompanying the application for a patent are not sufficiently full and explicit, so as to enable a mechanic of ordinary skill to build a machine.
3. An assignee of the exclusive right to use ten machines within the city of Louisville, or ten miles around, may join his assignor with him, in a suit for a violation of the patent-right, under the circumstances of this case.

THE bill was filed in this case in the Circuit Court for the District of Kentucky, by the complainants, setting forth that William Woodworth was the inventor and patentee of a certain planing-machine, describing it; also, the extension of the said patent to W. W. Woodworth, as administrator, and that E. V. Bunn, one of the complainants, took an assignment from the said W. W. Woodworth for the exclusive right of making, using, and vending machines for planing, &c., under the extension of the patent, within the limits of the city of Louisville, and in the district of country ten miles around said city.

The bill further charges that the defendants have, in violation of the rights of the complainants, erected and put in operation, in the city of Louisville, a planing-machine, &c., which machine is, in all its material parts, substantially like and upon the plan of the machine of the complainants, and persists in using the same.

The defendant, James Wilson, answered the bill, substantially denying most of the material allegations contained in it. The other defendants answered, by denying that they had any interest in the machine.

The court granted an injunction, enjoining the defendant, James Wilson, from using the machine.

Afterwards, an application was made to the court, on behalf of the complainants, for a rule upon the defendant, James Wilson, to show cause why an attachment should not be issued against him for a violation of the injunction, which was accordingly granted.

The defendant showed cause by affidavit, in which he affirms that immediately on the service of the injunction he had ceased to use the machine mentioned in the bill, and conformed himself to the order of the court, and that he had purchased and set up Bicknell's planing-

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machine, which he was using, and which was substantially different from the machine of the complainants.

Much testimony was taken in the court below, on the question whether the machine which the defendant had substituted and was using was, in all its material and substantial parts, like Woodworth's, which it is not material to refer to more particularly. A great deal of testimony was also taken, for the purpose of showing that Woodworth was not the original inventor of the complainants' machine, which it is also not necessary to recite.

The cause afterwards came to a hearing on the merits, upon the pleadings and proofs, and also upon the rule previously granted against the defendant, to show cause why an attachment should not issue for a violation of the injunction, and, after consideration, the court dissolved the injunction and dismissed the bill, and discharged the rule to show cause, with costs.

As the opinion of the court refers, in general terms, to the interest of Woodworth under the assignment, as a justification for his being joined as a party in the suit, it is proper to set forth the assignment, which was as follows:

*“ Transfer from Woodworth, Administrator, &c., to E. V. Bunn.*

“ Whereas, William Woodworth, now deceased, did, in his lifetime, obtain letters patent, issued under the great seal of the United States, bearing date the 27th day of December, 1828, giving and granting to him, the said Woodworth, his heirs, administrators, and assigns, for and during the term of fourteen years from the date of the said letters patent, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used a certain improved method for planing, tonguing, grooving, and cutting into mouldings, or either plank, boards, or any materials, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings in or facing metallic, mineral, or other substances;

“ And whereas, William W. Woodworth, administrator of said William Woodworth, hath applied for and obtained an extension of said letters patent for the term of seven years from and after the expiration of said patent, to wit, the 27th day of December, 1842, pursuant to an act of Congress in such case made and provided, and hath a certificate of said extension annexed to said patent, signed by the Commissioner of Patents, under the great seal of the Patent Office of the United States, and dated November 16th, A. D. 1842; and whereas, E. V. Bunn, of the city of Louisville, in the State of Kentucky, hath

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fully viewed, examined, and considered for himself the said improvement, and, of his own motion, hath requested and desired the said William W. Woodworth, administrator of said William Woodworth, deceased, to give a license and permission, in writing, for constructing and using machines on the said improved plan in the city of Louisville aforesaid, including the district of country within ten miles of said city, and in no other city, town, or place in the United States, or the territories thereof, on the conditions hereinafter mentioned, and have offered to pay him the sum of fifteen hundred dollars for such license and consent in writing, with which request and desire the said William W. Woodworth, administrator of William Woodworth, deceased, has agreed to comply:

“Now, know all men by these presents, that the said W. W. Woodworth, administrator of William Woodworth, deceased, in consideration of the said sum of fifteen hundred dollars, secured to be paid to him, the said William W. Woodworth, administrator of William Woodworth, deceased, doth hereby give his full consent and permission, in writing, and license to the said E. V. Bunn, and to his executors, administrators, and assigns, to construct and use, during the said extension of the aforesaid patent, ten planing-machines on the improved plan aforesaid, within the city of Louisville, and including the district of country within ten miles of said city, and in no other city, town, or place within the United States or the territories thereof; and also, within said limits, to dispose of the plank or other things dressed and prepared in the said machines. And he doth also hereby authorize and empower the said E. V. Bunn, and his executors, administrators, and assigns, in the name of said Woodworth, administrator aforesaid, or in his own name, to commence and prosecute to final judgment any suit or suits against any person or persons who shall construct or use the said improvements within the said limits, contrary to the true meaning and intent of the aforesaid letters patent, and the extension thereof, and the law in such case made and provided; and to receive for his own benefit, and at his own proper costs and charges, any penalty or penalties which he may recover. And, in consideration of the premises, it is hereby covenanted and agreed, by and between the said William W. Woodworth, administrator of William Woodworth, deceased, his executors, administrators, and assigns, of the one part, and the said E. V. Bunn, his executors, administrators, and assigns, of the other part, as follows, namely:

“1st. That the said William W. Woodworth, administrator of William Woodworth, deceased, his executors or administrators, during the terms aforesaid, shall not, nor with themselves, construct or use, nor

give their license, consent, and permission to any other person than the said E. V. Bunn to construct or use, the improved planing-machine aforesaid, within the said city of Louisville, or within the district of country within ten miles of said city.

"2d. That the said E. V. Bunn, his executors, administrators, and assigns, shall not nor will, during the times aforesaid, construct or use more than ten machines as aforesaid within the limits above mentioned, nor construct or use any such machines, nor sell and dispose of any plank or other thing dressed and prepared in such machine anywhere else within the United States and the territories thereof; it being declared to be the true intent and meaning of these presents that not more than ten planing-machines in the whole shall be constructed and used, by virtue of the license, consent, and permission herein given.

"3d. It is understood and agreed that the said William W. Woodworth has entered and filed, at the Patent Office at Washington, a disclaimer of that part of said patent for the planing-machine which claims the reduction of materials, boards, and plank to an equal width and thickness by circular saws; and a lien is retained and renewed on this assignment for the security of the payment of the fifteen hundred dollars, the consideration and purchase-money to be paid to said Woodworth.

"Signed, sealed, and delivered this 21st day of June, 1843.

[SEAL.]

"W. W. WOODWORTH,

*"Administrator of W. Woodworth, deceased.*

"The words 'to him in hand paid by the said' were erased, and the word 'ten,' and the words 'in the name of said Woodworth, administrator aforesaid, or in his own name,' were interlined before the execution of the foregoing instrument, in presence of D. E. Sickles."

The cause was argued by *Latrobe* and *Staples*, for the complainants, Woodworth and Bunn, and by *Bibb*, for the defendants.

Mr. Justice NELSON delivered the opinion of the court.

The objection taken, that the administrator could not apply for an extension of the patent granted to Woodworth, his intestate, under the eighteenth section of the Patent Law, has been disposed of in the previous case of *Wilson v. Rousseau et al.*, and need not be further noticed.

Another objection taken to the right of the complainants to maintain the suit, is that Woodworth was not the first and original inventor of the planing-machine, against the using of which the defendant was enjoined.

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Syllabus.

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Without going into the proofs in the case, which are very voluminous, it will be sufficient to state that, after fully considering all the evidence produced bearing upon the question, the court is satisfied that the weight of it is decidedly against the objection, and in favor of the allegation in the bill, that Woodworth was the original inventor of the machine.

It is objected, also, that the specifications accompanying the patent were not sufficiently full and explicit, so as to enable a mechanic of ordinary skill to build a machine. The court is not satisfied, according to the proof in the case, that the objection is well founded, and it cannot be relied on as affording sufficient ground for the dismissal of the bill.

A further objection was taken, that W. W. Woodworth, one of the complainants, was improperly joined with E. V. Bunn, the assignee of the exclusive right in Louisville and ten miles around it. The court is of opinion that the interest of Woodworth in the assignment, as appears from the record, is sufficient to justify his being made a party jointly with the assignee.

Some other objections were taken to the maintenance of the suit on the argument, which it is not material to notice particularly. They have all been considered, and, in the judgment of the court, afford no sufficient ground for the dismissal of the bill and the dissolving of the injunction.

We think the court erred, and that the decree dismissing the bill, as to the defendant James Wilson, and dissolving the injunction, should be reversed, and that a perpetual injunction should issue.

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JAMES WOOD, PLAINTIFF IN ERROR, v. WILLIAM A. UNDERHILL AND  
ASCHEL H. GEROW, DEFENDANTS.

(5 Howard, 1.)

1. In order to obtain a patent, the specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention, without making any experiments of his own.
2. If the patent be for a new composition of matter, and no relative proportions of the ingredients are given, or they are stated so ambiguously and vaguely that no one could use the invention without first ascertaining, by experiment, the exact proportion required to produce the result, it would be the duty of the court to declare the patent void.
3. But the sufficiency of the description in patents for machines, or for a new composition of matter; where any of the ingredients do not always possess exactly

## Statement of the case.

the same properties in the same degree, is generally a question of fact, to be determined by the jury.

4. Where a patent was obtained for a new improvement in the mode of making brick, tile, and other clay ware, and the process described in the specification was to mix pulverized anthracite coal with the clay, before moulding it, in the proportion of three-fourths of a bushel of coal-dust to one thousand brick, some clay requiring one-eighth more, and some not exceeding half a bushel, this degree of vagueness and uncertainty was not sufficient to justify the court below in declaring the patent void.
5. The court should have left it to the jury to say, from the evidence of persons skilled in the art, whether the description was clear and exact enough to enable such persons to compound and use the invention.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Southern District of New York.

It appeared that, in the year 1836, Wood took out amended letters patent for "a new and useful improvement in the mode of making brick, tile, and other clay ware," and filed the following specification of his invention:

"Be it known, that I, the said James Wood, have invented a new and useful improvement in the art of manufacturing bricks and tiles. The process is as follows: Take of common anthracite coal, unburnt, such quantity as will best suit the kind of clay to be made into brick or tile, and mix the same, when well pulverized, with the clay before [it] is moulded. That clay which requires the most burning will require the greatest proportion of coal-dust. The exact proportion, therefore, cannot be specified; but, in general, three-fourths of a bushel of coal-dust to one thousand brick will be correct. Some clay may require one-eighth more, and some not exceeding a half-bushel. The benefits resulting from this composition are the saving of fuel, and the more general diffusion of heat through the kiln, by which the whole contents are more equally burned. If the heat is raised too high, the brick will swell, and be injured in their form. If the heat is too moderate, the coal-dust will be consumed before the desired effect is produced. Extremes are therefore to be avoided. I claim as my invention the using of fine anthracite coal, or coal-dust, with clay, for the purpose of making brick and tile as aforesaid, and for that only claim letters patent from the United States.

"JAMES WOOD.

"Dated 9th November, 1836."

In July, 1842, he brought a suit against the defendants in error, for a violation of this patent.

And at the trial the defendant objected to the sufficiency of the specification, "because no certain proportion for the mixture is point-

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Argument for the plaintiff in error.

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ed out, but only that such quantity of coal must be taken as will best suit the kind of clay to be made into brick or tile; but that clay which requires most burning will require the greatest quantity of coal-dust. The exact proportion cannot, therefore, be specified; but, in general, three-fourths of a bushel of coal-dust to one thousand brick will be correct. Some clay may require one-eighth more, and some not exceeding half a bushel; so that there is no fixed rule by which the manufacturer can make the mixture, but that must be ascertained by experiments upon the clay; and the claiming clause in the specification is only for the abstract general principle of mixing anthracite coal-dust with clay, for the purpose of making brick, without any practical rule as to the proportions, which is too vague and uncertain to sustain a patent,"—which objection was sustained by the court. The plaintiff excepted. And the verdict and judgment being against him, the case was brought up here upon this exception.

The cause was argued by *Silliman*, for the plaintiff in error, and *Rowley*, for the defendants.

*Silliman*, for the plaintiff in error, made the following points:

The plaintiff insists—

1. That he has, in his specification, given a general rule by which every kind of clay may be much better burned than by any previous process; and that the general proportions specified are, with some exceptions, the very best that can be used.

That a patent may properly be granted for a *beneficial general rule*, although there might be some exceptions to it not provided for.

2. That if it is necessary to entitle the plaintiff to a patent for a most beneficial invention for burning clay of the qualities usually found, that he should also discover the means of burning, to best advantage, clays of qualities not usually found, that his patent should not therefore be deemed void on its face; but he should be permitted to prove, by persons conversant with the business, that they could instantly determine, on inspection of clays of uncommon qualities, whether they required more or less than the usual burning, and how much more or less, so as to regulate the variation of proportions in such manner as to burn to the best advantage.

3. The plaintiff should have been permitted to show, under his specification, by *experts*, that any kind of clay of which bricks can be made, however varied the qualities, can be better burnt under his general rule than by any previous process; and if such is the fact, the plaintiff should be entitled to a patent for the discovery, if he had

given the general rule only, and had taken no notice of those exceptions, in which some uncommon kinds of clay can be best burned with a greater or less proportion of coal than that specified in the general rule.

4. The judge, in his decision, adopts all the errors of the defendants' objection, which states that there is no fixed rule by which the manufacturer can make the mixture, but that must be ascertained by experiments upon the clay. Suppose this to be so, and that the inventor has only furnished a guide by which such experiments can be successfully made, and that the subject, on account of the variable qualities of the materials, does not admit of greater certainty, and that by the simplest and cheapest experiments the manufacturer, in consequence of the plaintiff's invention, will be able to burn his bricks much better in less than half the time, and at less than half the cost of burning, by any other process, is not the inventor entitled to a patent for an invention practically so useful?

The fact that not a single brick has, for some years past, been burned, except according to the plaintiff's specification, is pretty good evidence that the manufacturers have been able to discover something from plaintiff's specification.

5. The objection, as adopted by the court, declares that the claiming clause in the specification is only for the abstract general principle of mixing anthracite coal-dust with clay, for the purpose of making bricks and tiles, without any practical rule as to the proportions, which is too vague and uncertain to sustain a patent. Suppose this objection true in point of fact, and that no information had been intentionally suppressed, and that the qualities of clay varied so much that the proportions most useful could only be ascertained by an experiment on each bed of clay, it might, nevertheless, be a very useful invention, for which the inventor should be in some measure compensated by a patent. But this part of the objection is not true in fact; for the claiming clause is of the invention of using fine anthracite coal, or coal-dust, with clay, for the purpose of making brick and tile "*as aforesaid*." These words, "*as aforesaid*," refer to the general rule of three-fourths of a bushel of coal for a thousand bricks, with the exceptions or variations previously expressed.

6. The judgment should be reversed, with costs, including the costs in the Circuit Court.

*Rowley, for the defendants in error.*

The patentee's specification is uncertain and insufficient. It furnishes no rule for making bricks, without the manufacturer's first



## Opinion of the court.

making a series of experiments. The most it does is to prescribe in about what manner the trials are to be conducted, which is not enough to sustain his patent. *The King v. Arkwright*, Dav. Pat. Cases, 106 (per Buller, J.); *Turner v. Winter*, 1 Term R., 606 (per Ashurst, J.); *Boulton v. Bull*, 2 H. Bl., 484 (Buller, J.); *Harmer v. Playne*, 11 East, 101 (Lord Ellenborough); *The King v. Wheeler*, 2 Barn. & Ald., 345 (Abbott, Ch. J.); Godson on Patents, 85; *Lowell v. Lewis*, 1 Mason's R., 182 (Story, J.); *Langdon v. De Groot*, 1 Paine's R., 203; Phillips on Patents, 83, 267, 268, 283, 284, 289.

Mr. Chief Justice TANEY delivered the opinion of the court.

The question presented in this case is a narrow one, and may be disposed of in a few words.

The plaintiff claims that he has invented a new and useful improvement in the art of manufacturing bricks and tiles; and states his invention to consist in using fine anthracite coal, or coal-dust, with clay, for the purpose of making brick or tile; and for that only he claims a patent. And the only question presented by the record is, whether his description of the relative proportions of coal-dust and clay, as given in his specification, is upon the face of it too vague and uncertain to support a patent.

The degree of certainty which the law requires is set forth in the act of Congress. The specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention; that is to say, to compound and use it without making any experiments of his own. In patents for machines, the sufficiency of the description must, in general, be a question of fact, to be determined by the jury. And this must also be the case in compositions of matter, where any of the ingredients mentioned in the specification do not always possess exactly the same properties in the same degree.

But when the specification of a new composition of matter gives only the names of the substances which are to be mixed together, without stating any relative proportion, undoubtedly it would be the duty of the court to declare the patent to be void. And the same rule would prevail where it was apparent that the proportions were stated ambiguously and vaguely; for in such cases it would be evident, on the face of the specification, that no one could use the invention without first ascertaining by experiment the exact proportion of the different ingredients required to produce the result intended to be obtained. And if the specification before us was liable to either of

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Order.

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these objections, the patent would be void, and the instruction given by the Circuit Court undoubtedly right.

But we do not think this degree of vagueness and uncertainty exists. The patentee gives a certain proportion as a general rule; that is, three-fourths of a bushel of coal-dust to one thousand bricks. It is true, he also states that clay which requires the most burning will require the greatest proportion of coal-dust; and that some clay may require one-eighth more than the proportions given, and some not more than half a bushel, instead of three-fourths. The two last mentioned proportions may, however, be justly considered as exceptions to the rule he has stated; and as applicable to those cases only where the clay has some peculiarity, and differs in quality from that ordinarily employed in making bricks. Indeed, in most compositions of matter, some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must sometimes be in some degree superior or inferior to those most commonly used. In this case, however, the general rule is given with entire exactness in its terms; and the notice of the variations mentioned in the specification would seem to be designed to guard the brick-maker against mistakes, into which he might fall if his clay was more or less hard to burn than the kind ordinarily employed in the manufacture.

It may be, indeed, that the qualities of clay generally differ so widely that the specification of the proportions stated in this case is of no value; and that the improvement cannot be used with advantage in any case, or with any clay, without first ascertaining by experiment the proportion to be employed. If that be the case, then the invention is not patentable, because, by the terms of the act of Congress, the inventor is not entitled to a patent unless his description is so full, clear, and exact as to enable any one skilled in the art to compound and use it. And if, from the nature and character of the ingredients to be used, they are not susceptible of such exact description, the inventor is not entitled to a patent. But this does not appear to be the case on the face of this specification. And whether the fact is so or not, is a question to be decided by a jury, upon the evidence of persons skilled in the art to which the patent appertains. The Circuit Court, therefore, erred in instructing the jury that the specification was too vague and uncertain to support the patent, and its judgment must be reversed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern

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District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

PETER HOGG AND CORNELIUS H. DELAMATER, PLAINTIFFS IN ERROR,  
v. JOHN B. EMERSON.

(6 Howard, 437.)

1. When a case is sent to this court under the discretion conferred upon the court below by the seventeenth section of the act of July 4, 1836, (Patent Law,) 5 Statutes at Large, 124, the whole case comes up, and not a few points only.
2. The specification constitutes a part of a patent, and they must be construed together.
3. Emerson's patent for "certain improvements in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land," decided not to cover more ground than one patent ought to cover, and to be sufficiently clear and certain.
4. A patentee whose patent-right has been violated may recover damages for such infringement for the time which intervened between the destruction of the Patent Office by fire, in 1836, and the restoration of the records under the act of March 3, 1837.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Southern District of New York. It was a suit for the violation of a patent-right, and the writ of error was allowed under the seventeenth section of the act of 1836.

On March 8th, 1834, John B. Emerson, the defendant in error, obtained the following letters patent, (which were recorded anew on the 5th of March, 1841,) namely:

"The United States of America to all to whom these letters patent shall come:

"Whereas, John B. Emerson, a citizen of the United States, hath alleged that he has invented a new and useful improvement in the steam-engine, which improvement he states has not been known or used before his application; hath made oath that he doth verily believe that he is the true inventor or discoverer of the said improvement; hath paid into the treasury of the United States the sum of thirty dollars, delivered a receipt for the same, and presented a peti-

## Statement of the case.

tion to the Secretary of State, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: These are, therefore, to grant, according to law, to the said John B. Emerson, his heirs, administrators, or assigns, for the term of fourteen years from the eighth day of March, one thousand eight hundred and thirty-four, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said John B. Emerson himself, in the schedule hereto annexed, and is made a part of these presents.

"In testimony whereof, I have caused these letters to be made patent, and the seal of the United States to be hereunto affixed.

"Given under my hand, at the city of Washington, this eighth day of March, in the year of our Lord one thousand eight hundred and thirty-four, and of the independence of the United States of America the fifty-eighth.

[SEAL.]

"ANDREW JACKSON.

"By the President.

"LOUIS McLANE, *Secretary of State.*"

*City of Washington, to wit:*

I do hereby certify that the following letters patent were delivered to me on the eighth day of March, in the year of our Lord one thousand eight hundred and thirty-four, to be examined; that I have examined the same, and find them conformable to law; and I do hereby return the same to the Secretary of State, within fifteen days from the date aforesaid, to wit, on this eighth day of March, in the year aforesaid.

B. F. BUTLER,

*Attorney-General of the United States.*

The schedule referred to in these letters patent, and making part of the same, containing a description, in the words of the said John Brown Emerson himself, of his improvement in the steam-engine:

"To all whom it may concern: Be it known, that I, John Brown Emerson, of the city of New York, have invented certain improvements in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land, and that the following is a full and exact description thereof:

"One object of my improvement is to substitute for the crank motion a mode of converting the reciprocating motion of a piston into a continued rotary motion, by a new combination of machinery for that purpose.

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"This mode is applicable to an engine either with one or with two cylinders, and is carried into effect as follows: Alongside of the cylinder I place a shaft, the lower end of which may revolve in a step on the platform or foundation upon which the cylinder stands, in which case it must be somewhat longer than twice the length of the cylinder, as it must extend above it to a height somewhat greater than the length of the stroke of the piston. Sometimes, however, this shaft may have its lower gudgeon only a small distance below the upper end of the cylinders, whence it must extend above it, as before. Its upper gudgeon must of course be sustained by a suitable frame. This shaft is to stand parallel to the piston-rod, from which it is to receive its revolving motion. Upon the upper end of the shaft, above the top of the cylinder, there is to be placed a solid cylinder of wood, or of any other convenient substance, of such diameter as shall cause its periphery to come nearly into contact with the piston-rod for its whole length, when the piston is raised. The solid cylinder above described is to be made to revolve in the following manner: I make a groove in it, which commences near its lower end, and, passing spirally, extends half-way round it by the time it reaches nearly to the upper end, or to a distance vertically equal to the stroke of the engine; from that point it passes down around the opposite half, and returns into itself at the point of beginning. Upon the upper end of the piston, against its side, I place a friction-roller, which is to work in the groove in the solid cylinder; the piston-rod rising between parallel guide-pieces, by which it is kept in its proper place, and its tendency to turn round by the action of the roller in the groove is checked. When the piston is down, this friction-roller will stand in the V formed by the junction of the grooves on the opposite sides, and, as it is raised, it will in its passage to the upper junction give half a revolution to the solid cylinder, and in descending will complete the revolution by the action of the friction-roller on the other portion of the groove.

"When two cylinders are used, they are to be placed parallel to each other, and at such a distance apart that the pistons of each may, in like manner, act upon the solid cylinder, the piston of one being up when the other is down. The boiler, the steam-pipe, the valves for the admission and discharge of steam, and other appendages, may be similar to some of those already in use. From the revolving shaft already described, a rotary motion may be communicated to paddle-wheels, steam-carriages, or other objects. As it is my intention, in general, to place my cylinders and revolving shaft vertically, I communicate motion to the horizontal shaft of a paddle-wheel by means of bevel-gear wheels near the lower end, or at any convenient part

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of the shaft; and by similar gearing, carriages may be propelled upon rail or ordinary roads.

“When used for steamboats, I employ an improved spiral paddle-wheel, differing essentially from those which have heretofore been essayed. This spiral I make by taking a piece of metal of such length as I intend the spiral propeller to be, and of a suitable width, say, for example, eighteen inches; this I bend along the center, so as to form two sides, say of nine inches in width, standing at right angles, or nearly so, to each other, and give to it, longitudinally, the spiral curvature which I wish. Of these pieces I prepare two or three, or more, and fix them on to the outer end of the paddle-shaft, by means of arms of a suitable length, say of two feet, more or less, in such a position that the trough-form given to them longitudinally shall be effective in acting upon the water. It must be entirely under water, and operate in the direction of the boat’s way. Instead of metal, the spiral propeller may be formed of wood, and worked into the proper form,—the shape, and not the material thereof, being the only point of importance.

“Where a capstan is required, as on board of a steamboat, I allow the upper end of the vertical shaft before described to pass through the deck of the vessel, and attach the capstan thereto, so that it may be made to revolve by the action of the shaft, using such ray-wheels and falls to connect the shaft and the capstan as will allow of their being conveniently engaged and disengaged.

“What I claim as my invention, and for which I ask a patent, is the substituting for the crank in the reciprocating engine a grooved cylinder, operating in the manner hereinbefore described, by means of its connection with the piston-rod, together with all the variations of which this principle is susceptible,—as, for example, a bar of metal may be bent in the form of a groove, and attached to the revolving shaft, and friction-wheels on the piston-rod may embrace this on each side, producing an effect similar to that produced by the groove. I also claim the spiral propelling-wheel, contracted and operating in the manner in which I have set forth; and likewise the application of the revolving vertical shaft to the turning of a capstan on the deck of a vessel. Not intending, in either of these parts, to confine myself to precise forms or dimensions, but to vary them in such manner as experience or convenience may dictate, whilst the principle of action remains unchanged, and similar results are produced by similar means.

“JOHN BROWN EMERSON.”

At April Term, 1844, Emerson brought an action of trespass on

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the case in the Circuit Court of the United States for the Southern District of New York, against Hogg and Delamater, for an infringement of his patent-right. As one of the points decided by the court was whether or not the allegations of the declaration corresponded with the evidence of the patent, it is thought proper to insert the declaration. It was as follows, namely :

“John B. Emerson, a citizen of the State of New York, by Peter Clark, his attorney, complains of Peter Hogg and Cornelius Delamater, citizens of the same State, defendants, in custody, &c., of a plea of trespass on the case :

“For that, whereas the said plaintiff was the original inventor of a certain new and useful improvement, in the letters patent hereinafter mentioned and fully described, the same being a certain improvement in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land, which was not known or used before his said invention, and which was not, at the time of his application for a patent, as hereinafter mentioned, in public use with his consent or allowance. And the said plaintiff, being so as aforesaid the inventor thereof, and being also a citizen of the United States, on the eighth day of March, one thousand eight hundred and thirty-four, upon due application therefor, did obtain certain letters patent therefor, in due form of law, under the seal of the United States, signed by Andrew Jackson, then President, and countersigned by Louis McLane, then Secretary of State, bearing date the day and year aforesaid, whereby there was secured to him, the said plaintiff, his heirs, executors, administrators, or assigns, for the term of fourteen years from and after the date of the said patent, the exclusive right and liberty of making, using, and vending to others to be used the said improvement, as by the said letters patent in court to be produced will fully appear. And the said plaintiff further says that the said defendants, well knowing the said several premises, but contriving and wrongfully and injuriously intending to injure the plaintiff, and deprive him of the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the making, using, and vending of the said invention or improvement, after the making and issuing of the said letters patent, and within the term of fourteen years in said letters patent mentioned, to wit, on the first day of January, eighteen hundred and forty, and on divers other days and times between that time and the commencement of this suit, at the city of New York, and within the Southern District of New York, wrongfully and unjustly, without the leave or license and against the will of the plaintiff, made and sold divers, to

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wit, ten, machines for propelling boats, in imitation of the said invention and improvement, or a part of the said invention or improvement, to the benefit, use, and enjoyment whereof the said plaintiff was and is entitled as aforesaid, in violation and infringement of the said letters patent, and of the exclusive right and privilege to which the plaintiff was and is entitled as aforesaid, and contrary to the form of the statutes of the United States in such case made and provided.

“And the said plaintiff further says that the said defendants, well knowing the said several premises, but further contriving and intending as aforesaid, after the obtaining of the letters patent by the said plaintiff as aforesaid, and within the said term of fourteen years, to wit, on the said first day of January, eighteen hundred and forty, and at divers other times between that day and the commencement of this suit, within the Southern District of New York aforesaid, wrongfully and unjustly, without the leave or license and against the will of the plaintiff, did make and sell divers, to wit, ten, improved machines for propelling boats or vessels upon the water, constructed in a similar form and acting upon the same principle as the said machine or improvement, to the benefit, use, and enjoyment whereof the said plaintiff was and is entitled by his said letters patent as aforesaid, in violation and infringement of the exclusive right so secured to the said plaintiff by the said letters patent as aforesaid, and contrary to the form of the statute in such case made and provided.

“And the said plaintiff further says that the said defendant, well knowing the said several premises, but contriving and intending as aforesaid, after the obtaining of the said letters patent by the said plaintiff as aforesaid, and within the said term of fourteen years, to wit, on the said first day of January, eighteen hundred and forty, and at divers other times between that day and the commencement of this suit, in the Southern District of New York aforesaid, wrongfully and unjustly, and without the consent or allowance and against the will of the plaintiff, did imitate in part and make a certain addition to the said invention or improvement, to the benefit, use, and enjoyment whereof the plaintiff was and is entitled as aforesaid, in breach of the said letters patent, and in violation and infringement of the exclusive right and privilege so secured to the said plaintiff as aforesaid, and contrary to the form of the statute in such case made and provided.

“By means of the committing of which said several grievances by the said defendants as aforesaid, the said plaintiff is greatly injured, and has lost and been deprived of divers great gains and profits which he might and otherwise would have derived from the said invention



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and improvement in the said letters patent described and set forth, and in respect whereof he was and is entitled to such privilege as aforesaid, and was and is otherwise damaged to the said damage of the said plaintiff of ten thousand dollars; and therefore," &c.

To this declaration, the defendants pleaded the general issue, and filed a copy of the special matters of defense to the action.

In May, 1847, the cause came on for trial. The patent was given in evidence, when the counsel for the defendants prayed the court to instruct the jury that the patent thus produced in evidence by the said plaintiff was void, for the reasons following:

1. That the claim of the plaintiff, as set forth in his specification annexed to his letters patent, embraces the entire spiral paddle-wheel. The claim is, therefore, too broad upon the face of it, and the letters patent are void upon this ground, and the defendants are entitled to a verdict.

2. That the patent is void upon its face, for this: that, purporting to be a patent for an improvement, and specifying that the invention is of "an improved spiral paddle-wheel, differing essentially from any which have heretofore been essayed," without pointing out in what the difference consists, or in any manner whatever indicating the improvement by distinguishing it from the previously-essayed spiral paddle-wheels, it is wanting in an essential prerequisite to the validity of letters patent for an improvement.

3. That the patent is void upon its face, for this: that it embraces several distinct and separate inventions, as improvements in several distinct and independent machines susceptible of independent operation, not necessarily connected with each other in producing the result arrived at in the invention, and the subject-matter of separate and independent inventions.

4. It appears in evidence that the drawing and model of the paddle-wheel of plaintiff, filed and deposited originally in the Patent Office, had been lost by the destruction of that office in December, 1836, and that in restoring the record of the patent, under the act of March, 1837, the plaintiff sent from New Orleans to the office a new drawing, to be filed on the 5th of May, 1841, together with a court copy of the letters patent which were deposited in the office. The drawing was not sworn to by the plaintiff, but remained in the office till January, 1844, when it was delivered to an agent of the plaintiff and sent to New Orleans, and sworn to by him, and filed in the department on the 12th of February, 1844. On an examination subsequently by the plaintiff, it was discovered that this drawing was imperfectly made, and thereupon a second drawing was procured by

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him, which he claimed and offered to prove to be an accurate one, and was sworn to and filed on the 27th of March, 1844, an authenticated copy of which was offered in evidence on the trial by the plaintiff, which was objected to by the counsel for the defendants; but the objection was overruled, and the evidence admitted, to which an exception was taken.

5. That if, from the evidence, the jury are satisfied that no propelling-wheels were made by the defendants between the 27th of March, 1844, (the date of the alleged completion of the record of the plaintiff's patent, under the act of March 3d, 1837,) and the commencement of this suit, in April following, that, upon this ground, the defendants are entitled to a verdict.

The court charged, in respect to the instructions prayed for, that "the claim of the plaintiff was for an improvement on the spiral paddle-wheel or propeller; that, by a new arrangement of the parts of the wheel, he had been enabled to effect a new and improved application and use of the same in the propulsion of vessels; that the ground upon which the claim is grounded was this: it is the getting rid of nearly all the resisting surface of the wheels of Stevens, Smith, and others, by placing the spiral paddles or propelling surfaces on the ends of arms, instead of carrying the paddles themselves in a continued surface to the hub or shaft. It is claimed that a great portion of the old blade not only did not aid in the propulsion, but actually impaired its efficiency, and also that the improved wheel is made stronger. It was made a question, on the former trial, whether the plaintiff did not claim, or intend to claim, the entire wheel. But we understand it to be for an improvement upon the spiral paddle-wheel, claimed to be new and useful in the arrangement of its parts, and more effective, by fixing the spiral paddles upon the extremity of arms, at a distance from the shaft."

The court further instructed the jury, that "the description of the invention was sufficient, and that the objection that the parts embraced several distinct discoveries was untenable."

The court further charged, "that the damages were not necessarily confined to the making of the wheels between March, 1844, when the drawings were restored to the Patent Office, and the bringing of the suit. Such a limitation assumes that there can be no infringement of the patent after the destruction of the records, in 1836, until they are restored to the Patent Office, and that during the intermediate time the rights of patentees would be violated with impunity." We do not assent to this view.

In the first place, the act of Congress providing for the restoration

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was not passed till 3d March, 1837; and in the second place, in addition to this, a considerable time must necessarily elapse before the act would be generally known, and then a still further period before copies of the drawings and models could be procured. Patentees are not responsible for the fire, nor did it work a forfeiture of their rights.

The ground for the restriction claimed is, that the community have no means of ascertaining, but by a resort to the records of the Patent Office, whether the construction of a particular machine or instrument would be a violation of the rights of others, and the infringement might be innocently committed.

But if the embarrassment happened without the fault of the patentee, he is not responsible for it; nor is the reason applicable to the case of a patent that has been published, and the invention known to the public. The specification in this case had been published. It is true, if it did not sufficiently describe the improvement without the aid of the drawing, this fact would not help the plaintiff. If there had been unreasonable delay and neglect in restoring the records, and in the meantime a defendant had innocently made the patented article, a fair ground would be laid for a mitigation of the rule of damages, if not for the withholding them altogether; and the court left the question of fact as to reasonable diligence of the patentee or not in this respect, and also all questions of fact involved in the points of the case for the defendants, to the jury.

The counsel for the defendants excepted to each and every part of the charge of the court, so far as said charge did not adopt the prayer on the part of the defendants.

The verdict of the jury was, that the said Peter Hogg and Cornelius Delamater, the defendants, are guilty of the premises within laid to their charge, in manner and form as the said John B. Emerson hath within complained against them, and they assess the damages of the said plaintiff, on occasion thereof, over and above his costs and charges by him about this suit in this behalf expended, at one thousand five hundred dollars, and for those costs and charges at six cents.

The judgment of the court was, that the said John B. Emerson do recover against the said Peter Hogg and Cornelius Delamater his damages, costs, and charges in form aforesaid by the jurors aforesaid assessed, and also three hundred and twenty-four dollars and fifteen cents, for his said costs and charges by the said court now here adjudged of increase to the said John B. Emerson, and with his assent; which said damages, costs, and charges, in the whole, amount to one thousand eight hundred and twenty-four dollars and fifteen cents.

The cause was argued on this court, on printed arguments, by *Upton* and *John O. Sargent*, for the plaintiffs in error, and *Morton* and *Cutting*, for the defendant in error. The arguments were too voluminous to be reported *in extenso*, and it is not possible, therefore, to give more than extracts from each.

The counsel for the plaintiffs in error assigned as errors the following points:

I. The defendant in error has no patent for an improved spiral paddle-wheel.

II. If the defendant's patent is for the combination of instruments described in the specification, there is no pretense that the combination has been infringed; if for several separate improved machines, it cannot be supported in law.

III. Defendant's patent is void for too broad a claim, and for not distinguishing his alleged improvement from other inventions, nor particularly specifying, as the statute requires, the particular improvement which he claims as his own invention or discovery. The case exhibits an improvement as the invention, and the claim is for the whole machine.

IV. The drawing filed March 27th, 1844, was not legal evidence of defendant's patented invention, because there was a drawing filed by the patentee on the 12th of February previous, which was, by the second section of the act of 1837, with his letters patent, the only legal evidence of his invention, *as patented*, that could be offered in any judicial court of the United States.

V.—1. The patentee, after an alleged correction of the record of his letters patent, by filing the second drawing, could not, in law, avail himself of that alleged correction to cover by it alleged causes of action previously accruing; and in the absence of proof of any subsequent infringements, the plaintiffs here were entitled to a verdict below.

2. Nor was he entitled to recover damages for any alleged infringement prior to the alleged *completion* of his record by the filing of the corrected drawing of 27th March, 1844.

VI. What was reasonable time in this case for the restoration of defendant's patent to the office, if not expressly fixed by statute, (act of 1837, section 2,) was exclusively a question of law.

*Upton, for plaintiffs in error.*

1. This action was brought to recover damages from the defendants below, for their asserted infringement of an alleged patent of the plain-

## Argument for the plaintiffs in error.

tiff for "an improved spiral paddle-wheel"; and the first question to which the attention of the court is requested is one which is presented upon the face of the letters patent, which constitute the basis of the action, and which are incorporated into the bill of exceptions. It is this: Has the defendant in error any such patent?

If it be manifest to this court, upon an inspection of the record and an examination of the letters patent, that he has no grant, as patentee, of "an improved spiral paddle-wheel," then it is submitted that there is no escape from the necessity of reversing the judgment which has been rendered, awarding him damages for the invasion of such a grant. This necessity is in no manner affected, though it appear that the objection was not taken in the court below, either at the trial or upon a motion in arrest of judgment. It is sufficient if the defect be manifest upon the record; for it would be monstrous to contend that this court is powerless, in any case, to reverse the judgment, when it appears upon the record before them that the very foundation of the judgment is so incurably and fatally defective as to have been completely beyond the remedy of the party, though the objection were taken at the earliest possible stage of the proceedings. Authority can scarcely be necessary to sustain this position. But this court has decided, in the case of *Slacum v. Pomeroy*, 6 Cr., 221, that it is not too late to allege as error in the Supreme Court a defect which ought to have prevented the rendition of the judgment in the court below. "Had this error," say the court, "been moved in arrest of judgment, it is presumable the judgment would have been arrested;" and "there can be no doubt that anything appearing upon the record which would have been fatal upon a motion in arrest of judgment is equally fatal upon a writ of error." So also *Garland v. Davis*, 4 Howard, 131.

By the bill of exceptions, it appears that, upon the introduction in evidence of the letters patent by the plaintiff, "the counsel for the defendants did insist before the said Circuit Court, on behalf of said defendants, that the said letters patent so produced and given in evidence on the part of said plaintiff as aforesaid were wholly insufficient as the basis of the aforesaid action and claim upon the said defendants." Now, by reference to the letters patent, (page 7 of the record,) the court will perceive that the grant to the patentee, upon the face of the letters, is for "an improvement in the steam-engine," and for that alone; that it was for that alone that he solicited a patent by petition; that it was of that improvement only that he made oath that he was the original and first inventor. Such is the grant, and so is it recorded; and the public would seek in vain upon the

records of the Patent Office for a patent to the plaintiff below for "an improved spiral paddle-wheel."

It will not be contended that the letters, standing alone, confer any title to such an invention: But it may be said, that inasmuch as the patentee has described a paddle-wheel, and also an improved method of causing a capstan to revolve upon the deck of a vessel, as well as his improvement in the steam-engine, and claimed these as well as his steam-engine in his schedule annexed to the letters patent, the grant must be construed to cover the paddle-wheel and the capstan as well as the steam-engine, though it be in express terms for the steam-engine only, though it was for that alone that he solicited a patent, and it was that alone that he made oath he had invented. Were this doctrine maintainable, it is obvious that it would be wholly subversive of the policy of the law, which looks as well to the protection of the public as it does to the encouragement of inventors. That the schedule annexed to letters patent forms a part of the patent, and that they are to be construed together, is undoubtedly well established. This is the English doctrine, as well as that of our own courts; and, by a careful investigation of the authorities, it will be perceived that Mr. Phillips, in his elementary work, (pages 224, *et seq.*) is mistaken in supposing that there is any conflict between them.

By these authorities, it is decided that the title of the invention, as contained in the patent, may be explained by its description in the specification, whenever such title is general, ambiguous, or uncertain; and the patent will be sustained, in all cases, unless the patent indicate one invention, and the specification describe another and different invention. American authorities.—Phillips on Patents, 224; and cases cited; *Sullivan v. Redfield*, Paine C. C. R., 442; *Shaw v. Cooper*, 7 Peters, 292, 315; *Evans v. Chambers*, 2 Wash. C. C. R., 125; *Barrett v. Hall*, 1 Mason, 476; *Whittemore v. Cutter*, 1 Gall., 437; *Evans v. Eaton*, Peters' C. C. R., 341. English authorities.—Godson on Patents, 108, 113, and cases; *Neilson v. Harford*, Webster, 312, and arg.; *Rex v. Wheeler*, 2 Barn. & Ald., 350; S. C., 3 Merivale, 629; *Gleggy's Patent*, Webster, 117; *Russell v. Cowley*, Webster, 470; *Househill v. Neilson*, Webster, 679.

When Mr. Phillips says (Phillips on Patents, 225) that any defect in the title may be remedied by the specification, what he means is apparent by reference to the cases which he cites. The description comes in aid of a defective title, but never can create a new title, by adding to the grant. There must be such a conformity between the title and the specification as that the former shall give some idea of the latter. It is the description of the thing patented "which is made

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part of these presents,"—not a description of something else, of which the title of the grant gives no idea.

Thus reads the patent itself. After reciting that John Brown Emerson had, by petition, solicited a patent for an improvement in the steam-engine, had made oath that he was the first and original inventor of said improvement, and paid the fee of thirty dollars into the treasury, it grants to him the exclusive right, &c., in the said improvement, "a description whereof is given, in the words of the said John Brown Emerson himself, in the schedule hereunto annexed, and is made a part of these presents." Then follows the caption of the schedule, thus: "The schedule referred to in these letters patent, and making part of the same, containing a description, in the words of the said John Brown Emerson himself, of his improvement in the steam-engine."

No reported authority can be found in the remotest degree sustaining the proposition that a description and claim of anything contained in a specification are covered by the grant, though the grant make no reference to it, and the title is so entirely distinct from it as to suggest no idea of the thing described. Were this proposition tenable, then were we to strike out from this patentee's specification every word descriptive of his improvement in the steam-engine, leaving nothing but the comparatively few words descriptive of the spiral paddle-wheel and the improved capstan, the grant for the improvement in the steam-engine must be construed as a grant for an improved spiral paddle-wheel and an improved capstan. Now, would it not be monstrous to contend that an instrument of so solemn a character as a government grant of letters patent is to be added to and enlarged by construction?

The doctrine as settled, upon every principle of construction, is the true doctrine—that the description of the thing patented, contained in the schedule annexed to the patent, constitutes a part of the patent, and may be and should be resorted to, in construing the patent, to control the generality of the title, and to explain or elucidate ambiguities or uncertainties; but that a description of a thing not indicated by the patent, not even remotely suggested by the grant or the title, can never be construed with the patent, for the purpose of adding to or enlarging the terms of the grant.

That this doctrine may be made more obvious and conclusive, (if it be possible or desirable,) the court is referred to the provisions of the statute under which the letters patent in this case issued.

The inventor is required to present his petition soliciting the patent, and to make oath that he is the inventor. The statute further requires

that the letters patent shall recite the allegations and suggestions of the petition, and give a short description of the invention. This requisition was obviously for the twofold purpose: first, that it might appear that the proper preliminary steps had been taken by the applicant, of which the recital in the letters was proof; and, second, that it might, on their face, be seen what was the nature and character of the grant. Act of 1793, sections 1, 3. Now, did this patentee present his petition, soliciting a patent for an improved spiral paddle-wheel, and make oath that he was the inventor of that improvement? If it be answered that he did, then the positive requisition of the statute is not complied with; for the patent recites the allegations and suggestions of no such petition, and gives a short description of no such invention; and for this reason the patent would be absolutely void.

This is well established in the following cases: *Evans v. Eaton*, Peters' C. C. R., 340; *Kneass v. Schuylkill Bank*, 4 Wash. C. C. R., 9; *Cutting et al. v. Myers*, 4 Wash. C. C. R., 220; *Evans v. Chambers*, 2 Wash. C. C. R., 125.

If the letters patent do recite the allegations and suggestions of the petition, then the patentee did not solicit a patent for "an improved spiral paddle-wheel" or an "improved capstan"; he did not make oath that he had invented these improvements; and hence the letters contain no description whatever of these improvements, and confer no grant of an exclusive right in them upon the patentee.

(The counsel then quoted largely from the opinion of Judge WASHINGTON in *Evans v. Eaton*, Peters' C. C. R., 340.)

II. At the trial, the defendants' counsel requested the court to instruct the jury, "that the patent of the plaintiff was void upon its face, for this: that it embraces several distinct and separate inventions, as improvements in several distinct and separate machines susceptible of independent operation, and not necessarily connected with each other in producing the result aimed at in the invention, and the subject-matter of separate and distinct patents." The court charged the jury, that "the objection that the patent embraced several distinct discoveries is untenable." In this it is respectfully submitted that the court below erred.

(The counsel here cited and commented on Phillips on Patents. "It is well settled, that two or more distinct machines, capable of independent operations, cannot be united in one patent." 3 Wheat., 454; 1 Mason, 447; 2 Mason, 112; 1 Story, 290.)

III. At the trial of this case, the counsel for the defendants requested the court to instruct the jury, "that the claim of the plaintiff, as



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set forth in his specification annexed to his letters patent, embraces the entire spiral paddle-wheel. The claim is, therefore, too broad upon the face of it, and the letters patent are void upon this ground." Upon this point the court charged the jury as follows: "It was made a question, on the former trial, whether the plaintiff did not claim the entire wheel; but we understand it to be for an improvement upon the spiral paddle-wheel, claimed to be new and useful in the arrangement of its parts, and more effective, by fixing the spiral paddles upon the extremity of arms, at a distance from the shaft."

IV. At the trial, the counsel for the defendants also requested the court to instruct the jury, "that the patent is void upon its face for this: that, purporting to be a patent for an improvement, and specifying that the invention is of an improved spiral paddle-wheel, 'differing essentially from any that have heretofore been essayed,' without pointing out in what the difference consists, or in any manner whatever indicating an improvement by distinguishing it from the previously essayed spiral paddle-wheels, it is wanting in an essential prerequisite to the validity of letters patent for an improvement." Upon this point the court charged the jury as follows: "That the claim of the plaintiff was for an improvement on the spiral paddle-wheel or propeller; that, by a new arrangement of the parts of the wheel, he has been enabled to effect a new and improved application and use of the same in the propulsion of vessels; that the ground upon which the claim is founded is this: it is getting rid of nearly all the resisting surface of the wheels of Stevens, Smith, and others, by placing the spiral paddles or propelling surfaces on the ends of arms, instead of carrying the paddles themselves in a continued surface to the hub or shaft." It is claimed that a great portion of the old blade not only did not aid in the propulsion, but actually impaired its efficiency, and also that the improved wheel is much stronger." And the court further charged the jury, that "the description of the invention was sufficient."

Upon these two points, it is submitted that the court below erred. They are so connected, by reason of the peculiar circumstances of the case, that they will be presented and considered together, though they are distinct grounds of objection to the patent.

(The counsel then contended that the specification ought to be construed by itself, and be so clear as to be understood without resorting to evidence or any other source of information, and cited: English authorities.—*McFarlane v. Price*, 1 Starkie, 199; *In re Nickels*, Hindmarch on Patents, 186; *Hill v. Thompson*, 3 Merivale, 622; S. C., 8 Taunton, 325. American authorities.—*Dixon v. Moyer*, 4 Wash. C.

C. R., 69; *Evans v. Hettich*, 3 Wash. C. C. R., 425; *Lowell v. Lewis*, 1 Mason C. C. R., 189; *Ames v. Howard*, 1 Sumner, 482.)

This leads to the principle in the law of patents involved in the fourth point. It is the positive requisition of the statute, and has been repeatedly considered and passed upon by the Federal judicial tribunals.

Before an inventor shall receive a patent, he is required, "in case of any machine, fully to explain the principle and the several modes in which he has contemplated the application of that principle, or character by which it may be distinguished from other inventions, and shall particularly specify and point out the particular improvement or combination which he claims as his own invention or discovery." The requisition of the English law is similar in this respect.

Now, before proceeding to consider whether the patentee, in this case, has complied with this positive and salutary requisition of the law, the attention of the court is requested to the reported cases in which the requisition has received judicial construction.

By a careful examination of these authorities, it will be found established, that, where a patent is taken out for an improvement, the specification must describe what the improvement is, and the patent be limited to such improvement. If the patent includes the whole machinery, it includes more than the patentee invented, and is therefore void. That if the patent be for an improvement in an existing machine, the patentee must, in his specification, distinguish the new from the old, and confine his patent to such parts only as are new; and if both be mixed up together, and a patent is taken for the whole, it is void. That however the authorities may apparently vary in pointing out the particular manner in which the patentee must specify his improvement, and distinguish what he claims as new and his invention from what was old and before known, yet that they are in perfect harmony in deciding that he must do this in some manner, and upon the face of the specification. American authorities.—*Evans v. Eaton*, 3 Wheat., 454; *Woodcock v. Parker*, 1 Gall., 438; *Whittemore v. Cutter*, 1 Gall., 478; *Odiorne v. Winkley*, 2 Gall., 51; *Lowell v. Lewis*, 1 Mason, 182; *Barrett v. Hall*, 1 Mason, 447; *Sullivan v. Redfield*, Paine's C. C. R., 441; *Evans v. Eaton*, 7 Wheat., 408; *Dixon v. Moyer*, 4 Wash. C. C. R., 69; *Isaacs v. Cooper*, 4 Wash. C. C. R., 261; *Cross v. Huntley*, 13 Wend., 385; *Head v. Stevens*, 19 Wend., 411; *Ames v. Howard*, 1 Sumner, 482; *Kneass v. Schuylkill Bank*, 4 Wash. C. C. R., 9; *Morris v. Jenkins et al.*, 3 McLean, 250; *Peterson v. Wooden*, 3 McLean, 248. English cases.—*McFarlane v. Price*, 1 Starkie, 199; *Williams v. Brodie*, Davies' Patent Cases, 96, 97; *Manton v. Manton*,

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Davies' Patent Cases, 349; *Hill v. Thompson*, 8 Taunton, 325; *Minter v. Wells*, 1 Webster, 130; *Rex v. Nickels*, Hindmarch on Patents, 186.

Now, apply the rule of law, as prescribed by the statute and construed by these authorities, to the patent in this case. Admit that rule, as most liberally stated, in any reported decision, and the counsel respectfully asks, in what manner, upon the face of the patentee's specification, has he distinguished that which he claims as new and his invention from what was old and before known, or pointed out in what his improvement consists? It is most confidently answered that he has done this in no manner whatever, neither expressly nor by implication, nor by any reference; and it is not in the wit of man to determine, upon the face of the specification, what the improvement is which the patentee claims, or intended to claim. The court below, in their construction of the claim, in charging the jury, say that the improvement consists "in a new arrangement of the parts." Does this appear, either in terms or even impliedly, upon the face of the description? So far from this, the last words of the patentee, in his description, are, that the "shape" of the thing is the "only point of importance." The court further say, that this new arrangement of the parts consists in "getting rid of nearly all the resisting surface of the wheel of Stevens, Smith, and others, by placing the spiral paddles or propelling surfaces on the ends of arms, instead of carrying the paddles themselves in a continued surface to the hub or shaft."

Where, upon the face of the description, is there any mention made of Stevens', Smith's, or of any previously-invented wheel, save in the general declaration by the patentee, that his improved wheel "differs essentially from any which have been heretofore essayed,"—a declaration which the court, in the case of *Barrett v. Hall*, above cited, declare to be "no specification at all"? And where, upon the face of the specification, is there the most remote allusion to the "getting rid of resisting surface"?

V. At the trial of the case, "it appeared in evidence that the drawing and model of the paddle-wheel of the plaintiff, filed and deposited originally in the Patent Office, had been lost by the destruction of that office in December, 1836, and that in restoring the record of the patent, under the act of March, 1837, the plaintiff sent from New Orleans to the office a new drawing, to be filed on the 5th of May, 1841, together with a court copy of the letters patent which were deposited in the office. The drawing was not sworn to by the plaintiff, but remained in the office till January, 1844, when it was delivered to an agent of the plaintiff and sent to New Orleans, and sworn to by him, and filed in the department on the 12th day of February, 1844. On

an examination subsequently by the plaintiff, it was discovered that this drawing was imperfectly made, and thereupon a second drawing was procured by him, which he claimed and offered to prove to be an accurate one, and was sworn to and filed on the 27th day of March, 1844, an authenticated copy of which was offered in evidence on the trial by the plaintiff, which was objected to by the counsel for the defendants; but the objection was overruled, and the evidence admitted, to which an exception was taken."

It is contended, that the Circuit Court erred in admitting in evidence the second drawing of March 27th, 1844, and in support of this position the following considerations are respectfully submitted:

(The counsel then urged—

That the patentee had exhausted his privilege when he swore to the first drawing.

That if allowed to file more than one, he might continue to file them down to the day of trial.

That the first drawing became, by the statute, *primâ facie* evidence of the invention, and there could not be two such.

That if this patentee had procured a reissue of his patent, under the third section of the act of 1837, he would not have been entitled to the privilege which he now claims, and it is unreasonable to suppose that Congress intended to give greater privileges under one section than another.)

VI. At the trial of this case, the counsel for the defendants requested the court to instruct the jury as follows: "That if, from the evidence, the jury are satisfied that no propelling wheels were made by the defendants between the 27th of March, 1844, (the date of the alleged completion of the record of the plaintiff's patent, under the act of March 3, 1837,) and the commencement of this suit in April following, that, upon this ground, the defendants are entitled to a verdict."

The court refused to grant this prayer, and left it, as a question of fact, for the jury to say whether there had or had not been unreasonable delay on the part of the patentee in restoring the record. Now, was this a question of fact? It is submitted that it was not, but that, under the circumstances, it was purely a question of law, to be passed upon by the court.

The record shows, that, from the burning of the Patent Office, in December, 1836, up to the month of May, 1841, no step whatever was taken by the patentee to restore the record of his patent, and that he then delayed to complete the record until the month of February, 1844. Of course, there could have been no dispute as to the fact in

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connection with the question of reasonable or unreasonable diligence. Now, the authorities are clear in establishing this doctrine—that when there is no dispute as to the facts, the questions of reasonable or unreasonable time, or delay, or diligence, are questions of law for the court, and not of fact for the jury. The following cases are referred to: *Ellis v. Paige*, 1 Pick., 43; S. C., 2 Id., 71, 77, note; *Gilbert v. Moody*, 17 Wend., 354; *Reynolds v. Ocean Ins. Co.*, 22 Pick., 191; *Livingston & Gilchrist v. Maryland Ins. Co.*, 7 Cr., 506.

And now, as to the charge of the court, that “the damages were not necessarily confined to the making of the wheels between March, 1844, when the drawings were restored to the Patent Office, and the bringing of this suit.” Is not this error? Why was the drawing of March 27, 1844, filed in the Patent Office? For the reason only, as avowed, that the drawing of February preceding was incorrect and defective. For the reason only, that the public had no notice, or, what is still worse, that the public had an imperfect and deceptive information, by the first drawing, of the particulars of the patentee’s invention. Would it not be monstrous to allow a patentee to recover damages for an alleged infringement made at a time when, by his solemn oath, he declares that the defendant was not notified of the character of his invention? Nay, more, when he swears that, at the time of the alleged infringement, the only recorded notice of his invention, sworn to by himself, was imperfect, incorrect, and insufficient?

But, by an examination of the grounds upon which the court rest their decision upon this question, it will be seen in what manner the error has arisen. The court say, the limitation contended for by the defendants “assumes that there can be no infringement of the patent after the destruction of the records in 1836, until they are restored to the Patent Office, and that during the intermediate time the rights of patentees would be violated with impunity.” With the greatest deference, it will appear, upon a consideration of the statute provisions, that the doctrine contended for involves no such assumption.

The second section of the act of 1837 provides for the very difficulty which is urged by the court as the sole objection to the limitation contended for. Foreseeing that some time must necessarily elapse before patentees could be informed of their rights and duties, and prepare copies of their patents and drawings and models, Congress has provided, in this section, that, from the 15th of December, 1836, when the Patent Office was burned, to the 1st day of June, 1837, and not after, patentees and others may give in evidence their patents in any court, notwithstanding that they have not been re-recorded,

and no verified drawing of the invention has been filed in the Patent Office.

Is there not great danger, in the disposition to give the most liberal and enlarged interpretation to statute provisions for the protection and encouragement of inventors, that the rights of the public may be too much disregarded?

By the burning of the Patent Office, something more was involved in the loss of the evidences of the rights of patentees. The public were thereby deprived of the only notice which the law recognizes of what they could and what they could not do, without being subjected to prosecutions for invasions of patent-rights; for the public, in the language of Judge WASHINGTON, in a case before cited, "can depend upon no other information, to enable them to avoid the consequences of litigation, than what the records may afford. No description of the discovery secured by a patent will fulfill the demands of justice and of the law, but such as is of record in the Patent Office, and of which all the world may have the benefit."

Now, Congress, in legislating to repair the loss of the Patent Office, and to provide against its natural consequences, had in view the protection of the public as well as patentees; and while, on the one hand, it was justly considered that patentees ought not to suffer by reason of a loss arising from no fault of theirs, on the other, it was as justly considered that the public ought not to suffer by reason of a too long delay on the part of patentees to furnish to the public anew the recorded descriptions of their inventions. Thus, the second section of the act of 1837, saving the rights of patentees, enables them to recover damages for infringements after the burning of the Patent Office, and down to the month of June, 1837, notwithstanding the non-existence of any public record of their inventions; but, saving the rights of the public, the statute gives no further time.

Is not this clear? And being so, is it not manifest that the court below erred in the instructions given to the jury upon this point?

The drawing of the patentee, annexed to his patent or referred to in his specification, constitutes a part of the patent, and oftentimes, as in this case, is the most material portion of the description,—without which the invention would be virtually undescribed. Now, when a patentee alters or amends his patent, whether in the *written* description or the *delineated* description, there is nothing better established than that he cannot recover damages for an alleged infringement committed prior to such amendment. The authorities to this point are conclusive, and in perfect uniformity; some of them, and those the most recent, going so far as to maintain that it makes no differ-

## Argument for the defendant in error.

ence though the amendment be of a mere clerical error. *In re Nickels*, Turner & Phillips, 44; S. C., 1 Webster, 659; Hindmarch on Patents, (English edition,) 216, *et seq.*; *Wyeth v. Stone*, 1 Story, 290; *Woodworth v. Hall*, 1 Min. & W., 248, 389.

It is submitted that a denial of the doctrine here urged on behalf of the plaintiffs in error would be equivalent to an abrogation of the provisions of the thirteenth section of the Patent Act of 1837, which declares that a patent can only be amended by a surrender and re-issue, and that the amended patent can only operate upon causes of action accruing subsequently to the amendment.

Construe the first section of the act of 1837 as the court below has construed it, and what is the consequence? A patentee, whose grant is dated on or before the 14th of December, 1836, may maintain actions for infringement of his rights from then to the present time, without any public record of his patent whatsoever being in existence during the entire period, provided he produces at the trial an authenticated copy of his patent and drawings from the Patent Office, recorded there, perhaps, but the day before! From this consequence, it is submitted, there could be no escape; and small, indeed, would be the hope of escape for the innocent invader of the unrecorded right, with the question of reasonable diligence in the restoration of the record left to the decision of a jury.

*Morton and Cutting, for the defendant in error.*

I. The first point raised by the plaintiffs in error does not properly arise. The jury rendered a verdict for \$1,500 damages. The amount in controversy being less than \$2,000, the defendants below had no right to remove the cause to this court. They moved the Circuit Court for a new trial upon a case made, which motion was denied, and judgment was docketed upon the verdict. The defendants below then applied to the Circuit Court for the allowance of a writ of error, under the seventeenth section of the act of Congress approved July 4, 1836, which authorizes writs of error in patent cases to the Supreme Court of the United States, in the same manner and under the same circumstances as was then provided by law in other judgments and decrees of Circuit Courts, "and in all other cases in which the court should deem it reasonable to allow the same."

Having no right to a writ of error, therefore, unless the judges of the Circuit Court "should deem it reasonable to allow the same," application for the writ was made to the discretion of the court; and the application was granted so far as to allow the defendants to raise, for the consideration of the Supreme Court, five points specified by

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Argument for the defendant in error.

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the court below, and which constitute the second, third, fourth, fifth, and sixth points now presented by the plaintiffs in error.\* The defendants availed themselves of the permission to issue a writ of error, restricted as above stated, and now, after the writ has been allowed, they seek to argue a question not embraced in those specified by the court.

It is respectfully submitted that this course ought not to be encouraged, and that the grounds discussed in the first point taken by the plaintiffs in error need not be considered by the counsel for the patentee. It may be briefly remarked, however, that the point referred to was not raised at the trial, and does not appear upon the face of the record, or even upon the bill of exceptions. It was insisted below that the patent was void for the reasons specified in the bill of exceptions. The court will search in vain for the question attempted to be discussed by the counsel for the plaintiffs in error in his first point.

Even if it were raised by the bill of exceptions, and were a point that could be argued here, it would be untenable. The argument appears to be, that the patentee has no patent for "an improved paddle-wheel," because the title of the grant is for an improvement in the steam-engine, and the counsel for the plaintiffs in error argues as if the letters and the schedule were not a part of the same instrument. By taking the whole patent together, that is, the letters and the specification, there can be no difficulty in ascertaining the extent of the patent. It grants to the patentee the right "of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said patentee himself, in the schedule hereto annexed, and is made a part of these presents."

Thus, the schedule is made a part of the patent, as much as if it were recited in the letters themselves. The grant is for the improvement described in the schedule; and, by referring to the schedule,

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\* Writ of error allowed in respect to the question—

1. Whether the patent is void as embracing two or more distinct and independent inventions or improvements.
2. Whether the claim is for an entire paddle-wheel, or only for an improvement.
3. Whether the new is sufficiently distinguished from the old.
4. Whether the corrected drawing was properly allowed and filed.
5. Whether the rule of damages was correct, on condition that case be submitted on written argument to Supreme Court at an ensuing term, before 1st February, and judgment to be secured by filing the usual bond.

A copy of Judge Nelson's indorsement on petition for writ of error.

ALEX'R GARDINER, *Clerk.*



## Argument for the defendant in error.

the improved paddle-wheel is distinctly embraced as a part of the claim.

In the construction of patents, the schedule annexed must be always kept in view and resorted to, in order to ascertain what is the invention claimed and patented. If the claim or specification be more extensive than the actual invention, the patent may be void in part or in whole, for that reason; but there can be no doubt that, *prima facie*, the patentee has a grant for all that he claims in the schedule annexed to his patent. The description in the letters of the thing invented is always very brief, because it points to and incorporates the patentee's specification and description annexed, and which usually sets forth minutely the whole claim.

The argument on the other side, as to the effect of a variation between the title of the patent and the thing patented and described in the schedule, assumes that a good and perfect specification and description of the invention claimed by the patentee may be utterly defeated by a defect in the title, so that a specification and claim free from all ambiguity will be rendered utterly worthless by a defect in what the counsel terms "the title" of the patent. A rule of construction so harsh and unreasonable would be most destructive in its consequences. If applied to the interpretation of statutes, it would nullify many of them that are free from doubt. Not many of the acts of Congress would stand, if defective titles were declared to be fatal to the laws themselves.

The Patent Act of 1793, section first, provides that the Secretary of State may cause letters patent to be granted, "giving a short description of said invention or discovery." When the patentee presents his specification, it is referred to in and made a part of the patent; and it is from the patent, with schedules and drawings taken together, that it is to be determined what thing is intended to be patented. *Pitt v. Whitman*, 2 Story, 621. Any defect in the title is remedied by a proper description in the schedule. *Barrett v. Hall*, 1 Mason, 477; *Whittemore v. Cutter*, 1 Gall., 437; Phil. Pat., 224, 225.

In England, the rule appears to be different. There, the patent is distinct from the specification, and controls it in construction, so that the patentee cannot cover anything by the specification which is not embraced in the patent. *Campion v. Benyon*, 3 Brod. & Bingh., 5; *The King v. Wheeler*, 2 Barn. & Ald., 345.

II. But the plaintiffs insist that the patent "is void, for the reason that it embraces several distinct and separate inventions as improvements in several distinct and independent machines susceptible of independent operation, not necessarily connected with each other, in

producing the result arrived at in the invention, and the subject-matter of separate and independent inventions."

It is clear, from the specification, that the patentee claims to have discovered an improvement in the steam-engine, and, with it, in the mode of propelling vessels. He substitutes for the crank motion a mode of converting the reciprocating motion of a piston into a continued rotary motion, by a new combination of machinery for that purpose. From the revolving shaft described by him, a rotary motion may be communicated to paddle-wheels or other objects. When used for steamboats, the patentee employs the improved paddle-wheel described by him, which is necessarily to be worked in connection with the other machinery. When a capstan is required, as on board of a steamboat, he describes the mode of connecting the shaft of the engine with the capstan, so that it may be made to revolve by the action of the shaft; and he claims as his invention the substituting for the crank, in the reciprocating engine, a grooved cylinder, operating as described; the paddle-wheel constructed and operating as set forth; and the application of the revolving vertical shaft to the turning of a capstan.

Now, it is manifest that the invention is a mechanical unity. The improved engine and paddle-wheel are intended to act together, and if a capstan be used, the improved engine is made to connect with and turn the capstan, as it does the paddle-wheels. Although the engine may be applied to the old-fashioned wheel, and though it may or may not be attached to the capstan, yet it is manifest that the improved engine, connected with the paddle-wheel or with a capstan, may be used in connection to produce or aid the result designed by the patentee, namely, the propulsion or navigation of a vessel.

(The remainder of the argument upon this head is omitted.)

III. The defendants prayed the court to instruct the jury "that the claim of the plaintiff, as set forth in his specification annexed to his letters patent, embraced the entire spiral paddle-wheel. That the claim was, therefore, too broad upon the face of it, and the letters patent were void upon that ground."

The court charged the jury that "it was made a question, on the former trial, whether the plaintiff did not claim, or intend to claim, the entire wheel; but we understood it to be for an improvement upon the spiral paddle-wheel."

The counsel for the plaintiffs in error supposes that the court below arrived at this conclusion, not from the face of the patent, but from matters *dehors* the specification. This assertion is unfounded. The

view of the court below is the result of a just construction of the patent itself.

It is difficult to perceive by what course of argument the patent can be shown to be too broad upon its face. By the expression "too broad," I presume, it is intended that the patentee claims more than he has invented. This is usually a question of fact, dependent upon the proofs at the trial. The face of this patent certainly does not disclose the fact that the patentee has a grant for anything of which he does not claim to have been the inventor. The counsel for the plaintiffs has not discussed this point, except so far as his observations under his fourth point may be applicable to it; and it is, therefore, not deemed necessary here to enlarge further upon this branch of the case, except to observe that the patentee does not claim to be the inventor of paddle-wheels, nor of "wheels acting on the spiral or screw principle"; on the contrary, he refers to wheels previously "essayed," upon which wheels the patentee claims to have improved. What he does claim, then, is an improved spiral propelling-wheel, constructed and operating under water in the manner described, which improvement, as described in the schedule, is new, and is the invention of the patentee.

IV. It is insisted that the court below ought to have charged the jury as prayed for, namely, "that the patent is void upon its face, for this: that, purporting to be a patent for an improvement, and specifying that the invention is of an improved spiral paddle-wheel, differing from any which have heretofore been essayed, without pointing out in what the difference consists, or in any manner whatever indicating the improvement by distinguishing it from previously-essayed spiral paddle-wheels, it is wanting in an essential prerequisite to the validity of letters patent for an improvement."

The court refused so to charge, and held that the description of the invention was, in this respect, sufficient.

The point now raised is one purely technical, because it must be assumed, after verdict, and upon the bill of exceptions, that the patentee was the real inventor of what he claims; that, *de facto*, he has not claimed as new that which had been known before; that the improvement is useful, and that the specification is so full and clear, and free from ambiguity, that any mechanic skilled in the art of making propellers could, by following it, construct the thing patented.

But however meritorious the invention may be, yet it is contended that the patent ought to be adjudged void, because it does not point out the difference between the improved propeller and all other propelling-wheels previously essayed.

The object of pointing out the old from the new is, that the public may be informed what the party claims as his invention, and may ascertain if he claims anything in common use.

The law does not require that he should describe the various paddle-wheels then known, or point out the differences between them and his improvement. Such a rule, even if practicable, would be too onerous to be endured. Take, for example, a patent for an improvement upon all stoves previously essayed: it would be unreasonable to prescribe that the specification should describe all the stoves in use, or that had ever been essayed, and that it should point out the difference between them and the particular improvement. Such requirement would be impracticable. When Emerson applied for his patent, in 1834, there were a very great number of paddle-wheels and propellers known, or which had been essayed, many of which had been patented in this country and in England. Now, it was not necessary for him to have described all these various wheels and propellers. It is enough if he has specified his own improvement; and if he has done so in an intelligible form, his patent is good on its face, although, when tested by evidence *dehors* the patent, it might appear that he has claimed what was old, and thus his patent might be defeated.

In *Evans v. Eaton*, 7 Wheat., 435, the rule is thus expressed: "We do not say that the party is bound to describe the old machine, but we are of opinion that he ought to describe what his own improvement is, and to limit the patent to such improvement. The law is sufficiently complied with by distinguishing, in full, clear, and exact terms, the nature and extent of his improvement only."

Most of the authorities cited by the counsel for the plaintiffs in error, under his fourth point, are referred to by Phillips, in his work on Patents, and the rule that he deduces from them is thus stated, at page 269:

"In specifying an improvement in a machine, it is often necessary to describe the whole machine as it operates with the improvement, in order to make the description intelligible, and enable an artist to construct the machine, as the inventor is bound to do in his description, and which if he fails to do he falls into the fault of obscurity. On the other hand, if the whole machine, as well the old as the new part, be thus described, it is requisite to distinguish what part the patentee claims, since, if this does not satisfactorily appear, the patent will, as we have seen, be void for ambiguity; or, if the obvious construction is that he claims the whole machine in its improved state, the patent will be void by reason of the patentee claiming too much. The mode of expression generally used in the books in relation to this

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subject is, that the specification must distinguish the old from the new. The only object of this distinction is, however, to specify what the patentee claims; and the mere discrimination of the new from the old would not necessarily show this, for perhaps he does not claim all that is new. When the cases say, therefore, that the specification must distinguish the new from the old, we must understand the meaning to be that it must show distinctly what the patentee claims, the only object of this distinction being for this purpose. This doctrine is illustrated by some of the cases already stated, and it runs through them all wherein this question arises."

Most of the patents describe the improved machine only, as will be seen by referring to the specifications in the Patent Office, and to the reports of patent cases.

It has been, of late years, the practice of the courts of this country to give effect to patents, if possible, rather than to destroy them; and to this end, more technical objections are no longer encouraged. The rigorous rules of the English courts, and of some of our earlier cases, by which meritorious patents were frequently overturned, have given place to more liberal and enlightened principles.

(The remainder of the argument upon this head is omitted.)

V. The authenticated copy of the corrected drawing, filed in the Patent Office on the 27th of March, 1844, was correctly admitted.

The original drawing filed with the patent, in 1844, had been destroyed by fire. The patentee could not, of course, produce the original, and he therefore resorted to the next best evidence that the nature of the case permitted. This consisted of a copy, which the plaintiff below offered to prove to be an accurate copy of the original; and this copy, so offered, was duly authenticated, in the manner provided by the first and second sections of the act of March 3, 1837.

Upon the strictest principles of the law of evidence, the plaintiff below was entitled to prove what the original drawing really was. The original being lost, the next best evidence of it was an exact copy, proved to be accurate.

This proof would have been admissible and proper, irrespective of the act of 1837; and whether the copy so offered was a record of the Patent Office or not. Suppose the act of 1837 had never been passed, and the plaintiff had proved the destruction of the original drawing, he might have produced upon the trial a copy of it; and, after proof that it was a true copy, he would have entitled himself to read it in evidence.

But there can be no reasonable doubt that the corrected drawing, filed on the 27th of March, 1844, was properly received by the Patent

Office, and that an authenticated copy thereof was admissible as evidence, under the provisions of the act of 1837.

That act was remedial in its character; its object was to restore the records, and to repair the loss occasioned by the fire. To that end, it was of the highest public importance that the specifications and drawings should be correctly and accurately restored. To have received imperfect or inaccurate copies, would have increased, and not have remedied, the mischief; and to assert that the Patent Office had exhausted its power to restore models and drawings by the reception of what were not copies or true representations of the originals, would be to give a construction to the statute that would defeat its object.

The first section declares: "That it shall be the duty of the Commissioner to cause the copies offered by the patentee, or any authenticated copy of the original record, specification, or drawing which he may obtain, to be transcribed," &c. It is not only within the powers of the department to receive corrected drawings or models in place of those that prove to be inaccurate or imperfect, but it is the duty of the Commissioner to obtain exact substitutes for the originals, if possible; and if those already filed are shown to be erroneous, imperfect, or untrue delineations of the originals, it is the duty of the Commissioner to replace them with corrected copies. In this way only can the objects of the act be accomplished. To deny this power would be to perpetuate errors.

VI. The court below properly refused to charge the jury that the defendants were not entitled to a verdict, if they were satisfied that no propelling-wheels were made between the 27th of March, 1844, and the commencement of the suit.

The defendants excepted to the charge so far only as it did not adopt the prayer insisted on by them.

The prayer upon this point insists that the defendants were entitled to a verdict, if no wheels were made by them after the 27th of March, 1844, no matter how often they had infringed the plaintiff's patent prior to that date. It assumes that all persons may, with impunity, infringe upon all or any patents intermediate between the destruction by fire of the records of the Patent Office, and the complete restoration of them under the act of 1837. If the principle contended for be sound, then the patentee has no remedy for willful and deliberate violations of his patent, committed intermediate the destruction of the records of the Patent Office and the complete restoration of them, no matter how public and notorious the patent may have become, and no matter how extensively the patent may have been published and circulated in works of art or otherwise.

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This principle cannot be sound, and the defendants' prayer and exception raise no other question. The prayer assumes the broad ground that there is no liability for infringements committed prior to the restoration, not only of the patent itself, but of the drawings, and that the patentee is not entitled even to nominal damages.

The patent, in the present case, had been restored and recorded anew long before the 27th of March, 1844, namely, in the year 1841; the recorded copy of the specification and claim was correct, and disclosed the patentee's right; and yet the court was asked, in effect, to charge the jury that infringements might be perpetrated with impunity at any time after the fire, and at any time after the recording anew of the letters and schedule, until the 27th of March, 1844. The letters patent were published in the Franklin Journal in 1834, were filed anew in 1841, and of themselves were sufficient to protect the patentee, even if the restoration of the drawing had been imperfect.

The views of the learned judge in his charge need no illustration; he charged the jury as favorably for the defendants as they had a right to request.

The complaint of the counsel for the plaintiffs in error, that the court left the question of unreasonable delay, on the part of the patentee, in taking measures to restore his records, to the jury, is not properly urged upon the present writ of error, because—

1. It is not one of the five points that the court below allowed to be raised.

2. That part of the charge was not excepted to at the trial, and, on the contrary, the exception was limited to the point taken in the defendants' prayers.

3. Even if this point were properly before the court, it is clear that the question, whether the patentee had been guilty of unreasonable delay and neglect in restoring the records, was a question of fact upon the evidence then before the court.

It was a question of fact, submitted to the jury for the benefit of the defendants below; for if there had been such neglect or delay, the court instructed the jury, that, if the defendants had innocently made the patented article, it would be a fair ground for a mitigation of the rule of damages, if not for the withholding them altogether.

The charge was as favorable to the defendants as the law and the evidence would permit.

*John O. Sargent, for the plaintiffs in error, in reply and conclusion.*

It is objected to the first point raised by the counsel for the plaintiffs in error, that it is not properly presented to the court, though it

is admitted to arise upon the record. The argument is, that the court below intended to restrict the plaintiffs to the consideration of certain specified questions. True it is, that the court struck out from the bill of exception several points on which the plaintiffs relied; but the object of the court in so doing is misapprehended. It was the purpose of the court merely to disembarass and relieve the record of objections which they considered ill-taken, and the discussion of which they deemed unnecessary. That, besides this limitation, of which the plaintiffs have not complained, it was the intention of the court to cut them off from their right of dealing with this record according to law, is not to be presumed or implied. No doubt whatever is entertained by the counsel for the plaintiffs that the objection is well raised on the record, and that it is fatal to the defendant's claim.

I. The point made is, that the defendant in error has no patent for an improved spiral paddle-wheel.

The learned counsel for the defendant is mistaken in supposing that the argument of plaintiffs' counsel proceeds upon the idea that the letters patent and the specification are not parts of the same instrument. The specification forms a part of the patent, and they are to be construed together, but construed with reference to the fundamental principle of interpretation: *quoties in verbis nulla ambiguitas, ibi nulla expositio contra verba fienda est*—or, as it is sometimes laid down in the books, "No construction shall be made contrary to the very express words of a grant."

In construing this instrument, we must look to the situation of the parties, and the mode in which it was prepared. The formal letters patent speak the language of both parties. In the instrument of grant, there is nothing equivocal or ambiguous. It is not capable of being misunderstood. No ingenuity can extort a double meaning from it. Mr. Emerson made oath that he was the inventor of an improvement in the steam-engine; solicited a patent for said improvement; received a patent, reciting the exclusive privileges vested in him in said improvement, and making the description of said improvement contained in the schedule annexed a part of his patent. All this must be taken as absolute truth. The patentee claiming under this instrument is bound by its recitals, and estopped from denying anything that it alleges. The letters patent, in fact, are the joint production of the grantor and grantee. The Secretary of State adopted the description of his improvement which the grantee furnished in his petition. The entitling of the schedule is debatable ground. This may have been the work of the grantee alone, or of a clerk in the department. In either event, it indicates the intention



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of the parties, and, as if to exclude the possibility of the grantee's taking an exclusive privilege to any other thing than that contemplated and expressed in the patent, the heading or title of the schedule recites, in effect, that said schedule is made a part of the patent, so far as it contains a description of the improvement in the steam-engine, and no farther.

The language of the parties indicates plainly enough what was intended to be granted, and what was actually granted. Then comes the descriptive part of the schedule, or the specification, in the words of the grantee alone. This contains a particular description of the improvement in the steam-engine secured by the patent. It then describes an application of this improved engine to turn the capstan on the deck of a vessel; and an improved spiral paddle-wheel, alleged to differ materially from those previously essayed. Now, the ground taken by the counsel who opened this case is simply this—that Mr. Emerson cannot, by the introduction of new matters in his specification, make his patent operate as a grant for the improvement mentioned in his petition, oath, and letters; and also as a patent for other things not mentioned in such petition, oath, and letters. It is respectfully submitted that such is clearly the law.

It is presumed that there is no difficulty in the court's taking judicial notice of anything involved in the construction of a patent, which a judge at *nisi prius* would know without the aid of a jury. If this view is correct, the court will know that an improved steam-engine is not an improved paddle-wheel, and was not at the time this patent was issued. This being so, the improved spiral paddle-wheel is not only not in terms included in this patent, but is, by legal implication, as absolutely excluded from the patent as if it were excluded in express terms. In the fair, natural, obvious interpretation of this grant, collecting its meaning from the terms used in it, understood in their plain, ordinary, and popular sense, the improved steam-engine is the subject, and the sole subject, of Mr. Emerson's patent. Apply these principles which, in the language of a learned and eminent judge, furnish a "rule of construction which applies to all instruments," and they establish beyond a question that Mr. Emerson has no grant for an exclusive privilege in a spiral paddle-wheel.

And, first, because the force of the schedule is thus restrained in express terms by the patent, and these terms are the language of both parties. Again, because the language of the schedule is throughout the language of the grantee alone, and binds the grantor only so far as it has been expressly, or by necessary implication, adopted by him. Now, the duty of the Secretary of State, under the act of 1793, was

purely ministerial. He took no such judicial cognizance of specifications as is now rigidly exercised by the Commissioner of Patents. The grantee might have included many distinct machines in his schedule, and the Secretary of State was not called upon to notice the fact, did not notice it, and could not have prevented it. The patent was within his control, and the schedule so far as it was made a part of the patent, but not otherwise. He could so far restrict it as to limit its effect to the description of the thing patented, and to that extent he did in fact, in express terms, limit it. Beyond this he had no jurisdiction. The same is true of the Attorney-General. It was his duty merely to see that the patent purported to embrace but one improvement, and that the specification was signed by the patentee, and attested by two witnesses. His duty was then discharged, and he certified to the patent's being conformable to law. Now, is it not against reason, and therefore against law, to say that such a schedule, made by the grantee alone, and not examined by the grantor, is, in any other respect, and to any greater extent, operative in conferring exclusive privileges, than it is made so by the mutual assent of the parties, expressed in their common and joint language in the patent itself? Can such recklessness and improvidence in the issue of its grants, as a different construction would establish, be attributed to any government? If the schedule had contained the specification of a spiral paddle-wheel alone, would it have been patented under the terms of this grant? Would the patentee in that case have complied with that provision of the statute of 1793, which required him to "recite" his invention in his petition? Would his oath to the invention of an improved steam-engine then have covered the invention of a spiral paddle-wheel? And if not in that case, why in this? Does the mere fact of describing the improved steam-engine in the schedule, incorporate in this patent an improved paddle-wheel, which would not have been incorporated if the improved steam-engine had been omitted altogether? If such is the construction to be put upon these instruments, the Secretary might as well have issued his letters patent in blank, and suffered individuals to fill them up at their pleasure. The petition, the oath, the description, the grant, the signing by the Secretary and President, the reference to the Attorney-General, were all superfluous. But, say the counsel for the defendant in error, the schedule is a part of the patent; and if the schedule contains a description and claim of a machine, that machine becomes the subject of the exclusive privileges granted by the patent, just as much as if the inventor had petitioned for, sworn to, paid for, and received a patent for the same. This understanding of the matter would have

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been a very convenient one for a patentee under the law of 1793, because it would have enabled him to include in his letters the inventions of others, without incurring the penalties of perjury, and as many of them as he pleased, at the expense of a single fee. With all deference, but with all confidence, it is repeated, that the schedule is so far a part of the patent as it contains a description of the thing patented, and no farther. It is the description of the improvement patented contained in the schedule, which is the specification that forms a part of the patent. It is in this view that the language of the court is to be applied, when they say that the specification is a part of the patent, and that the whole is to be taken together, and construed as one instrument. As a general thing, under the law of 1793, the schedule contained only such a specification. In contemplation of law, it never can contain any other. If it contains anything more, the excess is surplusage. If it does not vacate the patent, it is at least inoperative;—it cannot enlarge the grant.

On the English cases, there would be no doubt on this point. For the non-conformity between the title in the patent and the description in the specification, the patent would be declared void on two grounds: 1st. For the false suggestion in the petition. 2d. For the claim in the specification of an improvement not within the true meaning and extent of the grant.

Either of these objections would render a patent in England absolutely void: 1st. Because the crown has been deceived. 2d. Because the inaccurate title is calculated to deceive the public.

These consequences flow, not from any special provision in the English patents or statutes, but from principles of the common law applicable to all public grants. These principles apply with equal force to public grants of the United States, unless there is some provision in our patents as issued, or in our statutes on this subject, rendering them inapplicable. It is submitted, with all deference, that no such provision can be found, and that the reasons for sustaining them in their full effect are stronger under the system established by our act of 1793, than under the English system.

(The remainder of the argument upon this head is omitted.)

II. It is again objected, by the counsel for the defendant in error, that there is nothing in the exception to the ruling of the court in regard to the insertion of several claims for distinct and separate machines in the specification.

The case of the defendant is obviously very much distressed by this point, and his counsel protest strongly that the inventions described exhibit a “mechanical unity,” being all a means of propelling vessels.

To maintain this proposition, they resort to a very extraordinary mechanical discussion, to show that, by means of the capstan, without regard to the motive power of the engine, they could propel a vessel. If this be so, and the counsel should present their argument to the Commissioner of Patents in the shape of a specification, they might readily obtain a patent for it, if a new and useful invention. They think, if a vessel with Mr. Emerson's machinery on board should be becalmed, without fuel, that, by applying "the motive power" by manning the capstan, motion would thereby be communicated to the propeller. The answer to this is, that no such application is contemplated by the patentee; and to arrive at it, the learned counsel is compelled to sever and destroy his mechanical unity, by leaving the steam-engine useless for the want of fuel.

The question is now, for the first time, distinctly presented to this tribunal, and the doctrine on this subject is to be settled by the judgment of the court in this case. It is a question of no inconsiderable public importance, and it is desirable that it should be adjudicated on plain and substantial grounds. All inventions are supposed to conduce more or less to one common object, to wit, the benefit of the public. This common purpose is probably too remote to sustain the introduction of all manner of inventions into the same patent; but, for all practical purposes, it is precisely as proximate and tenable as the common purpose claimed for the patentee in this case.

It is most humbly submitted, that the doctrine of this court, as suggested in *Evans v. Eaton*, is the true doctrine on this subject: "On the general Patent Law, a doubt might well arise whether improvements on different machines could regularly be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of those machines in combination." This language obviously contemplates a case in which the machines patented might be used in combination; and the whole force of Mr. Justice MARSHALL's very sound and pregnant suggestion is destroyed the moment the converse of the proposition is established, namely, that when machines are capable of being used in combination, then any number of them may be united in the same patent. The language of the court in the case cited applies only to the case where the machines in question are capable of acting together. Withdraw such cases from the operation of the principle propounded by the court, and there is an end of it. And yet this doctrine, as laid down by the court in that case, is daily acted upon by the Patent Office, under the act of 1836; and if it is materially

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shaken or qualified, the revenues of the department will be very seriously diminished.

The suggestions in *Evans v. Eaton*, on this point, were much considered in *Barrett v. Hall*, and it may be said that no cases on record present more masterly expositions of the principles of patent law which they discuss. *Wyeth v. Stone* stands on the extreme verge of sound principle; but there the two instruments were in fact but part of one and the same machine. The instruments contemplated in that case formed a compound machine for cutting ice. They were, in fact, but parts of one and the same instrument. Two things cannot be readily imagined more absolutely distinct and separate instruments, than a steam-engine and a paddle-wheel. A steam-engine is employed to give motion to every manner of machinery. A paddle-wheel may be turned by horse-power, or man-power; or windmill-power, as well as by a steam-engine. Here, the engine is the motive power; the wheel is the thing moved. The engine might be well employed to move anything else; the wheel might well be put in action by any other motive power. They are as distinct and separate as cause and effect, and cannot be united in one patent, except upon principles that would entirely nullify the rule of law laid down in *Evans v. Eaton* and *Barrett v. Hall*, and admit of the introduction in the same patent of entirely distinct and separate machines.

It is suggested that a different doctrine from that contended for by the plaintiffs prevails in England. We have cited no English authorities on this point. It arises on our own statutes, and is supported by Mr. Justice MARSHALL.

There is no hardship in the rule contended for. In no other way can the subject-matter of an invention be distinctly brought out, so as to warn the public against undesigned infringements. If several machines can be mixed up in one specification, and several improvements on each, and then patented in the name of one of those machines, it is respectfully, but earnestly, insisted, that the Patent Office cannot fail to become the source of more oppression and outrage than will be long tolerated by a people who are masters of their own institutions. Under such an understanding of the law, letters patent will be regarded by the public as mere charters of iniquity, and the whole system must be swept away. It must be as impracticable to sustain such an institution in the United States as it would be to establish the Inquisition here, or vest in the government those odious prerogatives the abuse of which led to the English statute of monopolies.

It is most humbly submitted, then, that, on the authorities and on the reason of the case, there was error in the charge of his honor the

circuit judge, that "the objection that the patent embraces several distinct discoveries is untenable."

III. Counsel for the defendant in error cannot perceive by what course of argument this "patent" can be shown to be too broad upon its face. We are embarrassed somewhat in reasoning upon this case, because it is an anomaly. This is the first attempt on record to sustain a grant of an exclusive privilege by virtue of letters patent which contain no allusion whatever to the alleged subject-matter of the privilege which is set up under them. We repeat, and to this point pray the special attention of the court, that, among the many hundred patent cases that have been adjudicated in this country and in England, not one such case is reported. In discussing analogies, therefore, we must waive for the time the great difference between this and all other cases, arising from the fact that the patent before us contains no grant of an exclusive privilege in a spiral paddle-wheel.

Plaintiffs' counsel do not allege, therefore, that this patent is too broad upon its face. It is as broad upon its face as the law will allow. It is broad enough to cover an improved steam-engine, and no more broad. It is made void by attempting to include more in the specification than is included in the grant, and more in the claim than is shown to be of the patentee's invention. The objection of plaintiffs' counsel is, that the claim is broader than the invention.

The claim is for the entire spiral paddle-wheel, constructed and operating as set forth; and, more than that, it is for such a machine, "not confined to precise forms or dimensions, but varied as experience or convenience may dictate; whilst the principle of action remains unchanged, and similar results are produced by similar means."

Here is a claim for the entire wheel, to be varied as the inventor may see fit to vary it, and for every other wheel operating on the same principle, and producing similar results by similar means. It is a claim, as broad and distinct as language can make it, for the spiral propelling-wheel, and every part of it, and for liberty to vary it in form as the inventor pleases, as long as a similar result, to wit, the propulsion of vessels, is produced by similar means, to wit, by a spiral wheel. The result contemplated is propulsion; the means or instrument is a spiral wheel, of such form as experience or convenience may induce the inventor to make, without changing the principle of action. Such is the claim; and if the claim is a valid one, no man can effect the propulsion of a vessel on the principle of action contemplated by a spiral wheel, without invading Mr. Emerson's claim.

But, while such is the claim with which Mr. Emerson arms himself,

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and goes out among men, as Lord Kenyon expressed himself in a similar case, "hanging terrors over the unlearned," when we come to examine the specification of his wheel, we find an implied acknowledgment that it is only an improvement, and merely an implied acknowledgment. He speaks of an "improved spiral paddle-wheel," leaving the unavoidable inference that he has improved the ordinary paddle-wheel by making it spiral, and that the spiral features—or, as he subsequently describes it, his spiral trough—is the only material part of his improvement.

Here is the old defect, that has been decided over and over again to be fatal—the invention of an improvement, and the claim of the whole machine. No ingenuity can withdraw this case from that large class of cases in which the rule we contend for has been laid down with a distinctness that cannot be mistaken, and applied with a wise, uniform, and unrelenting firmness. The courts say that no man shall give that false color to his claim which may enable him to "hang terrors over the unlearned." The case before the court is *Jessop's* case, where the patent was for the whole watch, and the invention of a particular movement. It is the case presented in *Williams v. Brodie*, where the invention was an improvement on a stove, and the patent for the whole stove. It runs on all-fours with *Cross v. Huntley*, where the invention was of an improvement in the washing-machine, and the claim was for the whole machine; where the court did not hesitate, in an action where the patent came up collaterally, to declare it void. It is *Bovill v. Moore*, where the patent for an improvement on a lace-machine was held void, because the claim was for the whole machine, though a considerable part of it had been long in use.

There is no matter of fact to be found, in order to bring out this defect, that the law may be applied to it. It lies on the face of the specification. *Jessop*, *Williams*, *Cross*, and *Bovill* showed that they had invented improvements, and claimed the entire machines. Emerson suggests that he has invented an improvement, and claims the entire machine. Where is the difference? What subtilty can distinguish between these cases? And why should we seek to establish thin, fine, and subtle distinctions, in a case where the policy of the law is so plain, obvious, and honest, and where the great end to be attained is to prevent patentees from "hanging terrors over the unlearned"?

These cases, it may be said, are not binding authorities upon this court. They are not so cited. No weight is claimed for them beyond that which they derive from their intrinsic good sense and sound reason. Their authority, as well-considered decisions, has never been

judicially disturbed or questioned. But there is a case of controlling authority, (that of *Evans v. Eaton*,) sustaining the doctrine for which we contend, to its full extent. To this case I shall have occasion again to refer, in considering the fourth head of the argument of the learned counsel for the defendant, to which I now pass.

IV. The fourth point discussed by the learned counsel for the defendant touches the second prayer made to the court below.

Plaintiffs contend that Mr. Emerson's specification does not define with precision the nature and extent of the alleged improvement in the spiral paddle-wheel, but describes the whole machine, and claims the whole as improved, without distinguishing the new from the old. A patent with such a specification cannot be supported. This doctrine rests so firmly on the authoritative decision of this court, that it may well be left to authority. We shall, therefore, merely allude to the obvious reason for it, which is, to limit the exclusive privilege to the actual improvement, and disarm the patentee of the power of "hanging terrors over the unlearned," and practicing upon the fears and credulity of the public, by "pretending that his invention is more than what it really is, or different from its ostensible objects." If a patentee can mix up a single undefined improvement in details of the construction and operation of an old machine, and then claim the whole machine constructed and operating in the manner set forth, then a patent, instead of being merely the reward of meritorious invention, is a device to encourage litigation, extortion, and fraud. Such a patent shifts its grounds at every trial, changes its color according to the aspect in which it is presented or met, and adapts itself with a fatal elasticity to the length and breadth of the evidence which happens to be applied to it.

(The remainder of the argument upon this head is omitted.)

V. Now, with regard to the drawings. It appears from the record, (p. 10,) that two drawings were filed by Mr. Emerson in the Patent Office, under the act of 1837: one as early as 1841, which was re-filed, with the plaintiff's oath to its correctness, on the 12th of February, 1844, and the other, with the same oath, on the 27th of March, 1844. The second drawing was the one produced and relied on by the plaintiff below as constituting, with the letters patent, that certified copy of the renewed record in the Patent Office which the second section of the act last cited makes the only proof of the alleged patent admissible in any judicial court of the United States.

The learned counsel for the defendant in error suggest, that, after the original drawing was destroyed by fire, the next best evidence of it was an accurate copy of it, offered to be proved such. It is submit-



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ted, with great deference, that a drawing of Mr. Emerson's paddle-wheel, filed in March to lay the foundation of a suit in April, was not the next best evidence of the alleged original, for the reason that there was another drawing, previously filed and sworn to, which was something more than next best evidence of the lost original, being made by statute absolutely the only evidence of it that could be received in any judicial court in the United States. It might, indeed, be well contended, that the first-filed drawing did not at all partake of the character of secondary evidence. It became, by force of the statute, to all legal intent, the original drawing. It filled the place of the original drawing on the record, being verified by the same oath, vesting the same rights, construed in the same way as part of the specification, and conclusive proof of all that it purported to prove, until it should be rebutted. The letters patent and first drawing filed by Mr. Emerson, under the first section of the act of 1837, became, by virtue of the second section, so far as the patentee was concerned, primary evidence. It was open to observation and impeachment to all the rest of the world; but, by operation of the statute, in connection with well-established principles of law, it was at all events conclusive upon the patentee. The drawing, therefore, filed on the 27th of March, 1844, was in law the "next best" evidence of Mr. Emerson's original drawing, because there was a prior drawing filed on the 12th of February, which the statute had expressly declared to be the legal original, at least for all purposes of litigation.

(The remainder of the argument upon this head is omitted.)

VI. On the question of damages, counsel for the defendant insist that there was no error in the charge of the learned judge, that "the damages were not necessarily confined to the making of the wheels between March, 1844, when the drawings were restored to the Patent Office, and the bringing of the suit." Such a limitation was prayed below, and, as it was supposed, on well-established principles of law and equity. It is again pressed, with all deference, but with perfect conviction, that the refusal of the prayer was error, for which the judgment under consideration ought to be reversed.

The Patent Act contemplates that everything to be done by an inventor, with respect to his specification and drawings, is to be done before the patent issues. There is no such thing as correcting the record of a specification or drawing by mere substitution of some other specification or drawing. After the patent issues, the patentee cannot, by merely depositing a new drawing, on any plea whatever, make it a part of his patent, or any evidence whatever of his invention, as originally patented, so as to cover cases of alleged infringe-

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ment prior to such change in the record. There can be only one motive of desiring to add a new drawing, and that is, to remedy a defect or insufficiency in the original drawing or specification, or to correct the same. The object of such a change can never be merely to present a more tasteful drawing, or a drawing more agreeable to the eye, or more in conformity to pictorial rules. Other arts than the fine arts induce such an application. The offer to file a new drawing is an admission on the part of the patentee that his new drawing covers something in which the original drawing is defective or insufficient. And, under these circumstances, what does the statute say? That the patentee must surrender his patent, and that a new patent may issue in conformity with his corrected specification, and thereafter operate, for the residue of the original term, on the trial of all actions thereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing out of the original patent. And in this case the Commissioner is not bound to grant such reissue, nor can he grant it except in cases where the error has arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention. Similar proceedings may be had in regard to the addition of an improvement. Act of 1836, section 13.

(The remainder of the argument upon this head is omitted.)

It is respectfully submitted, then,—

1. Because the defendant in error has no grant of exclusive privilege in the machine which is the subject-matter of the present controversy.

2. Because he could not in law receive a grant for it, as one of several distinct machines in the same patent.

3. Because, as the author of an improvement, he could not take out a valid patent for the whole machine.

4. Because he has not in his specification distinguished between the old and new parts of his alleged improved machine, but has claimed the whole machine as improved.

5. Because he did not produce in evidence the record of his patent which the law had made such, but another record. And,

6. Because he has recovered damages for causes of action accruing previously to the alleged correction of his record, and prior to the alleged renewal of it under the act of 1837.

For all these reasons, and for others raised upon the exceptions and record in this cause, presented perhaps too much at length, but not more at length, in the view of counsel, than their public import-

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ance may justify,—that the judgment of the Circuit Court in this case ought to be reversed.

Mr. Justice WOODBURY delivered the opinion of the court.

This is a writ of error brought under some peculiarities which are first to be noticed.

It comes here by virtue of the seventeenth section of the general Patent Law of July 4, 1836. 5 Statutes at Large, 124.

That section grants a writ of error from decisions of actions on patents, as in ordinary cases, and then adds the privilege of it “in all other cases in which the court shall deem it reasonable to allow the same.” This was doubtless intended to reach suits where the amount in dispute was less than \$2,000, on account of the importance of the points sometimes raised, and the convenience of having the decisions on patents uniform, by being finally settled, when doubtful, by one tribunal, such as the Supreme Court.

The judges below, in this case, deemed it reasonable, that only a certain portion of the questions raised at the trial, concerning the validity of the patent, should come here; and the record was made up accordingly.

But the appellants contend for their right to bring here all the questions which arose in the case, and this is a preliminary point to be settled, before going into the merits. The present is believed to be the first writ of the kind which has given occasion for settling the construction of any part of the above provision; and, therefore, without the aid of precedent, after due consideration of the words and design of the statute, we have come to the conclusion, that the position of the plaintiffs in error, in this respect, is the correct one, and that when a court below deem it “reasonable” to allow a writ of error at all, under the discretion vested in them by this special provision, it must be on the whole case.

The word “reasonable” applies to the “cases,” rather than to any discrimination between the different points in the cases.

It may be very proper for the court below to examine those points separately and with care, and if most of them present questions of common law only, and not of the construction of the Patent Acts, and others present questions under those acts which seem very clearly settled or trifling in their character, not to grant the writ of error at all. It might, then, well be regarded as not “reasonable” for such questions, in a controversy too small in amount to make the writ a matter of right to persons, if standing on an equal footing with the suitors. But we think, from the particular words used rather than

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otherwise, that the act intended, if the court allowed the writ as "reasonable" at all, it must be for the whole case, or, in other words, must bring up the whole for consideration.

We shall, therefore, proceed to examine all the questions made at the trial, which it is supposed are relied on, and are now before us on the original writ and a *certiorari* issued since.

Looking to the declaration, the action is for a violation of a patent for an "improvement in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land."

The evidence offered at the trial, was a patent for "a new and useful improvement in the steam-engine," "a description whereof is given, in the words of the said John B. Emerson himself, in the schedule hereto annexed, and is made a part of these presents."

In the schedule annexed, is described fully what he says he invented, namely, "certain improvements in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land."

The first question arising on this statement, is whether the evidence proves such a patent as is set out in the writ to have been violated by the respondents.

If the patent is to be ascertained from the letters alone, or rather from what is sometimes called their title or heading, without reference to the schedule annexed, the evidence is undoubtedly defective, as the writ speaks of a patent for an "improvement in the steam-engine, and in the mode of propelling" vessels, &c., therewith; while the letters themselves, in their title or heading, speak only of a patent for "a new and useful improvement in the steam-engine." But the schedule annexed and referred to for further description, after "improvement in the steam-engine," adds, "and in the mode of propelling therewith" vessels, &c.

It can hardly be doubted, therefore, that the improvement referred to in the writ and in the letters patent, with the schedule or specification annexed, was in truth one and the same.

Coupling the last two together, they constitute the very thing described in the writ. But whether they can properly be so united here, and the effect of it to remove the difficulty, has been questioned, and must therefore be further examined. We are apt to be misled, in this country, by the laws and forms bearing on this point in England being so different in some respects from what exist here.

There, the patent is first issued, and contains no reference to the specification, except a stipulation that one shall, in the required time,

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be filed, giving a more minute description of the matter patented. Webster on Patents, 5, 88; Godson on Patents, 6, App. It need not be filed under two to four months, in the discretion of the proper officer. Godson on Patents, 176.

Under these circumstances, it will be seen that the patent, going out alone there, must, in its title or heading, be fuller than here, where it goes out with the minute specification. But even there it may afterwards be aided, and its matter be made more clear, by what the specification contains. They are, says Godson on Patents, 108, "connected together," and "one may be looked at to understand the other." See also 2 Hen. Bl., 478; 1 Webst. Pat. R., 117; 8 D. & E., 95.

There, however, it will not answer to allow the specification, filed separately and long after, to be resorted to for supplying any entire omission in the patent; else something may be thus inserted afterwards which had never been previously examined by the proper officers, and which, if it had been submitted to them in the patent and examined, might have prevented the allowance of it, and which the world is not aware of, seeing only the letters patent without the specification, and without any reference whatever to its contents. 3 Brod. & Bingh., 5.

The whole facts and law, however, are different here. This patent issued March 8, 1834, and is therefore to be tested by the act of Congress then in force, which passed February 21, 1793. 1 Statutes at Large, 318.

In the third section of that act, it is expressly provided "that every inventor, before he can receive a patent," "shall deliver a written description of his invention," &c.;—thus giving priority, very properly, to the specification rather than the patent.

This change from the English practice existed in the first Patent Law, passed April 10, 1790, (1 Statutes at Large, 109,) and is retained in the last act of Congress on this subject, passed July 4, 1836. 5 Statutes at Large, 119.

It was wisely introduced, in order that the officers of the government might, at the outset, have before them full means to examine and understand the claim to an invention better, and decide more judiciously whether to grant a patent or not, and might be able to give to the world fuller, more accurate, and early descriptions of it than would be possible under the laws and practice in England.

In this country, then, the specification being required to be prepared and filed before the patent issues, it can well be referred to therein *in extenso*, as containing the whole subject-matter of the claim or petition

for a patent, and then not only be recorded for information, as the laws both in England and here require, but, beyond what is practicable there, be united and go out with the letters patent themselves, so as to be sure that these last thus contain the substance of what is designed to be regarded as a portion of the petition, and thus exhibit with accuracy all the claim by the inventor.

But before inquiring more particularly into the effect of this change, it may be useful to see if it is a compliance with the laws in respect to a petition which existed when this patent issued, but were altered in terms shortly after.

A petition always was, and still is, required to be presented by an inventor when he asks for a patent, and one is recited in this patent to have been presented here. It was also highly important, in England, that the contents of the petition as to the description of the invention should be full, in order to include the material parts of them in the patent, no specification being so soon filed there, as here, to obtain such description from, or to be treated as a portion of the petition, and the whole of it sent out with the patent, and thus complying with the spirit of the law, and giving fuller and more accurate information as to the invention than any abstract of it could.

In this view, and under such laws and practice here, it will be seen that the contents of the petition, as well as the petition itself, became a very unimportant form, except as construed to adopt the specification, and the contents of the latter to be considered substantially as the contents of the former.

Accordingly, it is not a little curious, that though the act of 1793, which is to govern this case, required, like that of 1790, a petition to be presented, and the patent when issued, as in the English form, to recite the "allegations and suggestions of the petition," (1 Statutes at Large, page 321, section 1, and page 110, section 3,) yet, on careful inquiry at the proper office, so far as its records are restored, it appears that, after the first act of 1790 passed, the petitions standing alone seldom contained anything as to the patent beyond a mere title; sometimes fuller, and again very imperfect and general, with no other allegations or suggestions or descriptions whatever, except those in the schedule or specification. The only exception found is the case of *Evans v. Chambers*, 2 Wash. C. C., 125, in a petition filed December 18, 1790.

Though the records of the Patent Office before 1836 were consumed in that year, many have been restored, and one as far back as August 10, 1791, where the petition standing alone speaks of having invented only "an easy method of propelling boats and other vessels through

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the water by the power of horses and cattle." All the rest is left to the schedule. Other petitions, standing alone, are still more meagre. One, for instance, in 1804, asks a patent only of a "new and useful improvement, being a composition, or tablets to write or draw on;" another, only "a new and useful improvement in the foot-stove;" and another, only "a new and useful improvement for shoemaking;" and so through the great mass of them for nearly half a century. But the specification being filed at the same time, and often on the same paper, it seems to have been regarded, whether specially named in the petition or not, as a part of it, and as giving the particulars desired in it; and hence, to avoid mistakes as to the extent of the inventor's claim, and to comply with the law, by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. This may have grown out of the decision of *Evans v. Chambers*, in order to remedy one difficulty there. Cases have been found, as early as 1804, and with great uniformity since, explicitly making the schedule annexed a part of the letters patent. Proofs of this exist, also, in our reports, as early as 1821, in *Grant et al. v. Raymond*, 6 Peters, 222; and one, 1st October, 1825, in *Gray et al. v. James et al.*, Peters' C. C., 394; and 27th December, 1828, *Wilson v. Rousseau*, 4 How., 649.

Indeed, it is the only form of a patent here known at the Patent Office, and the only one given in American treatises on patents. Phillips on Patents, 523. Doubtless this use of the schedule was adopted, because it contained, according to common understanding and practice, matter accompanying the petition as a part of its substance, and all the description of the invention ever desired, either in England or here, in the petition. Hence it is apparent, if the schedule itself was made a part of the patent, and sent out to the world with it, all, and even more, was contained in it than could be in any abstract or digest of a petition, as in the English form.

We regard this mode and usage on this subject, adopted so early here and practiced so long, as not proper to be overruled now, to the destruction of every patent, probably, from 1791 to 1836; and this, too, when the spirit of all our system was thus more fully carried out than it could have been in any other way.

As this course, however, sometimes was misunderstood and led to misconstructions, the revising act as to patents, of July 4th, 1836, changed the phraseology of the law in this respect, in order to conform to this long usage and construction under the act of 1793, and required not in terms any abstract of the petition in the patent, but

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rather "a short description" or title of the invention or discovery, "correctly indicating its nature and design," and "referring to the specification for the particulars thereof, a copy of which shall be annexed to the patent." And it is that—the specification or schedule—which is fully to specify "what the patentee claims as his invention or discovery." Section 5. 5 Statutes at Large, 119.

It was, therefore, from this long construction, in such various ways established or ratified, that, in the present patent, the schedule, or, in other words, the specification, was incorporated expressly and at length into the letters themselves,—not by merely annexing them with a wafer or tape, as is argued, but describing the invention as an "improvement, a description whereof is given, in the words of the said John B. Emerson himself, in the schedule hereto annexed, and is made a part of these presents." Hence, too, wherever this form has been adopted, either before or since the act of 1836, it is as much to be considered with the letters, (*litteræ patentēs*), in construing them, as any paper referred to in a deed or other contract. Most descriptions of lands are to be ascertained only by the other deeds and records expressly specified or referred to for guides; and so of schedules of personal property, annexed to bills of sale. *Foxcroft v. Mallett*, 4 How., 378; 21 Maine, 69; 20 Pick., 122; Phil. on Patents, 228; *Earle v. Sawyer*, 4 Mason C. C., 9; *Ex parte Fox*, 1 Ves. & Beames, 67. The schedule, therefore, is in such case to be regarded as a component part of the patent. *Peters' C. C.*, 394, and *Davis v. Palmer et al.*, 2 Brockenbrough, 301. The oath of Emerson, too, that he was inventor of the improvement, must thus be considered as extending to all described in the schedule, no less than the title; and this is peculiarly proper, when the specification is his own account of the improvement, and the patent is usually only the account of it by another, an officer of the government. Taking, then, the specification and letters together, as the Patent Office and the inventor have manifestly in this instance intended that they should be, and they include what has long been deemed a part and the substance of the petition; and the patent described in them is quite broad enough to embrace what is alleged in the writ to have been taken out as a patent by the plaintiff, and to have been violated by the defendants. They are almost *ipsissimis verbis*. And when we are called upon to decide the meaning of the patent included in these letters, it seems our duty not only to look for aid to the specification as a specification, which is customary, (1 Gall., 437; 2 Story R., 621; 1 Mason C. C., 477,) but as a schedule, made here an integral portion of the letters themselves, and going out with them to the world, at first, as a part



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and parcel of them, and for this purpose united together forever as identical.

It will thus be seen, that the effect of these changes in our Patent Laws, and the long usage and construction under them, is entirely to remove the objection, that the patent in this case was not as broad as the claim in the writ, and did not comply substantially with the requirements connected with the petition.

From want of full attention to the differences between the English laws and ours, on patents, the views thrown out in some of the early cases in this country do not entirely accord with those now offered. *Paine C. C.*, 441; *Pennock et al. v. Dialogue*, 2 Pet., 1. Some other diversity exists at times, in consequence of the act of 1793, and the usages under it in the Patent Office, not being in all respects as the act of 1836. But it is not important, in this case, to go farther into these considerations.

The next objection is, that this description in the letters, thus considered, covers more than one patent, and is, therefore, void.

There seems to have been no good reason at first, unless it be a fiscal one on the part of the government when issuing patents, why more than one in favor of the same inventor should not be embraced in one instrument, like more than one tract of land in one deed, or patent for land. *Phillips on Patents*, 217.

Each could be set out in separate articles or paragraphs, as different counts for different matters in libels in admiralty or declarations at common law, and the specifications could be made distinct for each, and equally clear.

But, to obtain more revenue, the public officers have generally declined to issue letters for more than one patent described in them. *Renouard*, 293; *Phillips on Patents*, 218. The courts have been disposed to acquiesce in the practice, as conducive to clearness and certainty; and if letters issue otherwise, inadvertently, to hold them, as a general rule, null. But it is a well-established exception, that patents may be united, if two or more, included in one set of letters, relate to a like subject, or are in their nature or operation connected together. *Phillips on Patents*, 218, 219; *Barrett v. Hall*, 1 Mason C. C., 447; *Moody v. Fisk*, 2 Mason C. C., 112; *Wyeth et al. v. Stone et al.*, 1 Story, 273.

Those here are of that character, being all connected with the use of the improvements in the steam-engine, as applied to propel carriages or vessels, and may therefore be united in one instrument.

Another objection is, that these letters, even when thus connected

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with the specification, are not sufficiently clear and certain in their description of the inventions.

This involves a question of law only in part, or so far as regards the construction of the written words used. *Reutgen v. Kanours et al.*, 1 Wash. C. C., 168; *Davis v. Palmer et al.*, 2 Brockenbrough C. C., 303; *Wood v. Underhill*, 5 How., 1. The degree of clearness and freedom from ambiguity required in such cases is, by the Patent Act itself of 1793, to be sufficient "to distinguish the same from all other things before known, and to enable any person skilled in the art or science of which it is a branch, or with which it is most nearly connected, to make, compound, and use the same." 1 Statutes at Large, 321. See, also, on this, Godson on Patents, 153, 154; 2 Hen. Bl., 489; *Wood v. Underhill*, 5 How., 1; *Davoll et al. v. Brown*, 1 Woodb. & Minn., 57; Peters' C. C., 301; *Sullivan v. Redfield*, Paine C. C., 441.

There are some further and laudable objects in having exactness to this extent, so as, when the specification is presented, to enable the Commissioner of Patents to judge correctly whether the matter claimed is new or too broad. 3 Wheat., 454; 3 Brod. & Bingh., 5; 1 Starkie, N. P., 162. So, also, to enable courts, when it is contested afterwards before them, to form a like judgment. 1 Starkie, N. P., 192. And so that the public, while the term continues, may be able to understand what the patent is, and refrain from its use, unless licensed. Webster on Patents, 86; 11 East., 105; 3 Merivale, 161; *Evans v. Eaton*, 3 Wash. C. C., 453; 4 Wash. C. C., 9; *Bovill v. Moore*, Davies' Cases, 361; *Lowell v. Lewis*, 1 Mason C. C., 182-189.

In the present instance, yielding to the force of such reasons in favor of a due and rational degree of certainty in describing any improvements claimed as new, there still seems to us, though without the aid of experts and machinists, no difficulty in ascertaining, from the language used here, the new movement intended to be given to the steam-engine, by substituting a continued rotary motion for a crank motion, and the new form of the spiral wheel, when the engine is used in vessels, by changing the form of the paddles and placing them near the ends of the arms; and the new connection of the power with the capstan of such vessels, by inserting the upper end of the shaft into the capstan. It is obvious, also, that the inventor claims as his improvement not the whole of the engine, nor the whole of the wheel, but both merely in the new and superior form which he particularly sets out. He, therefore, does not claim too much, which might be bad. *Hill v. Thompson et al.*, 2 J. Marsh., 435; 4 Wash. C. C., 68; Godson on Patents, 189; *Kay v. Marshall*, 1 Mylne & Cr.,

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373; 1 Story R., 273; 2 Mason C. C., 112; 4 Barn. & Ald., 541; *Bovill v. Moore*, 2 Marsh Com. P. Rep., 211.

The novelty in each he describes clearly, as he should; and it is not necessary he should go further. 1 Story R., 286; Webster on Patents, 86, note; *McFarlane v. Price*, 1 Starkie, 199; and *King v. Cutler*, Id., 354; 3 Car. & Payne, 611; 2 Mason C. C., 112; Kingsby & Pirsson on Patents, 61; Godson on Patents, 154; *Isaacs v. Cooper et al.*, 4 Wash. C. C., 259.

He need not describe particularly, and disclaim all the old parts. 7 Wheat., 435; Phillips on Patents, 270, and cases cited.

And the more especially is that unnecessary, when such disclaimer is manifestly, in substance, the result of his claiming as new only the portions which he does describe specially. All which is required on principle, in order to be exact, and not ambiguous, thus becomes so.

It is to be recollected, likewise, that the models and drawings were a part of this case below, and are proper to be resorted to for clearer information. *Earle v. Sawyer*, 4 Mason C. C., 9. With them and such explanatory testimony as experts and machinists could furnish, the court below were in a condition to understand better all the details, and to decide more correctly on the clearness of the description; but from all we have seen on the record alone, we do not hesitate to concur in the views on this point as expressed in that court.

In conclusion, on the other objections to the proof, as to the drawings and to the charge below in relation to the effect of them, and to the destruction of them by fire, we likewise approve the directions given to the jury.

The destruction by fire was no fault of the inventor; and his rights had all become previously perfected. This is too plain to need further illustration. We cannot consent to be over-astute in sustaining objections to patents. 4 East., 135; *Crosley v. Beverley*, 3 Car. & Payne, 513, 514. The true rule of construction in respect to patents and specifications, and the doings generally of inventors, is to apply to them plain and ordinary principles, as we have endeavored to on this occasion, and not, in this most metaphysical branch of modern law, to yield to subtleties and technicalities, unsuited to the subject, and not in keeping with the liberal spirit of the age, and likely to prove ruinous to a class of the community so inconsiderate and unskilled in business as men of genius and inventors usually are.

Indeed, the English letters patent themselves, now, however different may have been once their form or the practice under them, declare that "they are to be construed" "in the most favorable and beneficial sense, for the best advantage" of the patentee. Godson

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on Patents, 24, App. 7; *Kingsby & Pirsson on Patents*, 35. See, also, on this rule, *Grant v. Raymond*, 6 Peters, 218; *Ames v. Howard*, 1 Sumn., 482-485; *Wyeth v. Stone*, 1 Story R., 273, 287; *Blanchard v. Sprague*, 2 Story R., 164; 2 Brockenbrough C. C., 303; 2 Barn. & Ald., 345, in *The King v. Wheeler*; 5 Howard, 708, in *Wilson v. Rousseau et al.*; 1 Crompt. Mees. & Ros., 864, 876, in *Russell v. Cowley*.

The judgment below is

AFFIRMED.

NOTE.—After the delivery of this opinion, the counsel for the plaintiffs in error suggested that other questions were made below, which they desired to be considered, and therefore moved for another *certiorari* to bring them up. This was allowed, and judgment suspended till the next term.

FREDERICK J. AND SAMUEL W. BARNARD AND HENRY Q. HAWLEY,  
APPELLANTS, v. JOHN GIBSON.\*

(7 Howard, 650.)

1. Where a decree in chancery refers the matters to a master to ascertain the amount of damages, and in the meantime the bill is not dismissed, nor is there a decree for costs, the decree is not a final one, from which an appeal will lie to this court, although there is a perpetual injunction granted.
2. The amount of damage which will follow from restraining a party from using a machine held under a patent-right is a proper consideration to be addressed to the Circuit Court, but does not constitute a ground of appeal.

THIS was an appeal from the Circuit Court of the United States for the Northern District of New York.

The question being, whether or not the decree of the Circuit Court was final, the reporter thinks it proper to insert the whole of that decree, together with the statement of facts, as he finds it prepared by Mr. Justice NELSON.

*Circuit Court, United States.*

JOHN GIBSON

v.

FREDERICK J. BARNARD AND OTHERS.

} In Equity.

I. W. W. Woodworth conveyed to John Gibson the exclusive right to the Woodworth planing-machine in and for the city and county of

\*Mr. Chief Justice TANEY did not sit in this cause, being indisposed at the time it was argued.

## Statement of the case.

Albany, with the single exception of two rights in the town of Watervliet, in said county. With this exception, the whole right of the county was in Gibson.

II. The two machines, the right to use which was thus excepted, consisted, first, of a machine in use at the time in said town by Rousseau and Easton, which had been erected under the first term of the patent, and the right to continue which they claimed during any extension of the grant; and, second, of a machine which Gibson had conveyed to Woodworth, and by him to Rousseau and Easton.

III. Woodworth, on the 19th of May, 1842, agreed with Rousseau and Easton to make an assignment to them by which they would become vested more fully with the right of running the machine in the town of Watervliet, which they claimed under the first term of the patent; and, also, to assign to them the right to use the other machine which had been conveyed to him by Gibson, of even date with this agreement. In consideration of which, Rousseau and Easton paid at the time \$200; and, in case the extension should be obtained, and assignment of the two machines, as above stipulated for, made, they would pay, in addition, \$2,000, in four equal annual installments.

IV. This agreement, of the 19th of May, 1842, was modified by an indorsement on the same, signed by all parties, 26th April, 1843, in which it was recited that Rousseau and Easton had, on that day, executed and delivered to Woodworth eight promissory notes, of \$250 each, payable at different periods, the last one 1st July, 1846; in consideration thereof, the said Woodworth agreed that, upon payment of said notes as they became due, he would make the assignments stipulated for in the said agreement referred to.

V. On the 12th of August, 1844, Woodworth assigned all his interest in this contract with Rousseau and Easton in respect to the two machines, and all right and title to the use of the same, to J. G. Wilson, by which he took the place of Woodworth.

VI. On the 13th of November, 1844, Gibson renounced and released all right or claim, if any, to these two machines, to J. G. Wilson, this having been supposed necessary to enable Wilson to sue Rousseau and Easton for breach of their contract, or for an infringement of the Woodworth patent and extension by the use of the machines in the town of Watervliet, after refusing to fulfill their contract. Gibson claimed no right to the use of the two machines in said town, as he had already passed to Woodworth all the right which he ever had in the same. The release was given for abundant caution, the better to secure to Wilson the right which he had acquired by the assignment from Woodworth.

## Statement of the case.

VII. On the 5th of December, 1845, J. G. Wilson granted to F. J. Barnard & Son a license to construct and use two machines in the town of Watervliet, for which he was to receive \$4,000; but it was then and there agreed that, if the decision of the Supreme Court of the United States, in a case then pending between Wilson and Rousseau and Easton, should be against Wilson, so as to exclude him from the use of the said two machines in the said town, then he was to repay to Barnard & Son \$2,000, paid to him on that day in part satisfaction of the purchase-money; but if the decision should be in favor of Wilson, and Barnard & Son should be put in possession of the right to erect and use the two machines in said town, then they were to pay to Wilson a further sum of \$2,000.

VIII. Upon the foregoing state of facts, and upon the pleadings and proofs in the case, it is quite clear that, down to the time of the grant of Wilson to Barnard & Son, the 5th of December, 1845, Gibson, the complainant, possessed the exclusive right and title to the planing-machine in and for the county of Albany, with the exception of the two rights in the town of Watervliet, namely, the right to use one claimed by Rousseau and Easton under the first grant, and more effectually secured to them by Woodworth, and the one sold and assigned by Gibson to Woodworth, and by him to Rousseau and Easton.

And, further, that Wilson possessed no interest in any right to the use of the planing-machine in the town of Watervliet, except in the two so derived from Woodworth by assignment of the 12th of August, 1844, and which had before been sold to Rousseau and Easton, and of which they were in the actual use and enjoyment. Wilson, therefore, could grant his interest, whatever it might be, in these two rights, and nothing more; and this was all that could pass to Barnard & Son under the grant of the 5th of December, 1845. The terms of that agreement also establish that it was the interest of Wilson in these two rights which he intended to sell, and Barnard & Son to purchase.

IX. The failure of Rousseau and Easton to fulfill their agreement of purchase with Woodworth, the interest in which belonged to Wilson, did not, of itself, operate to annul and cancel the contract. It was a contract partly executed; \$200 of the purchase-money had been paid, and promissory notes given for the residue. The machines had been erected, and were in operation; and although a court of equity might have decreed the contract to be delivered up and cancelled upon terms, until then Rousseau and Easton must be deemed in the lawful use and enjoyment of the two rights under the patent. And even

## Statement of the case.

assuming the contract to be annulled, and the parties remitted to their original rights, it is clear that Wilson had power to grant but one of the rights in said town of Watervliet, as the other was secured to Rouseau and Easton under the decision of the court in *Wilson v. them*.

An injunction was accordingly issued.

On the 11th of April, 1848, the Circuit Court of the United States for the Northern District of New York was in session at Utica, when the following decree was passed:

"This cause having been brought on to be heard upon pleadings and proofs, and Mr. Wm. H. Seward having been heard on the part of the plaintiff, and Mr. Marcus T. Reynolds on the part of the defendants, and due deliberation having been had, it is ordered, adjudged, and decreed that the defendants in this cause be, and they are hereby, perpetually enjoined from any further constructing or using, in any manner, and from selling or disposing, in any manner, of the two planing-machines mentioned in said bill, as erected by them in the town of Watervliet, in the county of Albany, or either of said machines, which machines are machines for dressing boards and plank, by planing, tonguing, or grooving, or either, or in some separate combination, constructed upon the principle and plan specified and described in the schedule annexed to letters patent issued to Wm. W. Woodworth, administrator of William Woodworth, on the 8th day of July, 1845, which letters were a renewal upon a formal surrender for an imperfect specification of letters patent issued to Wm. Woodworth on the 27th day of December, 1828, and extended on the 16th day of November, 1842, to take effect on the 27th day of December, 1842, and again extended by act of Congress on the 26th day of February, 1845, and from infringing upon or violating the said patent in any way whatsoever.

"And it is further ordered, adjudged, and decreed that it be referred to Julius Rhodes, Esq., of Albany, counsellor at law, as a master *pro hac vice* in this cause, with the usual powers of a master of this court, to ascertain and report the damages which the plaintiff has sustained, arising from the infringement of his rights by the defendants, by the use of the said two machines by them.

"And it is further ordered, that the report of the said master herein may be made, either to this court in term time, or to one of the judges thereof at chambers in vacation; and that either party may, on ten days' notice to the other of time and place, apply, either to this court in term time, or to one of the judges thereof at chambers in vacation, for confirmation of such report.

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Motion to dismiss the appeal.

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“And it is further ordered, that either party may, at any time, on ten days’ notice of time and place to the other, apply to this court in term time, or to one of the judges thereof in vacation, for further directions in the premises.

“And the question of costs, and all other questions in this cause, are hereby reserved until the coming in of the said report.

“And the complainant shall either pay to the defendants, or set off against the damages to be awarded, the sum of two thousand dollars, which he offered in his bill to pay them, with interest from the 5th of December, 1845.”

An appeal from this decree brought the case up to this court.

*Mr. Seward* moved to dismiss the appeal, upon the ground that the decree was not a final one, which motion was opposed by *Mr. Taber*.

*Mr. Seward* stated the case, and then said that it was admitted that an appeal would not lie, except from a final decree. The only question is, what is the distinction between final and interlocutory decrees. The same principle may be applied which governs the construction of judgments at law; those are final which grant a remedy upon the whole matter, and dismiss a party from the court. But in equity there is some difficulty, owing to the different nature of the relief which is granted. A final decree in equity may be defined to be one which definitively adjudges the whole subject-matter; an interlocutory decree, one which disposes of some parts and reserves others for future decision. 2 Daniell, Ch. Pr., Part 2, pp. 631, 632, 635, 638, 641, London edition of 1840. The present decree is not final, when tested by the principles laid down by Daniell.

1. It expressly reserves the question of costs. They do not depend upon any statute, but upon judicial discretion.

2. It does not determine the amount of damages, but refers the subject to a master to ascertain and report.

3. Even if the master decides, still the decree does not adjudge them to be according to the report.

4. It does not settle any principles upon which damages can be computed, whether they are for one machine or two, &c.

5. It reserves a decision upon the rights of the respective parties. The complainant offered, in his bill, to pay \$2,000; the decree says he shall do so, but does not say whether it is an extinguishment of the claim, or only a set-off.

6. The bill prays that the machines and their produce may be delivered to the plaintiff; but the decree is silent upon this point. The



## Argument against the motion.

question is reserved. It may be said that a perpetual injunction is decisive of the rights of the parties. But it is only an order, which the court may revoke at any time. It cannot be pleaded in bar. We think the parties are still in court.

7. The decree does not give all the relief which is prayed for in the bill. Whatever is asked and not granted is left undecided, because the bill is not dismissed as to that.

(*Mr. Seward* then commented on 10 Wheat., 502; 11 Wheat., 429; 8 Peters, 318; 9 Peters, 1; 6 Cranch, 51; 15 Peters, 287; 2 How., 62; 5 How., 51; 6 How., 203; *Ib.*, 208, 209.)

*Mr. A. Taber*, against the motion.

1. The decree in question is a "final decree," upon a sound construction of the Judiciary Act of 1803, ch. 93, sec. 2. The fundamental purpose of this act was to give an appeal, if required, where the amount in controversy was sufficient, to the end that the substantial rights of parties should not be finally disposed of by Circuit Courts. Not so of the English statutes of limitations, authorities construing which have been cited on the other side. Their leading object was, not to give or take away an appeal, but to restrict, by a short limitation, appeals taken *pendente lite*, allowing a longer one to those taken after the cause was ended. Wherefore, the words "final decree," in these English acts, are justly interpreted to mean one which is a *finis* of the cause, and in our act, one which is a *finis* of substantial rights of the parties, which, unless immediately appealed from, would take away property from one and give it to another, or work irreparable mischief. 6 How., 202, 203, 206; 13 Peters, 15; 3 Cranch, 179; 2 Smith's Chan. Prac., 187, 188.

The decree in question would do both. It was intended by the Circuit Court finally to adjudge and determine the patent-rights in controversy. It takes them away from the defendants, and vests them in the complainant; and, by the perpetual injunction it directs, immediately renders worse than valueless—an incumbrance upon the ground—the expensive erections of the defendants for their enjoyment.

For the costs of the cause, no appeal would hereafter lie. 4 Russell, Ch., 180; 3 Peters, 307, 319; 2 How., 210, 237. The other matters reserved are merely in execution of the decree already passed. Before these matters could have been adjusted, and an appeal prosecuted to effect, our patent-rights would have expired by their own limitation, and nothing remain for the appellate offices of this court but a *post mortem* examination of our rights for the vindication of abstract law.

The perpetual injunction, the main relief prayed, is a final execution,—not the mere extension of a preliminary injunction, which latter has been repeatedly denied in this cause, and is wholly inapplicable to a contest between assignees under the same patent, which is, therefore, no more *primâ facie* evidence for one party than the other. 4 Burr., 2303, 2400; 1 Vernon, 120; Id., 275; 7 Ves., 1; 3 Meriv., 622; 14 Ves., 130–132; Drewry on Injunctions, 223, sec. 5, 221, sec. 3, 223, sec. 4; Eden on Injunctions, 207.

2. But if this is not a case for an appeal under the act above cited, it assuredly must be one of “all other cases” provided for by the seventeenth section of the Patent Act of 1836, ch. 747. In patent causes, evidently for the reasons above alluded to, there is no limitation of an appeal, except the safe one that “the court shall deem it reasonable to allow the same.” If the act means this honorable court, this appeal has been allowed by it, by one of its justices at chambers. If, as is more probable, the Circuit Court was intended, (6 How., 458 and note, and 477,) then Justice NELSON, being a quorum of that court, (Laws of 1837, ch. 801, sec. 3,) acted as such, judicially, in allowing it at chambers. 1 Brock., 380. Or, if error has occurred in the manner of taking this appeal, no statute restriction being in the way, it should be allowed, in furtherance of justice, to be amended now. Laws of 1789, ch. 20, sec. 32; 16 Peters, 319; 7 Wend., 508. And this, according to the last-cited case, would be properly done by simply denying this motion.

3. If it be replied to the last point, that this is not a case arising under the Patent Law, but under the common law of contracts and assignments, then the Circuit Court never had jurisdiction, the cause being between residents of the same State, and an appeal lies at any time, to reverse its decision already made, and dismiss the cause. 2 How., 244; 3 Id., 693; 8 Peters, 148; 16 Id., 97; 3 Dallas, 19.

Mr. Justice M'LEAN delivered the opinion of the court.

This is an appeal from the decree of the Circuit Court for the Northern District of New York.

The parties claim conflicting interests as assignees of Woodworth's patented planing-machine. The cause was submitted to the circuit judge, who decreed that the defendants below be perpetually enjoined from any further constructing or using in any manner the two planing-machines, &c., and the case was referred to a master to ascertain and report the damages which the plaintiff has sustained, arising from the infringement of his rights by the defendants by the use of the said two machines: The report of the master to be made in term

## Opinion of the court.

time, or to one of the judges at chambers in vacation, and, on ten days' notice, either party to move for confirmation of the report, &c. The question of costs was reserved until the coming in of the report, &c.

A motion is made to dismiss this appeal, on the ground that the decree is not final.

No point is better settled in this court, than that an appeal may be prosecuted only from a final decree. The cases are numerous where appeals have been dismissed, because the decree of the Circuit Court was not final. It is supposed there was a departure from this uniform course of decision, at the last term, in the case of *Forgay et al. v. Conrad*, 6 How., 201.

In that case the court says: "The decree not only decides the title to the property in dispute, and annuls the deeds under which the defendants claim, but also directs the property in dispute to be delivered to the complainant, and awards execution. And, according to the last paragraph in the decree, the bill is retained merely for the purpose of adjusting the accounts referred to the master. In all other respects, the whole of the matters brought into controversy by the bill are finally disposed of as to all of the defendants, and the bill as to them is no longer pending before the court." "If these appellants, therefore, must wait until the accounts are reported by the master and confirmed by the court, they will be subjected to irreparable injury."

The decree in that case would have been executed by a sale of the property, and the proceeds distributed among the creditors of the bankrupt, and lost to the appellants, before the minor matters of account referred to the master could be adjusted and acted on by the court. The course of procedure in the Circuit Court was irregular, and the consequent injury to the defendants would have been irreparable. Effect should not be given to its final orders by the Circuit Court, until the matters in controversy shall be so adjusted as to make the decree final. Any other course of proceeding will, in many cases, make the remedy by an appeal of no value.

The decree in the case under consideration is not final, within the decisions of this court. The injunction prayed for was made perpetual, but there was a reference to a master to ascertain the damages by reason of the infringement; the bill was not dismissed, nor was there a decree for costs. In several important particulars, this decree falls below the rule of decision in *Forgay v. Conrad*. The execution of the decree in that case would have inflicted on the defendant below an irreparable injury. The bill was dismissed as to the principal matters in controversy, and there was a decree for costs.

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Syllabus.

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It is said that the decree in this case, by enjoining the defendants below from the use of their machines, destroys their value and places the defendants in a remediless condition. That in the course of a few months their right to run the machines will expire, and that no reparation can be obtained for the suspension of a right by the act of the court. It is alleged, too, that many thousands of dollars have been invested in the machinery, which, by such a procedure, becomes useless.

The hardship stated is an unanswerable objection to the operation of the injunction, until all the matters shall be finally adjusted. If the injunction has been inadvertently granted, the Circuit Court has power to suspend it or set it aside, until the report of the master shall be sanctioned. And unless the defendants below are in doubtful circumstances, and cannot give bond to respond in damages for the use of the machines, should the right of the plaintiff be finally established, we suppose that the injunction will be suspended. Such is a correct course of practice, as indicated by the decisions of this court, and that is a rule of decision for the Circuit Court.

The appeal is dismissed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, and it appearing to the court here that the decree of the court below complained of is not a final decree within the meaning of the act of Congress, it is thereupon now here ordered and decreed by this court, that this cause be, and the same is hereby, dismissed for the want of jurisdiction.

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ELEAZER F. BACKUS, PLAINTIFF IN ERROR, v. WILLIAM GOULD AND DAVID BANKS, WHO SUE AS WELL FOR THE UNITED STATES AS THEMSELVES.

(7 Howard, 798.)

1. By the sixth section of the act of February 3, 1831, entitled "An act to amend the several acts respecting copyrights," the penalty of fifty cents on each sheet, whether printed or being printed, or published or exposed to sale, is limited to the sheets in possession of the party who prints or exposes them to sale.
2. It does not apply to those sheets which he had published, or procured to be published, whether they were found in his possession or not.

THIS case was brought by writ of error from the Circuit Court of the United States for the Northern District of New York.

It was a *qui tam* action, brought by Gould and Banks against Backus, for an alleged invasion of their copyright in nine volumes of Cowen's Reports, and the first three volumes of Wendell's Reports.

On the trial, the affidavit of John L. Wendell was read, stating that he, the deponent, was the real plaintiff, and that Gould and Banks were merely nominal plaintiffs.

In 1838, Backus published a book entitled "A Digest of the Causes decided and reported in the Superior Court of the City of New York, the Vice-Chancellor's Court, the Supreme Court of Judicature, the Court of Chancery, and the Court for the Correction of Errors, of the State of New York, from 1823 to October, 1836, with Tables of the Names of the Cases and of Titles and References, being a Supplement to Johnson's Digest."

To the declaration, Backus pleaded *nil debet*.

Upon the trial, the plaintiffs proved themselves entitled to the copyright of the first, second, and fifth volumes of Cowen's Reports, and of the second volume of Wendell's Reports. And that from the above volumes the defendant had transferred, literally, one hundred and forty-two and a half pages; and they proved a sale by the defendant of five hundred copies of his work.

The counsel for the defendant then prayed the court to instruct the jury as follows:

1st. That John L. Wendell, and not the plaintiffs, was the owner and proprietor of the copyright to the said first, second, and fifth volumes of Cowen's, and to the said second volume of Wendell's Reports, and that, by the statute, no person but the owner or proprietor could maintain said suit for said penalty, and prayed the court so to instruct the jury. But the court decided that the suit might be maintained in the name of William Gould and David Banks, notwithstanding the facts set forth in the affidavits of John L. Wendell, and so instructed the jury, and refused to instruct said jury as requested by defendant's counsel—to which decision, instruction, and refusal, the counsel for the defendant excepted.

2d. That the said books, called the first, second, and fifth volumes of Cowen's Reports, and second volume of Wendell's Reports, are not the subject of a copyright, and the publisher of them could acquire no exclusive right to the publication thereof, and therefore could not be unlawfully infringed, and prayed the court so to instruct the jury. But the court decided that, although the opinions of the several courts, as contained in said volumes of reports, were not the subject of a copy-

## Statement of the case.

right, yet that the indexes of said volumes, and the statement of the cases preceding the opinions, and the marginal notes, or synopsis of the case, at the head of each case, were the subject of a copyright, for any infringement of which this action would lie, and so charged and instructed the jury, and refused to charge or instruct the jury as prayed by the defendant's counsel—to which decision, charge, and instruction, and refusal, the defendant's counsel excepted.

3d. The defendant's counsel insisted, that if the said indexes were the subject of a copyright, yet it was the duty of the proprietor thereof, who obtained the copyright, to express, in the title deposited and published, (where he was not entitled to a copyright of the whole book,) the matter for which he claimed such copyright; that he could not obtain a valid copyright to such matter, which was a very small portion of the work, under a general claim to a copyright to the whole book, and in this case he had not only not claimed any such copyright to the indexes, but merely a copyright to the report of the cases, and therefore had not acquired any valid copyright to such indexes, and prayed the court so to instruct the jury. But the court decided that a copyright to the whole book would secure to the proprietors the exclusive right to such matter in the book as was susceptible of a copyright, although such matter composed ever so small a portion of the book, and so instructed the jury, and refused to instruct said jury as requested by the counsel for the said defendant—to which decision, instruction, and refusal, the counsel for the defendant excepted.

4th. The counsel for the defendant also insisted, that the plaintiffs having obtained a copyright purporting to be for the whole book, when they were only entitled to a copyright for a very small portion of the matter contained in such book, such copyright was wholly void, and no action would lie for any infringement of it, and prayed the court so to instruct the jury. But the court decided that such copyright would, and did, secure to the plaintiffs the exclusive right to such matter in said book, whether it were more or less, as they were entitled to obtain a copyright for, and that said copyright was not void, and that this action would lie for an infringement or pirating of any part of the matter in said books for which the plaintiffs were entitled to obtain a copyright, and so instructed the jury, and refused to instruct the jury as prayed by defendant's counsel—to which decision, instruction, and refusal, the defendant's counsel excepted.

5th. The counsel for the defendant also further insisted, that the publication of the said supplement, or third volume of Johnson's Digest, was not a printing or publishing of the said first, second, and

## Statement of the case.

fifth volumes of Cowen's Reports, and second volume of Wendell's Reports, of which the said plaintiffs claimed to have the copyright, within the section of either of the acts of Congress giving said penalty; that said penal sections of said acts were to be construed strictly, and did not impose any penalty for printing or publishing a small portion of the matter for which a copyright was obtained; that, by the terms of the statute, the penalty was only inflicted for an unauthorized printing, reprinting, or publishing, &c., a copy or copies of the whole of the map, chart, book, or books for which the copyright had been obtained, and that for such printing, reprinting, or publishing any smaller portion than the whole, this action could not be sustained; and prayed the court so to instruct the jury. But the court decided that an action for the penalty, given by the penal section of the act, would lie for the printing, reprinting, or publishing by the defendant of any part or portion of the matter in said first, second, and fifth volumes of Cowen's Reports, and second volume of Wendell's Reports, to which the plaintiffs were entitled to a copyright, and so instructed the jury, and refused to instruct the jury as prayed by the defendant's counsel—to which decision, instruction, and refusal, the counsel for the defendant excepted.

6th. The defendant's counsel also insisted, that the offense for which the penalty sued for was inflicted by the act of Congress, was in the nature of a criminal offense; that the penalty was inflicted by the statute, in part as a punishment for a criminal offense, and in part as a punishment for a tortious, if not a criminal, invasion of private property, and that the action was local; and that the act or offense for which this action was brought was committed in the State of Pennsylvania, and therefore out of the jurisdiction of this court, and consequently the present action could not be sustained, and prayed the court so to instruct the jury. But the court decided that the action could be sustained in any State of the Union, and so charged the jury, and refused to instruct the jury as prayed by the defendant's counsel—to which decision, charge, and refusal, the defendant's counsel excepted.

7th. The counsel for the defendant also insisted, that the publication by the defendant of a *bona fide* digest of the first, second, and fifth volumes of Cowen's Reports, and second volume of Wendell's Reports, was not an infringement of the copyright of the plaintiffs to said books; it was a benefit, and not an injury, to those books; and prayed the court so to instruct the jury, that if they found, from the evidence in the case, that the supplement, or third volume of Johnson's Digest, published by the said defendant, was a *bona fide* digest

## Statement of the case.

of the decisions of the cases contained in said volumes, and was published by the defendant in good faith, and not for the purpose of furnishing to the public the matter contained in said volumes in a cheaper form or for a less price than those volumes were sold for; and that said digest was, in fact, a benefit instead of an injury to said volumes, and would promote the sales thereof, that then said publication was no infringement of the plaintiffs' said copyright, and this action could not be sustained, and the defendant would be entitled to their verdict. But the court refused so to instruct the jury; but did charge and instruct the jury, that if the defendant had transferred to his said digest any part of the matter contained in the indexes of said first, second, and fifth volumes of Cowen's Reports, or second volume of Wendell's Reports, and thus availed himself of the labor of others contained in books of which the plaintiffs held the copyright, the plaintiffs were entitled to their verdict—to which refusal, and charge, and instruction, the defendant's counsel excepted.

8th. The counsel for the defendant also insisted, that from the very nature of the work published, the same idea contained in the indexes to said volumes of reports, if correctly stated in said indexes, must necessarily be stated in the digest published by defendant; and if published in English, substantially the same words must be used; and if the work was a *bona fide* digest, and not an evasion for the purpose of furnishing the public with the work in a cheaper form than the original, the publication of said digest by the defendant could not be deemed an invasion of the plaintiffs' copyright, unless the matter in said indexes had been literally transferred to the defendant's digest, and prayed the court so to instruct the jury. But the court refused so to instruct the jury, but instructed them that, if the defendant had transferred to the said digest, published by him, any part of matter contained in the indexes to said first, second, and fifth volumes of Cowen's Reports, and second volume of Wendell's Reports, it was an invasion of the plaintiffs' said copyright, for which this action would lie—to which refusal and instruction, the counsel for the defendant excepted.

9th. In regard to the amount of the penalty to be recovered, the defendant's counsel insisted that the plaintiffs could only recover fifty cents for every sheet of the matter transferred from said index to first, second, and fifth volumes of Cowen's Reports, and second volume of Wendell's, to the said digest of said defendant, as had been proved to have been found in his possession, either printing or printed, published or exposed for sale; and that there was no legal proof that any such sheets of said matter had been so found in said defendant's



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Argument for the plaintiff in error.

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possession, and prayed the court so to instruct the jury. But the counsel for plaintiffs insisted that they were entitled to recover fifty cents for every sheet of such matter which had been published, or procured to be published, by the defendant, whether the same were proved to have been found in the defendant's possession or not; and so the court decided and instructed the jury, and refused to instruct the jury as prayed by the counsel for the defendant—to which decision and instruction, and refusal to instruct, the defendant's counsel excepted.

And with such charge and instruction, the court submitted the cause to the jury, who, under such decisions, charge, and instruction, found a verdict for the plaintiffs for \$2,069.75 debt, and six cents costs.

Upon all these exceptions, the case came up to this court.

They were all fully argued, by *Mr. James Bayard* and *Mr. Joseph R. Ingersoll*, for the plaintiff in error, and *Mr. Wendell*, for the defendants in error.

The arguments upon all the points, except the one upon which the decision of the court turned, are omitted. The views expressed by *Mr. Bayard* were illustrated and enforced by *Mr. Ingersoll*, in his reply to *Mr. Wendell*.

*Mr. Bayard* said, that, before entering upon the argument, it was right, as well in justice to his honor the District Judge (CONKLING) before whom the case was tried, as to prevent any prejudice to the case from an apparent decision by the court below, to state the circumstances under which the case comes before this court.

This case, with another embracing precisely the same questions, (which it is agreed shall abide the event of this,) came on to be tried before his honor Judge CONKLING, who held the Circuit Court at Albany in October, 1843, in the absence of the Circuit Judge, (the late Mr. Justice THOMPSON,) who was absent from sickness. In order to take a verdict which should determine the facts in the case, and fix the amount of the penalty, if any had been incurred, the points of law were stated by counsel, and ruled by the judge without argument, with the understanding that they were to be argued before a full court, when Judge THOMPSON should be able to sit. His continued indisposition, which at last terminated in his death, prevented this from being done; and in July, 1845, judgment was entered upon the verdict, by order of plaintiffs' attorney, without argument. And this writ of error was sued out to bring the record into this court, where the case is really now to be decided for the first time.

(*Mr. Bayard* then proceeded to argue the several points, until he came to the ninth prayer to the court below.)

Again, by the express words of the act, the offender is to forfeit and pay fifty cents only "for every such sheet which may be found in his possession."

This limitation has been totally disregarded by the learned judge of the Circuit Court, who adopted the views of the counsel for the plaintiffs, who "insisted that they were entitled to recover fifty cents for every sheet of such matter which had been published, or procured to be published, by the defendant, whether the same were proved to have been found in the defendant's possession or not," and so decided and instructed the jury.

This appears to be a most manifest disregard of the terms of the statute, in order to give what the judge seems to have considered an equitable construction, making it extend to a case clearly beyond its terms, which is a mode of construction altogether inadmissible in the case of a penal statute.

The reason of this limitation of the penalty may not be very clear; but the words of the statute are plain, and when this is the case, there is no room for equitable construction in any statute, but especially in a penal one.

But it might not be difficult, if it were necessary, to find reasons for the limitation.

1st. Congress did not intend that an author should lie by during the two years allowed for bringing his action, permitting another to publish and vend his work during that time, and then recover fifty cents for every sheet so published.

This would be laying a trap for his ruin, as I have shown that the penalty upon an ordinary edition might exceed \$15,000; and if it were a popular work, several such editions might be disposed of in the course of two years.

2d. But for this limitation, several penalties might be incurred by several different persons on account of the same sheets.

The penalty is to be inflicted upon "any person who shall print, publish, or import, or cause to be printed, published, or imported, any copy, &c., without consent of the owner, or who shall (knowing the same to be so printed or imported) publish, sell, or cause to be published, sold, or exposed to sale, any copy," &c.

Not only, therefore, the publisher, but the printer, and every book-seller who sells a copy, may be liable to this penalty.

Now, upon the principle adopted by the court below, the penalty is incurred by the act of publication, printing, or selling, and the amount

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Argument for the plaintiff in error.

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is to be fixed by the number of copies published, printed, or sold, without regard to where they may be found. In case, therefore, of an edition of such a work, the publisher who has caused it to be printed, the printer who has actually printed it, the bookseller in whose store the whole edition has been placed for sale, and every bookseller to whom he has sent a part of it for sale, may be liable to the penalty of fifty cents for the same identical sheets. This could never have been intended.

3d. Again, it might be that a person who had unintentionally violated a copyright by the publication of a book, might, upon discovering that his publication was illegal, destroy the whole edition, and so relieve himself from the penalty. But according to the decision of the Circuit Court, he would still remain liable. Nay, if he were even to give the whole edition to the author of the protected work, he would still, on the principle of this decision, remain liable to this penalty.

These are some of the reasons which might be given for this limitation of the penalty; but whatever the reasons may have been, the words are plain, and measure the amount of the penalty by the number of sheets "found in defendant's possession."

If the intention of the legislature was what the Circuit Court held it to have been, it would have been perfectly easy and most obviously proper to have expressed that intention, either by omitting the words "which may be found in his possession," or by adding after the word "sale," in the next line, the words "or which he may have sold, or caused to be sold"; either of which, particularly the former, would have been the simple and natural mode of expressing the intention contended for by the plaintiffs.

Accordingly, we find that, in the British statutes on copyright, (of which there have been several,) there has been a change in this particular; and when the amount of the penalty was not intended to be measured by the number of books or sheets found in defendant's possession, it has been so expressed.

The first statute on this subject (from which all the subsequent ones, both in England and in this country, have been taken) was the statute 8 Anne, ch. 19, (1710,) which gives to authors and their assigns the sole right of printing, publishing, and vending their books for fourteen years, with the right of renewal for fourteen years longer if the authors are living at the expiration of the first term. And the first section provides that if any other person shall print, reprint, &c., any such book or books, without the consent of the author or his assignee, "then such offender or offenders shall forfeit such book or books, and all and every sheet or sheets, being part of such book or

books, to the proprietor or proprietors of the copyright thereof, who shall forthwith damask and make waste-paper of them; and further, that every such offender or offenders shall forfeit one penny for every sheet which shall be found in his, her, or their custody, either printed or printing, published or exposed to sale, contrary to the true intent and meaning of this act." Here we have the same limitation as in our act of Congress.

Next came the statute 12 George II, ch. 36, which was passed for the purpose of "prohibiting the importation of books reprinted abroad, and first composed or written and printed in Great Britain."

The first section of this statute, after prohibiting the importation for sale of books first written or printed in England, directs the forfeiture of the books so imported, to be damasked or made waste-paper of, as in the former statute, and then adds: "And further, that every such offender or offenders shall forfeit the sum of five pounds, and double the value of every book which he or they shall so import or bring into this kingdom, or shall knowingly sell, publish, or expose to sale, or cause to be sold, published, or exposed to sale, contrary to the true intent and meaning of this act."

Here we have the penalty not limited to the books found in the offender's custody or possession, but extended to all the books imported, sold, or exposed to sale contrary to the provisions of the statute.

The next statute was that of 15 George III, ch. 53, which was "An act for enabling the two universities in England, the four universities in Scotland, and the several colleges of Eton, Westminster, and Winchester, to hold in perpetuity their copyright in books given or bequeathed" to them, &c.

The first section of this act secures to the said universities and colleges the perpetual copyright in books given or bequeathed to them. The second section provides that if any person shall print, reprint, or import any such book or books, he or they shall forfeit the same, and every sheet thereof, to be damasked or made waste-paper of. "And further, that such offender or offenders shall forfeit one penny for every sheet which shall be found in his, her, or their custody, either printing or printed, published or exposed to sale, contrary to the true intent and meaning of this act." Here we have the penalty limited to the sheets found in the custody of the offender.

The next was the statute 41 George III, ch. 107, entitled "An act for the further encouragement of learning in the United Kingdom of Great Britain and Ireland, by securing the copies and copyright of printed books to the authors of such books, or their assigns, for the time herein mentioned."

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Argument for the plaintiff in error.

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This act is remarkable in several particulars, and especially with reference to the point now under consideration, that it has, in different sections, both the kinds of penalty, viz., one limited by the sheets found in the custody of the offender, and the other measured by the whole number of books imported. By the first section, after reciting that "it is expedient that further protection should be afforded to the authors of books," &c., the sole right of printing and reprinting is given to the author, &c., for fourteen years, with the right of renewal for another term of fourteen years, as before. Then it is enacted, that if any one violates this right, the offender or offenders shall be liable to a special action on the case, at the suit of the proprietor of the copyright, in which damages may be recovered. It is further enacted, that the offender shall forfeit such book or books, and all and every sheet and sheets, being part thereof, to be damasked, as before. "And all and every such offender and offenders shall also forfeit the sum of threepence for every sheet which shall be found in his or their custody, either printed or printing, or published or exposed to sale, contrary to the true intent and meaning of this act."

After several other provisions, not material to the present question, we come to the seventh section, which forbids the importation for sale of books first printed in the United Kingdom, and afterwards reprinted abroad. If any person shall import such book contrary to this act, "then every such book shall be forfeited, and may be seized by any officer of the customs, and the same shall be forthwith made waste-paper." "And all and every person so offending, upon conviction thereof, shall also, for every such offense, forfeit the sum of ten pounds, and double the value of each any every copy of such book or books which he, she, or they shall so import or bring, or cause to be imported or brought, into any part of the said United Kingdom."

Here was a statute intended to give "further protection" to authors, which it does by—1st, extending the sole right of authors, &c., to the whole of the United Kingdom of Great Britain and Ireland; 2d, giving a special action on the case to proprietors of copyrights; 3d, increasing the penalty on reprinting, &c., from one penny to threepence; 4th, giving to officers of the customs the right, and making it their duty, to seize and destroy any books imported, in violation of the act; 5th, increasing the penalty on importing such books from five to ten pounds. But the court will observe, that although this statute was intended to increase the protection to copyright, and although the legislature had fully in view the two different modes of measuring the penalty, imposing one in the first section and the other

in the seventh, yet they made no alteration in this respect with regard to books reprinted in the kingdom, but adhered to the original limitation contained in the statute of Anne, only increasing the penalty from one penny to threepence, while they follow the statute of 12 George II in extending the penalty on imported books to all books imported.

The next act shows the intention of the legislature still more clearly. That was the statute 54 George III, ch. 156, entitled "An act to amend the several acts for the encouragement of learning, by securing the copies and copyright of printed books to the authors of such books or their assigns."

The fourth section of this act extends the term of copyright to twenty-eight years, (with a subsequent extension, in section ninth, for the life of the author, if living at the expiration of the twenty-eight years,) gives the special action on the case for violation of the copyright, directs the forfeiture of every book printed, &c., in violation of the copyright, to be damasked, as before, and then provides, that "all and every such offender and offenders shall also forfeit the sum of threepence for every sheet thereof, either printed or printing, or published or exposed to sale, contrary to the true intent and meaning of this act." Here the limitation to *sheets found in the custody of the offender* is omitted; and this is particularly important, as I will show presently, when I come to examine the acts of Congress on this subject.

I have been thus particular in the examination of these British statutes, because the acts of Congress have been evidently taken from them, copying the very words, in many instances. And in the absence of decided cases, putting a judicial construction upon these acts, it is important to learn the sense of the legislature, as to the true meaning of the terms used, from the changes which have been made from time to time; and it is very evident, from this examination, that where the legislature intended to extend the penalty beyond the books or sheets found in the custody of the offender, they have said so in such a way as to leave no doubt about it; as, first, in the case of importation of protected books, the offender forfeits double the value of every book imported, and, finally, in 1814, and not till then, in case of reprinting in England, the offender shall forfeit threepence for every sheet, either printed or printing, or published or exposed to sale, contrary to the act.

In the last British statute on this subject, 5 and 6 Victoria, ch. 45, which repeals the former acts, and forms a complete system of copyright law, the penalty of pecuniary forfeiture is omitted altogether;

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Argument for the plaintiff in error.

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and the proprietor of a copyright has a special action on the case for damages, and a right to maintain detinue or trover for the pirated copies.

Now let us turn to the acts of Congress on this subject. The first was the act of the 31st of May, 1790, which gives to the author or authors of any map, chart, book or books, (being citizens of the United States,) and their executors, administrators, and assigns, the sole right to print, reprint, publish, and vend the same for the term of fourteen years, with the right of renewal by the author, if living, for another term of fourteen years.

The third section provides the penalty for violating this copyright, viz.: 1st. Forfeiture of every copy of the book, &c., wrongfully printed, to be destroyed, &c.; 2d. "And every such offender and offenders shall also forfeit and pay the sum of fifty cents for every sheet which shall be found in his or their possession, either printed or printing, published, imported, or exposed to sale, contrary to the true intent and meaning of this act."

The court will observe that these provisions of this act were taken from the British statutes then in existence. The same term of duration—fourteen years, with the right of renewal for fourteen years more, if the author were living. The same penalty—forfeiture of books, to be destroyed, and payment of a sum of money for every sheet found in the offender's possession. The difference in this part of the act being, that Congress uses the word "possession" instead of "custody," and fixes the penalty at fifty cents instead of threepence, thus making this act much more severe than the British statutes, as I remarked in a former part of my argument.

Then we come to the act of February 3, 1831, under which this action is brought; for it repeals the previous acts. This act extends the term of copyright to twenty-eight years, with the right of renewal for fourteen years more by the author, if living; and then, after providing the mode of securing the copyright by deposit of title-page, and giving notice by publication, the sixth section provides the penalty, which is, as in the former act, forfeiture of every copy of the book, but not to be destroyed, and "fifty cents for every sheet which may be found in his possession, either printed or printing, published, imported, or exposed to sale, contrary to the intent of this act."

Now, the court will observe that this act of Congress was passed sixteen years after the statute 54 George III, ch. 156. And there can be no doubt that this statute was before the framers of the act of Congress, not only from the general presumption that Congress would be acquainted with an act of Parliament on the same subject passed

sixteen years before, but from their adopting some of its provisions, such as the extended term of twenty-eight years. And yet Congress carefully adheres to the old penalty, limiting it to the sheets found in the offender's possession, although they must have seen the alteration made in the British statute, and known that the effect would be to extend the penalty to all sheets printed or imported. Perhaps Congress thought the penalty of fifty cents a sheet was so large that it ought to be limited to the sheets found in defendant's possession. Perhaps it was intended to excite the diligence of the informer to commence his action as soon as the work was published, and before it passed out of the possession of the publisher; or, more probably, the penalty thus limited was intended to operate as a restraint upon booksellers who might take the work for sale, and who would be subject to the penalty for the sheets found in their possession. But whatever may have been the reason, the words of the act of Congress are distinct and plain.

The legislature has prescribed a certain penalty, to be measured by a standard distinctly given. The British Parliament saw proper to alter and enlarge that penalty for the United Kingdom of Great Britain and Ireland. But the Congress of the United States, when their attention was specially called to the subject, have refused to adopt this alteration. They have adhered to the old penalty, and the courts of the United States will not make the alteration.

If this construction is correct, as I trust the court will agree with us in thinking it to be, it is very evident that the instruction given by the court, and the verdict found by the jury in this case under the direction of the district judge, impose a penalty totally different from that prescribed by the law; for not a single sheet of this work was found to be in the possession of the defendant, and the judgment upon it must therefore be reversed.

*Mr. Wendell.*

It is said that the penalty of fifty cents is limited to the sheets found in the possession of the defendant, though the counsel candidly admitted it to be difficult to discern the reason of that limitation. He, however, suggested that it might have been on account of the enormous penalty which would be imposed in the case of the reprint of a whole volume, and that it might have been to induce the bringing of an action forthwith, before the books had passed into the hands of innocent holders, and thus save them from prosecution. It was also said, that, although in the later acts of the Parliament of England upon the subject of copyright, the words "sheets found in the custody



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of the offender" are omitted, the similar words contained in our original act upon the subject are still continued in the last act of Congress; from which it was inferred, that these words contained some peculiar meaning which, with us, was intended to be preserved. The answers to which suggestions are—1st, that the penalty will be equally enormous, whether the action be brought forthwith, or at the end of a year; 2d, that innocent holders of the pirated work are not exposed, for the penalty reaches only those who knowingly sell; and, 3d, the change of phraseology in the acts of Parliament shows that these words were considered mere matter of form, as "sheets printing and printed," the only state of things to which the words could attach, are retained in the act.

Mr. Justice M'LEAN delivered the opinion of the court.

This cause is brought here by a writ of error to the Circuit Court of the United States for the Northern District of New York.

An action of debt was brought by Gould and Banks to recover certain penalties alleged to have been incurred by the invasion of the copyright of the plaintiffs in twelve volumes of law reports, to wit, nine volumes of Cowen's Reports and three of Wendell's, by the publication of a digest as a supplement or third volume of Johnson's Digest. The defendant pleaded *nil debet*.

On the trial, the plaintiffs proved themselves entitled to the copyright of the first, second, and fifth volumes of Cowen's Reports, and of the second volume of Wendell's Reports; and that, from the above volumes, the defendant had transferred, literally, one hundred and forty-two and a half pages; and they proved a sale by the defendant of five hundred copies of his work.

The injury complained of consisted in copying from the above reports the marginal notes or indexes of the reporter, and publishing them in the digest. From the first volume of Cowen's Reports forty pages were copied; from the second volume, twenty-nine; from the fifth, fifty-four pages; and from the second volume of Wendell's Reports nineteen and a half pages were copied, which included the whole of the indexes of that volume, except eight and a half pages. The change in the phraseology was so great in these pages that the witness did not consider them as having been transferred to the digest.

This is a *qui tam* action, and was brought under the sixth section of the act of 1831, entitled "An act to amend the several acts respecting copyrights."

Before the Circuit Court, many points of law were raised, and instructions prayed, on the facts in evidence; but as the decision will

## Opinion of the court.

turn upon the construction of the above section, under the ninth prayer of the defendant, the other questions will not be considered.

The defendant's counsel insisted "that the plaintiffs could only recover fifty cents for every sheet of the matter transferred from said index to the first, second, and fifth volumes of Cowen's Reports, and the second volume of Wendell's, to the said digest of said defendant, as had been proved to have been found in his possession, either printing or printed, published or exposed for sale; and that there was no legal proof that any such sheets of said matter had been so found in said defendant's possession, and prayed the court so to instruct the jury."

"But the counsel for plaintiffs insisted that they were entitled to recover fifty cents for every sheet of such matter which had been published, or procured to be published, by the defendant, whether the same were proved to have been found in the defendant's possession or not; and so the court decided and instructed the jury." And they found a verdict for plaintiffs for "two thousand sixty-nine dollars and seventy-five cents debt, and six cents costs."

The sixth section provides that if any person, within the term for which a copyright has been secured, shall print, publish, or import, &c., sell, or expose to sale, or cause to be published, sold, or exposed to sale, any copy of such book, without consent in writing, such offender shall forfeit every copy of such book to the person legally entitled to the copyright thereof; "and shall also forfeit and pay fifty cents for every such sheet which may be found in his possession, either printed or printing, published, imported, or exposed to sale, contrary to the intent of this act."

This penalty of fifty cents on each sheet, whether printed or being printed, or published or exposed to sale, is limited to the sheets in possession of the defendant. But, under the instruction of the court, a verdict was rendered for every sheet which the defendant had published, or procured to be published.

As this is a penal section, it must be construed strictly. Under it, every copy of a book published without the consent of the person having the copyright, is forfeited, in addition to the penalty of fifty cents on each sheet in his possession.

The declaration seems not to have been drawn with the view of enforcing any other penalty than that which is imposed for each sheet found in the possession of the defendant.

The judgment of the Circuit Court is reversed, and the cause remanded for further proceedings.

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Statement of the case.

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ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs, and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*. ♦

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JACOB P. WILSON, COMPLAINANT, v. DANIEL BARNUM.

(8 Howard, 258.)

1. The following question, sent up to this court upon a certificate of division in opinion between the judges of the Circuit Court,—viz., “Whether, according to the true construction of the Woodworth patent, as amended, the machines made or used by the defendant at the time of filing the bill, or either of them singly, do or do not infringe the said amended letters patent,”—is a question of fact, over which this court has no jurisdiction.
2. The jurisdiction given to it by statute in certified cases only extend to points of law.

THIS case came up from the Circuit Court of the United States for the Eastern District of Pennsylvania upon a certificate of division in opinion between the judges thereof.

It is not necessary to do more than insert the statement of facts and point of division, as they are found in the record.

*Statement of Facts and Point of Division of Judges.*

UNITED STATES OF AMERICA, *Eastern District of Pennsylvania.*

At a Circuit Court of the United States, begun and held at the city of Philadelphia, for the Eastern District of Pennsylvania, on the 13th day of November, in the year of our Lord 1849—

Present: The Honorable Robert C. Grier and the Honorable John K. Kane.

## JACOB P. WILSON v. DANIEL BARNUM.

*Statement of Facts.*

This was a suit in equity. The bill was filed April 5, 1849, by the plaintiff, as assignee of letters patent issued to William Woodworth. After due notice, a motion was made for a special injunction, which was fully heard before his honor John K. Kane, at a regular Circuit Court, on the 21st, 22d, 23d, 24th, and 25th days of May, A. D. 1849,

his honor Judge Grier being absent. The defendant resisted the motion, and filed affidavits on his part, when, after a full hearing of the parties and arguments of counsel, on the 1st day of June, 1849, a special injunction was granted, a copy of which is annexed to this statement. Afterwards, on the 4th day of June, 1849, the defendant filed an answer, setting up the fact of his having a patent for his machine, and denying all similarity between it and that of the plaintiff; which same defense had been previously set up by the said affidavits, on the hearing of the motion for an injunction. Afterwards, on the 29th day of June, 1849, a motion was made by the defendant to dissolve the injunction, which motion was duly argued on the bill and affidavits on the part of the plaintiff, and on the answer and affidavits on the part of the defendant; and on the 1st day of August, 1849, an order was made in the cause, directing an issue to be tried by a jury, for the purpose of ascertaining whether the machines of the defendant were or were not infringements of the machine of the plaintiff, and ordering the injunction to stand, on the plaintiff giving security to the defendant in the sum of ten thousand dollars, which was done.

The issue came on to be tried by a jury on the 17th day of October, 1849, and after a protracted trial the jury was discharged, not being able to agree.

At this present term of the court, both of the judges being present, a motion was made by the defendant to dissolve the injunction, and arguments of counsel were heard thereon. Thereupon, without any decision being had on said motion, and upon an agreement of the parties, with the consent and by the direction of the court, this cause was brought to a final hearing on the pleadings and the proofs which had been taken herein, as well as on the proofs and evidence which were put in on the trial of the issue before the jury, and which last-named proofs and evidence were, for the purpose of said final hearing, considered as proofs in this cause.

The pleadings were a bill, an answer, and a replication, copies of which are hereunto annexed, and a copy of all the proofs and evidence used on said final hearing is also hereunto annexed.

On said final hearing, it appeared and was determined by the court as matter of fact—

1. That letters patent of the United States were issued to William Woodworth on the 27th day of December, 1828, of the tenor and effect mentioned in the bill.

2. That William Woodworth died intestate on the 9th day of February, 1839, in the city of New York, and that William W. Wood-

## Statement of the case.

worth, his son, and one of his heirs at law, was thereupon duly appointed his administrator by the surrogate of the city and county of New York.

3. That on the 16th day of November, 1842, an extension of the said letters patent for seven years from the 27th day of December, 1842, was duly granted by the United States, under the eighteenth section of the Patent Act of July 4, 1836, to the said William W. Woodworth, as administrator as aforesaid.

4. That by an act of Congress of the United States, passed February 26, 1845, the said letters patent were further extended to the said William W. Woodworth, as administrator as aforesaid, for seven years from the 29th day of December, 1849.

5. That on the 8th day of July, 1845, the said letters patent were surrendered for a defective specification, and renewed letters patent were thereupon issued on the same day, on an amended specification, to the said William W. Woodworth, as administrator as aforesaid, which renewed letters patent were of the tenor and effect set forth in the bill. An authenticated copy of the said renewed letters patent of July 8, 1845, and of the specification and drawings thereto, and an authenticated copy of the said original letters patent of December 27, 1828, and of the specification and drawings thereto, were produced on the hearing, and may be produced on argument before the Supreme Court of the United States.

6. That the exclusive right of the said renewed letters patent of July 8, 1845, for the district of Southwark, in the county of Philadelphia, and Eastern District of Pennsylvania, was vested in the plaintiff.

7. That the defendant had erected, within the said district of Southwark, and used and operated therein, since the said exclusive right became vested in the plaintiff, and before the filing of the bill, a machine for tonguing and grooving boards and plank, and also a machine for planing boards and plank. The machine for tonguing and grooving boards and plank was constructed as stated in the evidence. (A model thereof was produced on the hearing by the plaintiff, and the machine itself was produced on the hearing by the defendant. The same are certified by the clerk of the court, and may be used on argument before the Supreme Court of the United States.) The machine for planing boards and plank was constructed as shown by a model produced on the hearing by the plaintiff, and by the machine itself on the hearing by the defendant. (The same are certified by the clerk of the court, and may be used on argument before [the] Supreme Court of the United States.)

8. That letters patent were issued to the defendant on the 13th day of March, 1849, which are referred to in, and a copy of which is annexed to, his answer herein.

On the final hearing, the following question occurred, to wit:

Whether, according to the true construction of the Woodworth patent, as amended, the machines made or used by the defendant, at the time of filing the bill, or either of them singly, do or do not infringe the said amended letters patent.

On which question the opinions of the judges were opposed.

Whereupon, on a motion by William H. Seward and St. George Tucker Campbell, plaintiff's counsel, it was ordered that the point on which the disagreement hath happened may, during the term, be stated, under the seal of the court, to the Supreme Court, to be finally decided.

R. C. GRIER.  
J. K. KANE.

Mr. Chief Justice TANEY delivered the opinion of the court.

This case comes before the court upon a certificate of division, and has been submitted on printed arguments.

The plaintiff, who claims as assignee of what is generally called the Woodworth patent, filed a bill in equity, praying an injunction against the defendant to restrain him from using a certain machine, in which, as the complainant charged, boards were planed, tongued, and grooved in the same manner as in the Woodworth machine; the machine of the defendant operating in the same way in every respect as the one for which the complainant held the patent.

The defendant, in his answer, denied that his machine was substantially like and upon the plan of the Woodworth machine. Other defenses were also taken in the answer; but it is not necessary to notice them, as they do not concern the question certified.

A great mass of testimony was taken on both sides in the Circuit Court, and models and drawings produced of the two machines, all of which have been sent up for the examination and consideration of this court, with the certificate of division.

On the final hearing of the case, the judges of the Circuit Court differed in opinion on the following question: "Whether, according to the true construction of the Woodworth patent, as amended, the machines made or used by the defendant at the time of filing the bill, or either of them singly, do or do not infringe the said amended letters patent."

The question thus certified is one of fact, and has been discussed

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Order.

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as such in the arguments offered on both sides. It is a question as to the substantial identity of the two machines; and its decision must depend upon the testimony of witnesses, the examination of the models and drawings, or of the machines themselves, and the application of mechanical principles and combinations, which the court could learn only from the testimony of persons skilled in the science of mechanics.

The jurisdiction of this court to hear and determine a question certified from the Circuit Court is derived altogether from the act of 1802, ch. 31, sec. 6, (2 Statutes at Large, 159,) and that act evidently gives the jurisdiction only in cases where the judges of the Circuit Court differ in opinion on a point of law. The language of the whole provision upon this subject so clearly requires this construction, that it is unnecessary to comment on it. And it would be utterly inconsistent with the well known and established proceedings of courts of equity, as well as courts of common law, to take out of a case during its progress a single question of fact, and send it here with the evidence upon that point only, for the final decision of this court. In the case before us, a great number of facts must be ascertained and determined from the evidence, before a final opinion could be formed upon the question certified.

Besides, this act of Congress has been in force for nearly half a century, and has been repeatedly acted on in this court; and it has uniformly received the construction we now give to it. In the multitude of questions which have been certified, this court has never taken jurisdiction of a question of fact; and in a question of law it requires the precise point to be stated, otherwise the case is remanded without an answer.

The question now certified being one of fact, we have no jurisdiction; and the case must therefore be remanded to the Circuit Court, to be there proceeded in as law and justice may require.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Eastern District of Pennsylvania, and on the point or question on which the judges of the said Circuit Court were opposed in opinion, and which was certified to this court for its opinion, agreeably to the act of Congress in such case made and provided, and was argued by counsel. And it appearing to this court, upon an inspection of the said transcript, that no point in the case, within the meaning of the act of Congress, has been certified to this court, the point or question being one of fact, it is thereupon now here ordered and decreed by this

## Statement of the case.

court, that this cause be, and the same is hereby, dismissed, and that this cause be, and the same is hereby, remanded to the said Circuit Court, to be proceeded in according to law.

JAMES G. WILSON, APPELLANT, v. ANDREW P. SIMPSON, E. E. SIMPSON, JOSEPH FORSYTH, AND BAGDAD MILLS.

(9 Howard, 109.)

1. The documents showing the title to Woodworth's planing-machine are set forth *in extenso* in 4 Howard, 647, *et seq.*
2. The assignment from Woodworth and Strong to Toogood, Halstead, and Tyack (4 Howard, 655) declared not to have been fraudulently obtained, according to the evidence in this case.
3. An assignee of Woodworth's planing-machine, having a right, under the decision in 4 Howard, to continue the use of the patented machine, has a right to replace new cutters or knives for those which are worn out.
5. The difference explained between repairing and reconstructing a machine.

THIS was an appeal from the Circuit Court of the United States for Louisiana.

It was a continuation of the case of *Simpson et al v. Wilson*, reported in 4 Howard, 710, where a statement of the case is given, which need not be here repeated. All the documents relating to the patent and transfer of Woodworth's planing-machine are set forth *in extenso* in the case of *Wilson v. Rousseau et al.*, 4 Howard, 647, *et seq.*

The report of the case in 4 Howard shows that the two following questions were certified to this court, viz.:

"1. Whether, by law, the extension and renewal of the said patent granted to William Woodworth, and obtained by William W. Woodworth, his executor, inured to the benefit of the said defendant to the extent that said defendant was interested in said patent before such renewal and extension.

"2. Whether, by law, the assignment of an exclusive right to the defendant, by the original patentee or those claiming under him, to use said machine, and to vend the same to others for use, within the county of Escambia, in the territory of West Florida, did authorize said defendant to vend elsewhere than in said county of Escambia, to wit, in the city of New Orleans, State of Louisiana, plank, boards, and other materials, products of a machine established and used within the said county of Escambia, in the territory of West Florida."

On the 18th of April, 1846, the decisions of the Supreme Court in these questions were certified to the Circuit Court, as follows:



## Argument for the complainant.

"1. That, by law, the extension and renewal of the said patent granted to William Woodworth, and obtained by William W. Woodworth, his executor, did not inure to the benefit of said defendant to the extent that said defendant was interested in said patent before such renewal and extension. But the law secured to persons in the use of machines at the time the extension takes effect the right to continue the use of the same.

"2. That an assignment of an exclusive right to use a machine, and to vend the same to others for use, within the specified territory, does authorize an assignee to vend elsewhere, out of the said territory, plank, boards, and other materials the product of such machine."

Thereupon, leave was granted by the Circuit Court to the defendant Forsyth to amend his plea, and to the complainant to amend his bill.

And thereupon the complainant amended his bill—

1. By charging that the mutual deed between Woodworth and Strong of the one part, and the assignees of Emmons' patent, (before mentioned,) was procured by the latter by fraud upon Woodworth and Strong, not discovered until the extension of the patent.

2. That the defendants had put in operation one new machine since the extension of the patent of 1842 took effect, and that they had rebuilt, by the addition of new parts, being substantial parts of Woodworth's invention, the old machines which they had in actual use at the expiration of the first term of the patent, so that they were practically no longer the same machine; and thus that the use of those machines, under the color of machines which had been in actual use at the expiration of that term, was a fraud upon the law.

Issue was joined upon these new matters. Evidence was taken upon them, as well as upon the question of the extent of infringement.

It is not necessary to insert this evidence, because the substance of it is stated in the opinion of the court.

On the 4th of May, 1849, the cause came on to be heard before the Circuit Court, upon the bill, answers, replication, exhibits, and evidence, when the court decreed that the bill should be dismissed.

The complainant appealed to this court.

The cause was argued by *Mr. Seward* and *Mr. Webster*, for the appellant, and by *Mr. Gilpin* and *Mr. Westcott*, for the appellees.

The counsel for the complainant contended—

1. That the mutual deed executed by and between William Woodworth, James Strong, and William Tyack, D. H. Toogood, Daniel Halstead, and Uri Emmons, was procured from the said Woodworth

## Argument for the complainant.

and Strong by fraud, and is therefore void; and that this fraud vitiates and avoids the defendants' title or right to the use of Woodworth's invention.

2. That the defendants' machines are used in fraud of the law, and in violation of the complainant's rights.

In support of the first proposition, it was urged that Woodworth was the inventor of the machine, which was of great value, and that the consideration which was received by Woodworth and Strong in the mutual deed, viz., that of receiving an assignment of Emmons' rights, was of no value whatever, because Emmons had no rights to convey; and that this was an intentional fraud upon Woodworth and Strong, practiced by Toogood, Halstead, and Tyack. It was also urged, that the fraud thus established vitiated and avoided the claim of the defendants, because the mutual deed secures no part of the franchises of the extended term to assignees of the first term. Whatever they have is derived only from the proviso in the eighteenth section of the act of July 4, 1836. Those claiming the benefit of the extension must be lawfully possessed of the right at the close of the first term. But they acquire that interest only by virtue of a valid assignment. It must be a lawful title, capable of carrying all the incidental advantages, whether conferred by the deed or conferred by law.

Proposition II. The defendants' machines are used in fraud of the law, and in violation of complainant's rights.

The thing patented means the machine, which is a thing that produces, and is not itself a product. It is proved that a set of knives for surface work will do good work for from sixty days to three months. That a Woodworth machine cannot be operated more than three months, without making the service knives, and the cutters for tonguing and grooving, anew.

In the case of *Wilson v. Rousseau and Easton*, 4 Howard, 646, it was held that, under the eighteenth section of the act of 1836, the exclusive right to make, use, and vend the thing patented is vested in the patentee, with a reservation in favor of the assignees or grantees of the right to use the thing patented. That is to say, all assignees or grantees of the right to use the thing patented, who had machines in use at the time of the renewal, are, by this reservation, protected in the continued use of the specific machine or machines, but specially excluded from the right to make.

The reservation is specially limited to the continued use of the thing patented.

Mr. Justice NELSON, in the case referred to, (4 How., 646,) says:

## Argument for the complainant.

"The clause, in terms, seems to limit studiously the benefit or reservation, or whatever it may be called, under or from the new grant, to the naked right to use the thing patented; not an exclusive right even for that, which might denote monopoly, nor any right at all, much less exclusive, to make and vend. That seems to have been guardedly omitted."

There is a broad distinction between the continued use of the invention, and the continued use of the machine patented. The former necessarily carries with it the right to construct, whilst the latter excludes it. This distinction is clearly drawn by Mr. Justice NELSON in the same case. 4 How., 688. He says: "It may be said that the 'thing patented' means the invention or discovery, as held in *Mc Clurg v. Kingsland*, 1 How., 202, and that the right to use the 'thing patented' is what, in terms, is provided for in the clause. That is admitted; but the words, as used in the connection here found, with the right simply to use the thing patented, (not the exclusive right, which would be a monopoly,) necessarily refer to the patented machine, and not to the invention; and, indeed, it is in that sense that the expression is to be understood generally throughout the Patent Law, when taken in connection with the right to use, in contradistinction to the right to make and sell." Again: "The 'thing patented' is the invention; so the machine is the thing patented; and to use the machine is to use the invention, because it is the thing invented, and in respect to which the exclusive right is secured, as is also held in *Mc Clurg v. Kingsland*. The patented machine is frequently used as equivalent for the 'thing patented,' as well as for the invention or discovery, and, no doubt, when found in connection with the exclusive right to make and vend, always means the right of property in the invention—the monopoly. But when in connection with the simple right to use, the exclusive right to make and vend being in another, the right to use the thing patented necessarily results in a right to use the machine, and nothing more." It is therefore unquestionable, under this ruling of the Supreme Court, that the reservation is strictly limited to a right to the continued use of the specific machine or machines legally in use at the time of the renewal.

Let us ascertain with precision what this reservation is. It is not a reservation of the entire right to use the invention, as was ruled in the case of *Mc Clurg v. Kingsland*, for the doctrine on which that case rests was expressly ruled out in the case of *Wilson v. Rousseau and Easton*, and the reservation expressly limited to the continued use of the specific machine or machines in existence at the time of the renewal.

## Argument for the complainant.

It necessarily results, from this ruling, that the reservation applies only to such inventions as are embodied in tangible, material form. Processes which are only directory, and simply teach how a product or result is to be obtained, do not come within the reservation, because these have no visible material existence;—such, for instance, as the process of tanning leather by submitting hides to the chemical action of a solution of such substances as contain the tannin principle; the process of curing India-rubber by mixing it with sulphur, and then subjecting it to the action of artificial heat, by which process this valuable substance is so changed as not be affected by the changes of temperature, and by which it is also rendered insoluble; the various processes of bleaching fibrous and textile substances; the processes of fixing colors on fabrics by the use of what are called mordants, which, by their chemical action on the colors, render them insoluble in water; daguerreotyping, which consists in preparing the surface of a metal plate, with certain chemical agents, to render it so sensitive to the chemical action of light as to receive the impression of the lights and shadows of any object reflected on its surface; and a variety of other processes in the useful and fine arts, too numerous to specify, but which present some of the greatest triumphs which modern inductive science has applied to the wants of man.

All these do not come under the reservation of the eighteenth section of the act of 1836, as expounded in the case of *Wilson v. Rousseau and Easton*, because they have no tangible, material existence. They are simply mental processes, which direct how and what matters to treat to produce the required results, and when the results are produced there is an end of the thing patented. True, the application of the process may require complex and costly apparatus; but unless such apparatus, as is sometimes the case, be not in itself the subject-matter of patent, the reservation does not apply, for the thing patented at the time of the renewal has no material existence. It is the thing patented, when existing in a material form at the time of the new grant, to which the reservation applies alone, and not to the invention irrespective of this material existence.

True, the licensee or grantee of the right to use the invention may have invested thousands of dollars in the erection of costly apparatus by which to apply a patented process, such costly apparatus not being the subject-matter of the patent, and the moment the patent is renewed the costly apparatus becomes useless as regards its use under the license, but nevertheless it is not a waste, for the value of the patent to the patentee arises from the fact that it is vendible, and both

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Argument for the complainant.

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the invention and the apparatus used in the application of it, being vendible things, can become the subjects of barter and sale.

We have thus shown that the reservation applies only to one class of inventions, namely, such as require the investment of capital in the thing patented; for there is a broad distinction between the investment of capital in the thing patented, and in apparatus and appliances for the application of the thing patented. For instance, the reservation does not apply nor look to the capital invested in workshops, warehouses, and the preparation of operatives to conduct a patented process. A licensee under the patent for casting iron rolls, which was the thing patented in the case of *Mc Clurg v. Kingsland*, may have expended thousands of dollars in the erection of workshops, in flasks and other moulds for casting chilled rolls under that patent, and in the preparation of operatives for carrying into effect the thing patented, but the moment the first term of the patent expires, and it is renewed, he cannot claim the right to the continued use of the invention under the renewed term, because the thing patented perishes or is destroyed by the act of a single use. It consists in so moulding the sand in which the roll is to be cast, as to make the channel through which the molten iron is to be poured into the moulds a tangent to the circle, that, in running in, it may take a whirling or circular motion, and thus, by the law of centrifugal force, throw the heavier or denser particles of iron outward, to form the outer surface of the roll or cylinder, the dross and less pure particles going towards the center. In this case, the thing patented has no material existence beyond the single use. The moment the effect is produced, the thing patented is at an end; for the mould, being made of sand, is destroyed by the very act of producing the effect, and must be made over again for another application of the thing patented.

We shall allude again to this particular case in an after-part of the argument.

As the reservation applies only to things patented which have a material, tangible existence, the question arises, in such cases, how long does this reserved right to use continue, or when does it expire? If it was a reservation to the right of the invention, as contended for by those who cited the case of *Mc Clurg v. Kingsland* in the argument in the case of *Wilson v. Rousseau and Easton*, most unquestionably it would be without limit; but that was overruled by the Supreme Court, because of the broad distinction between the right to the invention, and the right to the continued use of the material machine patented, as we have already shown. Now, then, when does this reserved right to the continued use of the material machine patented cease?

## Argument for the complainant.

If it was coupled with the right to make, still it would be without limit. But as it was expressly ruled that the right to make is an exclusive right vested in the patentee, as a necessary consequence the reservation must expire with the existence of the material thing patented; the one, being an entire dependent of the other, must of necessity expire with it, as the branch dies with the trunk.

When the thing patented no longer has material existence, there is no longer any reserved right. This brings us to the inquiry, when does the material thing patented cease to exist? The answer to this inquiry must clearly be, and can only be, when it is worn out or destroyed. For when, by any event, the material thing patented no longer exists, it can only be renewed under the authority of the exclusive right to make the thing patented, and therefore the reserved right expires the moment that the material thing patented is worn out or destroyed. This is manifest, and there is no flying from the conclusion.

This brings us to the final and most important branch of the argument. When does the material thing patented cease to exist? To ascertain this, we must first determine what is the thing patented; for we must first know that a thing was, before we can know that it is no more. That the thing patented is the thing invented, we have before shown to be the doctrine of the court in *Wilson v. Rousseau and Easton*.

Woodworth did not invent the frame, the cog-wheels, and shafts, and other elementary parts, which, when put together, constitute what is known as the Woodworth planing-machine. These are the mere appliances,—the mere elements of machinery,—which are as free for every man to use as the air he breathes. Nor did he invent the rollers for making pressure to control the plank, nor the cutting instruments for planing, nor the cutter-beads or stocks to which the cutters are attached. These, too, are public property, and at every man's command, to be freely made and used. As he did not invent any of these, and does not claim them in the letters patent as the thing patented, so the making of them does not come within the exclusive right to make, vested in the administrator by the renewal of the patent; nor does the use of them require the reservation of the statute. What, then, is the thing patented? Why, simply the combination of the cutting instruments or planes with the pressure-roller, or an analogous device. The combining or putting these together, to effect the planing of planks, is the thing patented, because it is the thing invented; and in this sense the thing invented is the thing patented. As the making these things separately is not making the thing pat-

## Argument for the complainant.

ented, the act of combining or putting them together, so that they shall be able to effect the planing of planks, is alone the making of the thing patented, the doing which is the exclusive privilege of the patentee.

If, then, as must be obvious, the putting or combining of these elements together in one machine is the making of the thing patented, then the converse of the proposition must also be true, namely, that the moment this combination ceases to exist, so soon the thing patented is extinct, and can only be renewed by the exercise of the right to make. We do not press this to the technical length of asserting that the simple act of disconnecting these elementary parts, such, for instance, as temporarily taking the roller or the cutting instruments out of the machine, destroys the thing patented, for that is merely a temporary act, with the intention to restore. But when any one of these elements is either worn out by use, or otherwise destroyed, then the combination invented—the thing patented—no longer exists, and cannot be restored without the exercise of the right to make. The capital which has been invested—not in the appliances to, but in the thing patented—has performed its office; it has lasted its days and vanished, and with it the reserved right which belonged to it alone. But, it may be said, it is a hardship for the man who invested his capital in the purchase of an entire machine, that he should be deprived of the use of it because one part only has worn out. The question of individual hardship cannot control the settlement of great legal questions. In the language of Mr. Justice NELSON in *Wilson v. Rousseau and Easton*, “We must remember that we are not dealing with the decision of the particular case before us, though that is involved in the inquiry, but with a general system of great practical interest to the country; and it is the effect of our decision upon the operation of the system that gives to it its chief importance.” If the question of pecuniary hardship could have a legitimate influence, it would not be difficult to demonstrate how much greater the hardship is to the patentee, by reason of the reservation under the most limited construction, than on the part of the grantee, by reason of the loss of the remnant of the machine, after the thing patented is worn out. But what becomes of the question of hardship in other cases, where the thing patented has no material existence, as in the case of a chemical process requiring costly apparatus for the application of the process, which is the thing patented?

Let us take, for illustration, the patent granted to Charles Good-year, for curing, or, as it is termed, vulcanizing India-rubber by mixing it with sulphur, and then baking it by exposure to heat. The

## Argument for the defendants.

thing patented in this instance is a process, an immaterial thing which has no visible existence. It is simply a rule of procedure. But this rule of procedure can only be applied to produce the desired effect by means of costly machinery for grinding and mixing the India-rubber and sulphur, and moulds and ovens, or boilers, for baking. Many manufacturers have been licensed to work under this patent. By reason of great poverty, occasioned by many years of fruitless experiments in search of this great discovery, he was compelled to grant licenses far below their actual value. Should he obtain a renewal of this patent, as the thing patented is not a machine, and has no material existence, the licensees or grantees will not come under the reservation,—will not the pecuniary loss to them be greater than any that can be sustained by the grantees under the Woodworth patent? Most assuredly it will; and yet for these there will be no remedy. They, however, as the grantees under the Woodworth patent, have received more than their reward; and so it will always be in similar cases, because none but valuable inventions can be renewed, and when the inventions have been of sufficient value to authorize the renewal, those who have used them have been remunerated.

But, as we before submitted, the hardship to the licensee or grantee is not a matter that can affect the judicial construction. The inquiry must look to the naked fact, when the material machine or thing patented ceases to exist.

(The counsel then proceeded to illustrate the above principles by other examples.)

The counsel for the defendants made the following points.

I. The Circuit Court, as a court of equity, had no jurisdiction under the acts of Congress, the parties not being citizens of Louisiana, the subject of controversy not arising there, the equitable relief not being applicable there, and the right of the complainant not having been established at law. Act of 1789, sec. 11, 1 Stat. at Large, 78; act of 1793, sec. 5, 1 Stat. at Large, 322; act of 1800, sec. 3, 2 Stat. at Large, 37; act of 1819, sec. 1, 3 Stat. at Large, 481; act of 1836, sec. 17, 5 Stat. at Large, 124; act of 1839, sec. 11, 5 Stat. at Large, 354.

II. If the Circuit Court possesses the fullest equitable jurisdiction, still the complainant cannot, on the general and well-settled principles which govern the interposition of a court of equity, obtain redress by such a bill; nor is he entitled to such relief as he asks.

He must establish at law the infringement of his right to the "thing patented," the illegal use thereof by the defendants, and the damages



## Argument for the defendants.

he has sustained thereby. His right in equity is merely to restrain the continued illegal use of the thing patented, when so established.

By what principle or rule, governing a court of equity, can he ask it, in an action such as this, and between these parties, to declare an agreement between other parties, and all rights under it, void?

What part of the Patent Law entitles the complainant to an account?

How are damages for the infringement to be obtained by proceedings in equity? Act of 1836, 5 Stat. at Large, 117, 123; 2 Story's Eq., sec. 794 *et seq.*, sec. 934; Dwarrris on Statutes, 744; Curtis on Patents, 358, 370, 375, 381, and cases cited; Phillips on Patents, 452; *Whittemore v. Cutter*, 1 Gallison, 429; *Miller v. Taylor*, 4 Burr., 2400; *Hill v. Thompson*, 3 Meriv., 622; *Bailey v. Taylor*, 1 Russ. & Mylne, 74; 3 Mylne & Craig, 735; 4 Mylne & Craig, 435, 487; 1 Woodb. & Min., 220, 280, 290, 376, 435; 2 Woodb. & Min., 28.

III. The complainant has no title on which he can found an action against the defendants. They claim no interest adverse to his. He holds the exclusive right to make, use, and vend the machines in Escambia county, Florida, under the new or extended grant. These machines are not made or used in contravention of that grant; they are no infringement of "the thing patented" to him; the defendants have not made, used, or sold the thing patented to him. The act of 1836, sec. 14, (5 Stat. at Large, 123,) establishes his right to use, and cannot be construed to embrace a machine, lawfully made, before his grant accrued. *Wilson v. Rousseau*, 4 How., 681, 682, 684; Jacob's Law Dict., *Quitclaim, Assignment*.

IV. Nor is the machine used by the defendants proved to be identical with that to which the complainant claims the exclusive right.

They held under the patent of Emmons as much as that of Woodworth; both patents were identical in many respects; the testimony is entirely imperfect and insufficient, so far as it describes the exact character or construction of the machines used by the defendants.

Woodworth purchased the right to use Emmons' patent during the existence of his first grant, and held this right when the defendants took their assignment. There is no proof, in this action, to show how far the defendants' machines, though called "Woodworth's," were made under one right or the other. The only "Woodworth machine" traced to the possession of the defendants never was used by them.

V. The right of defendants to use Woodworth's planing-machine (whether constructed under Woodworth's patent exclusively, or under that and Emmons' combined) in Escambia county, Florida, was com-

pletely vested on the 1st of June, 1836. The assignments were according to law. Act of 1793, sec. 4, 1 Stat. at Large, 322.

The claim of title, as set out in the record, is complete. The agreement of 28th November, 1829, is founded on a full and legal consideration. The attempt to establish its invalidity on the ground of fraud is totally unsustained by any evidence, and at variance with the whole conduct of Woodworth and the character of his proceedings. The assignments subsequent to the agreements are in due form; they were all duly recorded, though this was not required by any act in existence at the time when the title of Forsyth was complete.

But it is altogether immaterial in this suit whether this be so or not. The complainant (Wilson) cannot avail himself of it. The machine is no infringement of his right. It was erected and used under Woodworth's right; it was in being when that terminated. If illegally used, it was and is an infringement of that right,—not of the complainant's; and to Woodworth and his representatives alone belongs the claim for redress.

VI. After the decision of this court, (*Simpson v. Wilson*, 4 How., 711,) it is needless to answer the allegations of the bill which charge the act of vending the products of the machine elsewhere than in Escambia county as an infringement. That decision has conclusively affirmed his right to do so.

VII. The right of the defendants, as established by the act of 1836, and confirmed by the Supreme Court, is the right to "continue to use" the "thing patented" to the extent of their interest therein. This is all they have done. They have not exercised, during the renewed term, any other right derived under the assignment; they have not made or vended any machine; they have merely continued to use that which they had in use when the original term expired.

The attempt to sustain the allegations of the bill which charge the defendants with fitting up new machines since the 27th of December, 1842, or so reconstructing the old ones, since that time, as to make them essentially new ones, has totally failed. The evidence produced by the complainant negatives the allegations on both points. In allowing the continued use of the machines in existence on the 27th of December, 1842, this court evidently contemplated such repairs as were required to preserve them. *Wilson v. Rousseau*, 4 How., 707; *Woodworth v. Curtis*, 2 Woodb. & Minot, 528; *Boyd v. Brown*, 3 McLean, 295; *Boyd v. McAlpin*, 3 McLean, 427.

Mr. Justice WAYNE delivered the opinion of the court.

In the argument of this case, the counsel for the appellant put his

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Opinion of the court.

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right to the relief sought by his bill upon two points. We will consider them in the order in which they were presented.

The appellant's first point is, that the title and right of the defendants to use the Woodworth invention are taken from them by the fraud and artifice of Emmons, Tyack, Toogood, and Halstead, in procuring from Woodworth and Strong the deed of the 28th of December, 1829. Record, 51, 52.

The fraud alleged in the bill is, that Emmons, having pirated Woodworth's invention, contrived, by misrepresentation, to get a patent for the same, and, in conjunction with Toogood, Halstead, and Tyack, falsely and fraudulently represented to Woodworth, and to Strong, his assignee, that Emmons was the first inventor of the planing-machine for which Woodworth had received the first patent; and that Woodworth and Strong, regarding it possible that such might be the fact, not suspecting any fraudulent device, and fearing, notwithstanding Woodworth knew the invention to be his own, it might be established against him, executed the agreement of the 28th of November, 1829, for which no other consideration was received than Emmons' pirated patent.

The case is before us upon the original bill, and as it was afterwards amended, upon answers and replication. The defendants traverse this allegation of fraud, as fully as persons so situated can do, and deny any notice or knowledge about it, when they became the assignees of the invention for a valuable consideration. The complainant, then, must establish his charge by proofs. We think it has not been done.

The proof relied upon is, that, though Emmons received a patent for what he claimed to be his invention, it was subsequently proved to be identical with the principle of Woodworth's machine, and had been pirated from it. That, at the time Emmons applied for a patent, he had not, in any way, carried his machine into such a practical result, either in a model or execution, as to entitle him to letters patent. To this is added the declaration of two witnesses, Harris and Gibson, in a joint deposition,—(one of them we may suppose interested, from not having disavowed it, as his associate Gibson does.)—"that they called upon Emmons in the city of New York, several years since, and shortly previous to his death, for the purpose of obtaining information in relation to an invention of a planing-machine said to have been invented by him while residing at Syracuse. That he then informed them, that in the year 1824, being engaged in the erection of salt-vats at Syracuse, he had contrived a machine by which the plank used for salt-vats could be joined by means of knives upon a

## Opinion of the court.

revolving cylinder. That he went so far as to satisfy himself that boards and plank might be joined in that way; but the machine was never so far completed as to perform work with it. That he left Syracuse in July, 1824, and thought no more of the subject until after William Woodworth had obtained his patent, when he was employed by Toogood, Tyack, and Halstead to defeat it."

Such is the testimony in this record, in support of the charge that the mutual deed of the 28th of November, 1829, was obtained by fraud. It is under that deed that the defendants claim the right to use the Woodworth machines in their possession.

Apart from the insufficiency of such testimony, in combination or separately, to establish the fraud, if we suppose it had been sworn to by Emmons, it would be only hearsay, and not within any exception to the rule rejecting hearsay testimony. It is not so, on account of its being a dying declaration, or one made by Emmons at variance with his interest. Neither can it be brought under the exception, as an admission by one who is a party to a suit with others identified in interest with him; nor as coming from one having any interest in the suit, without being a party to the record with others who are so. And it is not the admission of one interested in the subject-matter of the suit, where the law, in regard to that source of evidence, looks chiefly to the parties in interest, and gives to their admissions the same weight as though they were parties to the record.

In fact, the declaration said to have been made by Emmons is merely hearsay. It cannot be made evidence for any purpose, of itself, or in connection with any other proof in the case not liable to any objection. It can neither aid nor be aided by other evidence.

We have put its exclusion on the ground stated, on account of the relations which the record shows Emmons had with some of the parties, rather than upon the little credit to which such a declaration from him would be entitled, from the difference and opposition between it and such as Emmons must have made when he applied for and obtained letters patent for what he claimed to be his invention.

Let us suppose, however, Emmons to be a competent witness to avoid an instrument obtained by the fraudulent devices of himself and his associates; and that there were independent corroborating proofs in confirmation of his credit in such a case. Still the declaration imputed to him would not, in any way, have disparaged the right or title of the assignees, under the deed of the 28th of December, 1829, their right having been acquired without notice of the fraud which the complainant says was practiced upon Woodworth and Strong.

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The complainant can have no benefit under the first point urged by his counsel.

The second point upon which the counsel rely is, that the defendants, as assignees under the deed, continue to use their machines, in fraud of the law, and in violation of the rights of the complainant. The specifications under the general proposition are, that the defendants have substituted other machines for those used by them, before the expiration of the first term of Woodworth's patent; that they have reconstructed Woodworth's entire combination in the frames of their old machines, or supplied an essential constituent part of it, to continue in use those machines which this court said they had a right to use as assignees, when this case was before it, upon certified points, in the year 1846. 4 How., 709, 711.

There is no proof of either the first or second specification.

But the questions which were argued by counsel,—when repairs destroy identity and encroach upon invention, or when the thing patented ceases to exist, so as to exclude the repair or replacement of any one part of its combination, in connection with the rest of it, not requiring repair, or to be replaced,—are before the court upon the evidence in the record.

We admit, for such is the rule in *Wilson v. Rousseau*, 4 Howard, that when the material of the combination ceases to exist, in whatever way that may occur, the right to renew it depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild the combination.

But it does not follow, when one of the elements of the combination has become so much worn as to be inoperative, or has been broken, that the machine no longer exists, for restoration to its original use, by the owner who has bought its use. When the wearing or injury is partial, then repair is restoration, and not reconstruction.

Illustrations of this will occur to any one, from the frequent repairs of many machines for agricultural purposes. Also from the repair and replacement of broken or worn-out parts of larger and more complex combinations for manufactures.

In either case, repairing partial injuries, whether they occur from accident or from wear and tear, is only refitting a machine for use; and it is no more than that, though it shall be a replacement of an essential part of a combination. It is the use of the whole of that which a purchaser buys, when the patentee sells to him a machine; and when he repairs the damages which may be done to it, it is no more than the exercise of that right of care which every one may

## Opinion of the court.

use to give duration to that which he owns, or has a right to use as a whole.

This foundation of the right to repair and replace, and its application to the point we are considering, will be found in the answers which every one will give to two inquiries.

The right to repair and replace in such a case is either in the patentee, or in him who has bought the machine. Has the patentee a more equitable right to force the disuse of the machine entirely, on account of the inoperativeness of a part of it, than the purchaser has to repair, who has, in the whole of it, a right of use? And what harm is done to the patentee in the use of his right of invention, when the repair and replacement of a partial injury are confined to the machine which the purchaser has bought?

Nothing is gained against our conclusion by its being said that the combination is the thing patented, and that when its intended result cannot be produced from the deficiency of a part of it, the invention in the particular machine is extinct. It is not so. Consisting of parts, its action is only suspended by the want of one of them, and its restoration reproduces the same result only, without the machine having been made anew. Of course, when we speak of the right to restore a part of a deficient combination, we mean the part of one entirely original, and not of any other patented thing which has been introduced into it, to aid its intended performance.

Nor is it meant that the right to replace extends to everything that may be patented. Between repairing and replacing there is a difference.

Form may be given to a piece of any material,—wood, metal, or glass,—so as to produce an original result, or to aid the efficiency of one already known; and that would be the subject for a patent. It would be the right of a purchaser to repair such a thing as that, so as to give to it what was its first shape, if it had been turned from it, or by filing, grinding, or cutting, to keep it up to the performance of its original use. But if, as a whole, it should happen to be broken, so that its parts could not be readjusted, or so much worn out as to be useless, then a purchaser cannot make or replace it by another, but he must buy a new one. The doing of either would be entire reconstruction.

If, however, this same thing is a part of an original combination, essential to its use, then the right to repair and replace recurs. That this is so, may be more satisfactorily shown by the Woodworth planing-machine than any other we know, and particularly by the complaint here made against these defendants.

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Woodworth's greatest merit, showing his inventive genius, is the adaptation of a well-known tool to a new form and mechanical action, giving an almost wonderful efficiency to its use, and which, in the hundred efforts which had been made before, had not been accomplished. We mean its cutters for planing, tonguing, and grooving.

The complaint now is, that the defendants, in the use of their old machines, have replaced new cutters for those which were worn out, in fraud of the ruling of this court in its answer to the first point certified when this case was formerly here. *Simpson et al. v. Wilson*, 4 How., 709.

This court then said, that the renewal of the patent granted to William Woodworth, to William W. Woodworth, his executor, did not inure to the benefit of the defendants to the extent they were interested in it before the renewal and extension, but that the law saved to persons in the use of the machines at the time the extension took effect the right to continue the use. *Simpson et al v. Wilson*, 4 How., 711.

Wilson and Rousseau's case, in 4 Howard, was very fully considered by this court. There were differences of opinion between the judges, as to the interest which assignees of an invention had in it, under the eighteenth section of the act of 1836, after the expiration of the first term of a patent, when there had been a renewal and extension of it. But it certainly did not occur to either of us, that the language then used by the court, and afterwards in *Simpson et al v. Wilson*, could make any difficulty in its application, or that it was subject to misapprehension.

It does not permit an assignee of the first term of a patent, after its renewal and extension, to make other machines, or to reconstruct it, in gross, upon the frames of machines which the assignee had in use when the renewal and extension of the patent took effect. But it does comprehend and permit the resupply of the effective ultimate tool of the invention, which is liable to be often worn out or to become inoperative for its intended effect, which the inventor contemplated would have to be frequently replaced anew, during the time that the machine, as a whole, might last.

The proof in the case is, that one of Woodworth's machines, properly made, will last in use for several years, but that its cutting-knives will wear out and must be replaced at least every sixty or ninety days.

The right to replace them was a part of the invention transferred to the assignee for the time that he bought it, without which his purchase would have been useless to him, except for sixty or ninety days after a machine had been put in use. It has not been contended, nor

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can it be, that such can be a limitation of the assignee's right in the use of the invention.

If, then, the use of the machine depends upon the replacement of the knives, and the assignee could replace them from time to time, as they were needed, during the first term of the patent, though they are an essential and distinct constituent of the principle or combination of the invention, frequently replacing them, according to the intention of the inventor, is not a reconstruction of the invention, but the use only of so much of it as is absolutely necessary to identify the machine with what it was in the beginning of its use, or before that part of it had been worn out.

The right of the assignee to replace the cutter-knives is not because they are of perishable materials, but because the inventor of the machine has so arranged them as a part of its combination, that the machine could not be continued in use without a succession of knives at short intervals. Unless they were replaced, the invention would have been of but little use to the inventor or to others. The other constituent parts of this invention, though liable to be worn out, are not made with reference to any use of them which will require them to be replaced. These, without having a definite duration, are contemplated by the inventor to last so long as the materials of which they are formed can hold together in use in such a combination. No replacement of them at intermediate intervals is meant or is necessary. They may be repaired as the use may require. With such intentions, they are put into the structure. So it is understood by a purchaser, and beyond the duration of them a purchaser of the machine has not a longer use. But if another constituent part of the combination is meant to be only temporary in the use of the whole, and to be frequently replaced, because it will not last as long as the other parts of the combination, its inventor cannot complain, if he sells the use of his machine, that the purchaser uses it in the way the inventor meant it to be used, and in the only way in which the machine can be used.

Such a replacement of temporary parts does not alter the identity of the machine, but preserves it, though there may not be in it every part of its original material.

Such being the case, and this court having determined that the statute providing for the extension and renewal of patents saves the rights of assignees in the use of the machines which they may have in operation when the extension takes effect, we do not think that the defendants in this case, from having replaced cutter-knives in their machines, have been using them in fraud of the law, or in violation of the rights of the complainant.



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We shall, therefore, direct the decree of the court below, dismissing the complainant's bill, to be affirmed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Louisiana, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

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JAMES G. WILSON, APPELLANT, v. GEORGE A. SANDFORD AND ROBERT G. MUSGROVE.

(10 Howard, 99.)

1. The seventeenth section of the act of 1836 gives the right of appeal to this court, when the sum in dispute is below the value of two thousand dollars, "in all actions, suits, controversies on cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries," provided the court below shall deem it reasonable to allow the appeal.
2. But a bill filed on the equity side of the Circuit Court to set aside an assignment upon the ground that the assignee had not complied with the terms of the contract, is not one of these enumerated cases; and the value in dispute being less than two thousand dollars, this court has no jurisdiction over the case.

THIS was an appeal from the Circuit Court of the United States for the District of Louisiana.

The appellant had filed his bill in the court below, setting forth a patent to William Woodworth, dated December 27th, 1828, for a planing-machine; also an extension, in 1842, of said patent for seven years, granted to William W. Woodworth, administrator of the patentee; an assignment of all right and interest in said extended patent throughout the United States (except Vermont) to complainant, Wilson; and a license from Wilson to the defendants to use one machine, upon payment of \$1,400, as follows, viz.: \$250 in cash, and the remainder in nine, twelve, eighteen, and twenty-four months, for which promissory notes were given, dated 23d April, 1845, one for \$150, and four for \$250 each.

The license was made an exhibit in the case, which, after setting forth the consideration of \$1,400, above mentioned, and the promissory notes for part thereof, contained the following provision: "And

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if said notes, or either of them, be not punctually paid upon the maturity thereof, then all and singular the rights hereby granted are to revert to the said Wilson, who shall be reinvested in the same manner as if this license had not been made."

The first two of said notes were not paid when they fell due, payment having been demanded and refused before the filing of the bill. The bill further insisted, that the license was forfeited by the failure to pay the notes, and that the licensor was fully reinvested at law and in equity with all his original rights. That the defendants, nevertheless, were using the machine, and thus were infringing the patent. Prayer for an injunction *pendente lite*, for an account of profits since the forfeiture of the license, for a perpetual injunction, for a re-investiture of title in complainant, and for other and further relief.

The defendants demurred to the whole bill, and also (saving their demurrer) answered the whole bill. They admitted all the facts alleged; and averred, on their part, that the contract set forth in the bill had been modified and varied by a new contract, which the complainant had broken, and that the respondent, being in the lawful use of a planing-machine at the expiration of the patent, had the right to use such machine without license, and consequently that the notes were without consideration.

There was a general replication, and the cause was heard first on bill and demurrer, and afterwards (the demurrer having been overruled) on bill, answer, and replication. Whereupon the bill was dismissed, with costs, and an appeal to this court taken.

The cause was argued by *Mr. Seward*, for the appellant, no counsel appearing for the appellees. As, however, the appeal was dismissed for want of jurisdiction, the argument of *Mr. Seward*, which was wholly upon the merits, is not inserted.

Mr. Chief Justice TANEY delivered the opinion of the court.

The bill in this case was filed by the appellant against the appellees in the Circuit Court of the United States for the District of Louisiana.

The object of the bill was to set aside a contract made by the appellant with the appellees, by which he had granted them permission to use, or vend to others to be used, one of Woodworth's planing-machines, in the cities of New Orleans and Lafayette; and also to obtain an injunction against the further use of the machine, upon the ground that it was an infringement of his patent-rights. The appellant states that he was the assignee of the monopoly in that district of country, and that the contract which he had made with the appel-

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lees had been forfeited by their refusal to comply with its conditions. The license in question was sold for fourteen hundred dollars, a part of which, the bill admits, had been paid. The contract is exhibited with the bill, but it is not necessary, in this opinion, to set out more particularly its provisions.

The appellees demurred to the bill, and at the final hearing the demurrer was sustained, and the bill dismissed. And the case is brought here by an appeal from that decree.

The matter in controversy between the parties arises upon this contract, and it does not appear that the sum in dispute exceeds two thousand dollars. On the contrary, the bill and contract exhibited with it show that it is below that sum. An appeal, therefore, cannot be taken from the decree of the Circuit Court, unless it is authorized by the last clause in the seventeenth section of the act of 1836.

The section referred to, after giving the right to a writ of error or appeal in cases arising under that law, in the same manner and under the same circumstances as provided by law in other cases, adds the following provision: "And in all other cases in which the court shall deem it reasonable to allow the same." The words "in all other cases" evidently refer to the description of cases provided for in that section, and where the matter in dispute is below two thousand dollars. In such suits, no appeal could be allowed but for this provision.

The cases specified in the section in question are, "all actions, suits, controversies on cases arising under any law of the United States, granting or confirming to inventors the exclusive right to their inventions or discoveries." The right of appeal to this court is confined to cases of this description, when the sum in dispute is below two thousand dollars. And the peculiar privilege given to this class of cases was intended to secure uniformity of decision in the construction of the act of Congress in relation to patents.

Now, the dispute in this case does not arise under any act of Congress; nor does the decision depend upon the construction of any law in relation to patents. It arises out of the contract stated in the bill; and there is no act of Congress providing for or regulating contracts of this kind. The rights of the parties depend altogether upon common-law and equity principles. The object of the bill is to have this contract set aside and declared to be forfeited; and the prayer is, "that the appellant's reinvestiture of title to the license granted to the appellees, by reason of the forfeiture of the contract, may be sanctioned by the court," and for an injunction. But the injunction he asks for is to be the consequence of the decree of the court sanctioning the forfeiture. He alleges no ground for an injunction unless

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the contract is set aside. And if the case made in the bill was a fit one for relief in equity, it is very clear that whether the contract ought to be declared forfeited or not, in a court of chancery, depended altogether upon the rules and principles of equity, and in no degree whatever upon any act of Congress concerning patent-rights. And whenever a contract is made in relation to them, which is not provided for and regulated by Congress, the parties, if any dispute arises, stand upon the same ground with other litigants as to the right of appeal; and the decree of the Circuit Court cannot be revised here, unless the matter in dispute exceeds two thousand dollars.

This appeal, therefore, must be dismissed for want of jurisdiction.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Louisiana, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that this cause be, and the same is hereby,

DISMISSED FOR WANT OF JURISDICTION.

JAMES STIMPSON, PLAINTIFF IN ERROR, v. THE BALTIMORE AND SUSQUEHANNA RAILROAD COMPANY.

(10 Howard, 329.)

1. Stimpson's patent "for an improvement for the purpose of carrying railroads through the streets of towns, or in other situations where it may be desirable that the wheels of ordinary carriages should not be subjected to injury or obstruction," decided to be a combination or application of means already known and in use, and not to be original as to the invention or discovery of those means.
2. That the mode given by him for the application of those means, and the objects proposed thereby, differ materially from the apparatus used by the Baltimore and Susquehanna Railroad Company for turning the corners of streets. The latter, therefore, no infringement of Stimpson's patent.
3. The practice of bringing cases up to this court upon an agreed state of facts has been sanctioned, and is now pronounced to be correct.

ERROR to the Circuit Court of the United States for the District of Maryland.

The plaintiff in error brought an action in the court below, for an alleged infringement of his patent-right by the defendant in error.

The cause was not tried by a jury, but was submitted to the court upon the statement of facts hereinafter inserted. Judgment for the defendant, upon which the plaintiff sued out this writ of error.

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*Statement of Facts.*

It is agreed that the privilege of the invention set forth or referred to in the declaration was intended to be secured to the plaintiff by letters patent, dated the 23d August, 1831; that said patent, for defectiveness of specification, was surrendered, and another instead thereof issued on the 26th September, 1835; and that this last was, for like reason, surrendered, and another issued in place of it, bearing date the 27th day of August, A. D. 1840; and that said patent-right was duly extended for the term of seven years from the 23d day of August, A. D. 1845, the period of the expiration of the term of said original letters patent. The invention is described in the specification in the words following, to wit:

*Specification.*

“The schedule referred to in these letters patent, and making part of the same.

“To all whom it may concern: Be it known, that I, James Stimpson, of the city of Baltimore, in the State of Maryland, have invented a new and useful improvement in the mode of forming and using cast or wrought iron plates or rails for railroad carriage-wheels to run upon, more especially for those to be used on the streets of cities, on wharves, and elsewhere; and I do hereby declare that the following is a full and exact description of my said inventions or improvements:

“For the purpose of carrying railroads through the streets of towns or cities, and in other situations where circumstances may render it desirable that the wheels of ordinary carriages should not be subjected to injury or obstruction, I so construct or form the rails, that the flanches of the wheels of railroad cars or carriages may be received and run within narrow grooves or channels, formed in or by said rails, said grooves not being sufficiently wide to admit the rims of the wheels of gigs or other ordinary carriages having wheels of the narrowest kind. These plates or rails may be varied in form, according to circumstances.

In the accompanying drawing, figure 1 represents a railroad track, supposed to be formed in a street, a part of it being shown as straight and a part as curved. The other figures give sectional views of various forms in which I make my railway bars or plates, which are usually of cast-iron, and are laid down and secured upon rails of wood. Figure 2 is a section of the form of cast-iron rail plate which I most commonly use where the track is slightly curved; and figure 3, a plate nearly the same with figure 2, which I use where the track

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is nearly or quite straight. In these plates I make a groove or channel, as at *a*, which is to receive the flanch of the wheel. This channel should be about an inch and a half wide at the top, and about an inch and a quarter at bottom; it is sufficiently deep to admit the flanch of the wheel to run in it without touching its bottom. The lower corners of the interior of this channel I make rounding or curved, in order that any dirt or other foreign matter collected therein may be the more readily forced out by the action of the flanches. The cheek or jam, which is on the inside of the channel, should be about three-fourths of an inch wider at top, and as high, or nearly so, as the face *c* of the plate upon which the tread of the wheel is to run. These plates I cast hollow at *d*, to save weight. They should be about two inches and a quarter deep, six inches and a half wide at the bottom, and about six inches and a quarter at the top; the taper at their sides, when thus formed, aiding in confining them in place by the wedging of the stones and earth of the pavement against them; they may be cast three or four feet in length; their ends should be bevelled, say at an angle of forty-five degrees; or they may be formed with a tenon and mortise. They have spike-holes through them, in order to fasten them down to the rails of wood or of stone upon which they are placed.

"Figure 3 is the same with figure 2, excepting that it has a slight chamfer or rounding off of the angle of the face, as shown at *e*, to admit the cone or curve on the tread of the wheel where it joins the flanch to run free, so that the general tread of the wheel may bear on the face *c* of the plate, which face I prefer to make a little crowning.

"Where the road is perfectly straight, as at *A*, on the track, this chamfered edge plate is to be preferred; but where it is slightly curved, as at *B*, on the track, I use on the outside of the curve the rails shown in figure 2, which are not chamfered, as the conical or larger part of the tread of the wheel close to the flanch will then bear upon the edge *e*, and this being larger than the tread, will cause the wheels to roll around such curved parts of the road with little or no slipping.

"Where it is necessary to turn a curve of shorter radius than that which could be readily effected by the aid of the conical part of the wheel, as at *C*, on the track, I then resort to the plan, secured to me by letters patent, for 'turning short curves on railroads,' which letters patent bear the same date, having been granted on the same day with the letters patent of which this instrument makes a part, for railroad plates to be used on the streets of cities, &c.; that is to say,

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I apply 'the flanches of the wheels on one side of the railroad carriages, and the tread of the wheels on the other side, to turn curves on railways.' In this case, a railroad plate may be made, like that shown in figure 4, to form the channel for the wheel on the larger or outer curve. In this case, the groove or channel is not to be equal in depth to the rise or projection of the flanch, so that the flanch alone bears on the rail on this outer side, and takes the whole weight of the load, thus freeing the tread of the wheel on that side from the face of the plate, for the distance necessary to turn the curve; for a full exemplification of which plan, I refer to said letters patent for 'turning short curves.' Such curves, however, will rarely, if ever, occur, excepting in the turning of the corners of streets; and to this particular mode I make no claim in the present patent. When the wheels arrive at the straight part of the track, after having run upon a curved part, the rails shown in figure 3 are used, or others of a like nature.

"It is to be understood that the object had in view in varying the form of the rails by chamfering, as in figure 3, or by omitting the chamfer, as in figure 2, is to attain the same end, namely, the running with little friction or dragging around curves in the streets, which is attained in the ordinary railroad tracks out of cities by allowing the cars to vibrate from side to side, so that the varying diameter on the conical parts of the treads of the wheels may cause them to adapt themselves to curvatures on the road. The narrow channel used by me, and so essential in cities, does not admit of this lateral vibration, but, by the devices above described, a similar result is attained.

"In most cases for passing along streets, and more especially when the iron rails are imbedded in rails or sills of stone, I prefer so to construct the said iron rails as that the wheels shall run altogether on the flanches. In this case, I use iron plates, such as are represented in figure 4. These plates may be made two inches and three-quarters wide at top, and three inches at the bottom; the channel or groove may be about five-eighths of an inch in depth, and an inch and a quarter wide at the top, and an inch at the bottom; the corners, at the bottom of the groove, being curved as in figures 2 and 3. The thickness below the bottom of the groove or channel may be three-fourths of an inch; the plates would then be one inch and three-eighths in depth. These shallow-channelled plates present several advantages, among which are, that they will offer less resistance than others to the motion of the cars; they are much lighter than others; they will not require any cleaning out, the flanches effecting this perfectly, which may not always be the case in deeper channels. These

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shallow channels may be made narrower than the deeper ones, the flanches being much thinner at their outer edges than they are near to the treads of the wheels. The wheels will, undoubtedly, be as safely guided in the shallow as in the deeper channels, and the rails will be equally durable with those of greater weight. When rails of this description are sunk into a channel in a rail of stone or wood, the base being wider than their upper sides, the pressure of sand into the seams on each side of the iron, caused by the running of common carriage-wheels over them, will effectually confine the iron plates between the jambs of the stone or wood. Figure 6 shows a rail plate resembling figure 4, but having a channel the whole depth of the flanch.

“Should it be preferred to use the ordinary wrought-iron rails, they may be laid double, at such a distance apart as to form the proper channel for the flanch between them; *ff*, figure 5, are sections of two such iron plates, and are shown as used at D on the track. Wrought plates may also be formed in the manner represented in figure 7. This plate is rolled so as to have a channel, *a*, in it, which may be one inch and a quarter wide at top, one inch at bottom, and five-eighths of an inch deep. The plate, *g g*, on each side of the channel, may be two inches wide; the whole plate may be of uniform thickness, and furnished with spike-holes alternately on each side of the channels; these are supposed to be used at E on the track. Where it is necessary to cross a water-gutter in the street, I use a cast-iron plate or plates to cross said gutter, the flanch channels being in such plate or plates. The whole surface between the channels is cast rough, to prevent the slipping of the feet of horses. The aforesaid cast-iron plate is best cast in one piece, as it will be stronger than if divided; although of the same thickness, it must, of course, be of a width sufficient for the particular gutter to which it is to be applied, and it should be strengthened by having ribs cast on its lower sides; these should be about an inch and a quarter deep, exclusive of the thickness of the plate. In some cases I cover the gutters the whole width of the street with such cast-iron plates, and extend them to some distance beyond the curbings. I thus make a great improvement in streets for the ordinary purposes of travel. Such a plate is shown in figure 8, *aa* being the grooved channels cast therein, and *hh* the upper face of the plate, cast rough or checkered.

“Having thus fully described the nature of my improvements, and pointed out various modes in which the same may be carried into effect, what I claim as constituting my invention, and desire to secure by letters patent, is the employment of plates or rails, either of cast



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or of wrought iron, constructed and operating upon the principle or in the manner herein described; having narrow grooves on each side of the track for the flanches of car-wheels to run in, by which they are adapted to the unobstructed passing over them of the various kinds of common carriages, and to the running of the wheels on slight curves without dragging. I also claim, in combination with such grooved rails or tracks, the employment of plates of cast-iron for the covering and crossing of gutters, such plates being constructed as described, and having the necessary flanch channels cast in them. And I do hereby declare that I do not intend to confine myself to the precise forms and dimensions herein given, these being designed merely to exemplify, in a clear manner, the nature, object, and mode of carrying into effect of my said invention.

“JAMES STIMPSON.

“Witnesses: J. M. STIMPSON, S. E. STIMPSON.

“Whereas, upon the petition of James Stimpson for an extension of the within patent, granted to the said Stimpson on the 25th day of August, 1831, the Board of Commissioners, under the eighteenth section of act of Congress approved the 4th day of July, 1836, entitled ‘An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose,’ did, on the 21st day of August, 1845, certify that said patent ought to be extended: Now, therefore, I, Edmund Burke, Commissioner of Patents, by virtue of the power vested in me by the said eighteenth section, do renew and extend said patent, and certify that the same is hereby extended for the term of seven years from and after the expiration of the first term, viz., the 23d day of August, 1845, which certificate of the said Board of Commissioners, together with this certificate of the Commissioner of Patents, having been duly entered of record in the Patent Office, the said patent now has the same effect in law as though the same had been originally granted for the term of twenty-one years.

“In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed, this 21st day of August, 1845.

[L. s.]

“EDMUND BURKE, *Commissioner of Patents.*”

It is admitted that, for the invention of the plaintiff referred to in the above-mentioned specification as being for “turning short corners,” a patent, dated 23d August, 1831, duly issued to him, which, for defect in specification, was surrendered; and that another, in place of it, issued to him, dated the 26th of September, 1835, and that said

## Statement of the case.

patent was duly extended for the term of seven years from the 23d of August, 1845, when the term of said original patent ended.

It is admitted that the invention for "turning short corners," as described in the specification in the patent of the 26th of September, 1835, was as follows, to wit:

*Specification.*

"The schedule referred to in these letters patent, and making part of the same, containing a description, in the words of the said James Stimpson himself, of his improvement in the mode of turning short curves on railroads, for which letters patent were granted, dated the 23d day of August, 1831, which letters patent are hereby cancelled on account of a defective specification.

"To all to whom these presents shall come: Be it known, that I, James Stimpson, of the city and county of Baltimore, and State of Maryland, have invented a new and useful improvement in the mode of turning short curves upon railroads with railroad carriages, particularly those round the corners of streets, wharves, &c., and that the following is a full and exact description of said invention or improvement, as invented or improved by me, viz.:

"I use or apply the common peripheries of the flanches of the wheels for the aforesaid purpose in the following manner:

"I lay a flat rail, which, however, may be grooved, if preferred, at the commencement of the curvature, and in a position to be centrally under the flanches of the wheels upon the outer track of the circle, so that no other part of the wheels which run upon the outer circle of the track rails shall touch or bear upon the rails but the peripheries of the flanches, they bearing the whole weight of the load and carriage, while the opposite wheels, which run upon the inner track of the circle, are to be run and bear upon their treads in the usual way, and their flanches run freely in a groove or channel, which treads are ordinarily about three inches in diameter less than the peripheries of the flanches. Were the bearing surfaces of the wheels which are in contact with the rails while thus turning the curve to be connected by straight lines from every point, there would thus be formed the frustums of two cones, if there be four wheels and two axles to the carriage, or if but one axle and two wheels, then but one cone, which frustums, or the wheels representing their extremities, will, if the wheels are thirty inches in diameter, and are coupled about three feet six inches apart, turn a curve of about sixty feet radius of the inner track rail. The difference in diameter between the flanches and treads being as before stated, and the tracks of the usual width,

## Statement of the case.

the wheels coupled as stated would turn a curve of a somewhat smaller radius if the axles were not confined to the carriage and in a parallel position with each other; but this being generally deemed necessary, the wheels run upon lines of tangents, and those upon the inner track, being as wide apart in the coupling as the outer ones, keep constantly inclining the carriage outwards, and thus cause the carriage to tend to run upon a larger circle than the difference in diameter of the treads and flanches would otherwise give; but the depth of the flanches and couplings may be so varied as to turn any other radius of a circle desired. What I claim as my invention or improvement is the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn curves upon railways, particularly such as turning the corners of streets, wharves, &c., in cities and elsewhere, operating upon the principle herein set forth.

“JAMES STIMPSON.

“Witnesses: JAMES H. STIMPSON, GEORGE C. PENNIMAN.

“Whereas, upon the petition of James Stimpson for an extension of the within patent, granted to the said Stimpson on the 23d day of August, 1831, the Board of Commissioners, under the eighteenth section of act of Congress approved the 4th day of July, 1836, entitled ‘An act to promote the progress of the useful arts, and to repeal all acts and parts of acts heretofore made for that purpose,’ did, on the 21st day of August, 1845, certify that said patent ought to be extended:

“Now, therefore, I, Edmund Burke, Commissioner of Patents, by virtue of the power vested in me by said eighteenth section, do renew and extend said patent, and certify that the same is hereby extended for the term of seven years from and after the expiration of the first term, namely, the 23d day of August, 1845, which certificate of the Board of Commissioners, together with this certificate of the Commissioner of Patents, having been duly entered of record in the Patent Office, the said patent now has the same effect in law as though the same had been originally granted for the term of twenty-one years.

“In testimony whereof, I have caused the seal of the Patent Office to be hereunto affixed, this 21st day of August, 1845.

[L. S.]

“EDMUND BURKE, *Commissioner of Patents.*”

It is further admitted, that before and since the period of said extension of the first above-mentioned patent, the defendant, a corporation

created by the General Assembly of Maryland for the business of, and engaged in, the transportation of passengers and goods by railways belonging to it, did, upon its railway, and as part thereof, in the city of Baltimore, and at the corner of two streets to be turned in the course of said transportation, construct, and has ever since kept up and used, a curve furnished and fitted as follows, to wit: On the inner side of the curve is placed a double iron rail cast in one piece, with the interval between large enough to allow the admission of the flanch of the wheel, the rail on the outer side being the usual one throughout the curve, without difference of any kind, except that it is curved; and it is admitted that the passage of the cars around the curve is throughout, and always has been, upon the treads of the wheels; and these rails were intended and used for the purpose of enabling the cars to turn the curves of the streets above mentioned.

Upon this statement of facts, it is submitted to the court to determine whether the defendant, under a just construction of said patent declared upon, has been guilty of any violation thereof. And it is agreed, that if the court shall, in the premises, be of opinion in favor of the plaintiff, judgment shall thereupon be rendered for the plaintiff, for the damages laid in the declaration; to be released on payment of such sum as shall be found for actual damages by a jury, to be impanelled by consent for that purpose, subject to be increased by the court, according to the act of Congress in such case made and provided.

The court to render an absolute judgment for the defendant if of opinion in the premises with the defendant; and either party having the right to sue out a writ of error from the judgment of the court.

It is further agreed, that the railway above mentioned used by the defendant is not sunk into the ground, so as to make the top of the rail on a level with the surface, but projects above the surface the height of the rail; and that the court shall have the power to draw all inferences from the facts herein stated which could be drawn by a jury.

CHARLES F. MAYER, *Plaintiff's Attorney.*

J. M. CAMPBELL, *Defendant's Attorney.*

The case was argued by *Mr. Mayer*, for the plaintiff in error, and by *Mr. Campbell*, for the defendant in error.

*Mr. Mayer.*

By referring to the defendant's brief, it is perceived that the right of this court to take cognizance of this cause is disputed. It is true,

## Argument for the plaintiff in error.

that the determination of the suit in the court below was upon a statement of facts, and under an agreement that the court might draw inferences from the facts as a jury might. The statement was for the purpose of bringing to the attention of the court what the invention of the plaintiff was, and in order that they might compare the contrivance of the defendant with it. The very agreement provides a reserved right of review. The mere circumstance, then, that the court were to draw inferences from the facts as a jury might do, does not make the judgment below irreversibly final, and nullify the agreement for assuring to either party the benefit of an appellate review.

But if the court should be of opinion that by the agreement they cannot consider the case, they will not, therefore, affirm the judgment below by dismissing it, but will send it back as in a case of mistrial.

The case of *Prentice v. Zane*, 8 Howard, 470, was disposed of in a manner not meeting the unanimous approbation of this court; and it will not be followed if, even by discrimination, any distinction can be taken between this or any other case and that. But that was the case of a special verdict, in which the jury found, not the facts, but the *testimony*, and the counsel, not willing to hazard the mistakes of another blundering jury, submitted the case upon that testimony and the few facts which were found; and this court thought that it would convert them into a jury to require them to find the facts from testimony presented to them. But if the court below could not, within its powers, find facts, this court will not presume that it did so; but, on the contrary, that it did not do so. A court does, however, in a metaphysical sense, in every case make inferences from facts; and it directs a jury to infer from facts. But here there is no room for inference. The facts are all agreed.

But is it true, as is assumed by the other side, that the court can in no case deal inferentially with facts? There is such a thing as a demurrer to evidence, which assumes all the facts asserted on the other side to be true, and the court infers from those facts as a jury would do. The facts are all admitted by the demurrer, and the court deals with those facts. An appellate court does the same. The facts must, however, be admitted; for there can be no such thing as a demurrer to evidence where the testimony is contradictory. 3 Pet., 36, 96; 4 Cranch, 219; 7 Cranch, 565; 11 Wheat., 171, 320. Now, in the last case the court decided that it was not a proper case for demurrer. The question referred to the court was not one of law, but of fact; that is, the *facts* were not admitted from which the court were to make proper inferences, but they were to deduce from the

*testimony* what the facts were. It is not, then, strictly true that, in the demarkation of the line that separates the court and jury, it is not the province of the court to deal with facts inferentially. And why do you adopt the analogy to a special verdict rather than to a demurrer to evidence, when you come to assign a place to a "case stated," in the technical vocabulary? The court must look to the facts to determine whether the invention in the one case is the invention in the other case; but that is not finding facts. It is mere construction, which the judicial mind is always employed in making.

As to the merits. Has the defendant infringed our patent? Now, what is the principle of our invention, not as gathered from a single expression judged by a meagre and carping criticism, but as taken from the whole context? The courts say that you are to look at the thing to be done, the object to be accomplished, and then to the agency by which it is accomplished. 1 Sumner, 482. The operative principle of our patent is the *groove*, by which the cars are kept in place, and it makes no difference whether you run them upon the flanch or upon the tread. Now, the defendant claims to have constructed a railway by the laying of two pieces of rail with an interval between them, which answers to our groove. And reliance is placed upon the using of one rail only for a groove, the other rail being flat. This, however, only gives the defendant a less beneficial use of our invention. It is but a mere colorable variance from the arrangements of the invention, whilst the principle, the characteristic merit, is adopted, whether on one or both sides of the railway, and whether the wheel shall move on the flanch or the tread. The case from 3 Wash. C. C. R. applies with force, where you take part of an invention, or accomplish less than the patentee proposes.

*Mr. Mayer* cited 2 Mason, 115; 4 Eng. Com. Law Rep., 357; 6 Ib., 512 (4 B. and A., 550); 4 Wash. C. C. R., 68, 703; 2 Brock., 298.

*Mr. Campbell, contra.*

The first question is, whether this court can exercise jurisdiction in this case. Can this court go out of its province as a court of law, and deal with other than questions of law? The court below had the power to find other facts by inference than those stated; and can this court, in the absence of any statement by the court below as to such further facts, determine what additional facts, if any, were or were not before the Circuit Court? The counsel on the other side says that the court can examine questions of fact, and draw inferences from facts, and that it has been done in case of demurrers to evidence.

## Argument for the defendant in error.

The case of *Prentice v. Zane* may stand, however, with the previous decisions. In demurrers to evidence, the only question is one of law upon the facts admitted. And Judge Buller long ago decided that there was no difference in principle between a demurrer to evidence and a special verdict. In either case the facts are found, and the court is called upon to determine the law. But in this case the court is to determine a mere question of fact. It is to deduce, from a comparison of the plaintiff's claim with the defendant's claim, the fact whether the one conflicts with the other. This case, then, presents no analogy to that of a demurrer to evidence where all the facts are admitted.

As to the merits. The reason that ordinary railway tracks are an obstruction to common traveling carriages is, that it is necessary that the rails should be raised above the surface of the ground, because railroad wheels are constructed differently from ordinary wheels in having two circumferences of different diameters, the smaller circumference being intended to rest on the rail, (and called the tread,) and the larger circumference running on the side of the rail. Now, the whole difference between the plaintiff's invention and the common railway track is, that the one is sunk beneath the surface of the ground, and the other not; the groove in this case answering the purpose of the elevation of the rails in the ordinary railway. Now, he does not claim the groove alone, and it is no part of his invention; but the *combination* of the groove with the sunken rails. The object which he accomplishes is the advantage of the present form of railroad wheels, *without* the usual obstruction to common vehicles.

The plaintiff's invention is a combination of the usual rail with a groove on each side of the road for the flanch of the wheel to travel in, so laid as not to rise above the surface. He has patented grooves on *both* sides of the road in connection with the sunken rail. He has patented grooves in combination, and not a single groove. Now, the defendant uses a rail with one groove only, that is, with a groove on one side of the road only, and the rails, instead of being sunk into the ground even with the surface, rise above the surface the height of the rail. The defendant's railway does not purport to do away, and does not in fact do away, the obstruction which it is the object of the plaintiff's invention to remove. The combination is not the same, and the result is different. How, then, can it be said that the one is an infringement of the other?

Now, it is settled, in the case of *Prouty v. Ruggles*, 16 Pet., 336, that, where three things are patented in combination, it is no infringement to use two of them in combination to produce the same result.

*Mr. Mayer*, in conclusion.

What we say is, that the using of one groove is a mere evasion—a mere colorable claim to invention. If the only object of our invention was the mere sinking of the railway, in order to remove an obstacle from ordinary vehicles, why, we should have patented only the sinking of the railway. But it is not so. We claim the sinking of the road in connection with the grooves for the reception of the flanches, in order to accomplish the safety of the cars, and their being kept in their course, especially at turns and corners. It is too narrow a view which is taken by the other side, to consider the sinking of the rails as the whole of the invention, merely because it describes that as one of its advantages. We maintain that Mr. Stimpson has patented the grooves, because he could not effect the objects of street travel without grooves. It is true, he describes his railway as peculiarly advantageous in the streets of towns and cities; still he does not confine it to that. The patent provides for the turning of a curve or corner, and this is as much a part of the claim as the sinking of the rail. The arrangement by which this is attained, with entire safety to the car and without impeding the speed, is singularly beautiful.

But it is said that this is a combination, and if any of the parts are left out, the combination is not used. There is no claim here for a combination, as such. We know what a groove is, and what a flanch is. Now, perhaps the effect, namely, the groove operating to restrain and confine the flanch, and thereby secure the safety of the car, may be produced as well by one groove as two. Still, the principle of the thing is the same. But this is not a combination. A combination is the union of distinct mechanical principles,—not a mere duplication of the same principle. The case of *Prouty v. Ruggles* was that of a plow. The whole of the parts were patented as a combination; and by so doing the patentee informed the world that anything short of the union of all these parts is not his invention. The jogging part of the plow was considered by the court a material part of the plaintiff's invention; and the defendant, having arrived at the same result without the jogging, had not taken the plaintiff's combination. But suppose there had been three joggings instead of one, and the defendant had taken two, would not that have been an infringement? The mere *quantum* of effect, whether greater or less, is not the point.

In regard to the jurisdiction, the court, in 11 Wheaton, says that, when the facts are found, the court will make inferences from them precisely as a jury would do. But in the case of *Prentice v. Zane* the facts were not found. The testimony was given, and the court was



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left to find out the facts from the testimony. Now, here you have all the facts. You have the plaintiff's claim, the sum, substance, and gist of his invention. You have also the sum and substance of that which we consider an infringement. The one can be placed beside the other; and it is but a matter of simple comparison to determine whether the one is identical with the other in any of its material parts.

Mr. Justice DANIEL delivered the opinion of the court.

This case comes before us upon a writ of error to the Circuit Court of the United States for the District of Maryland.

The plaintiff in error instituted in the Circuit Court his action on the case to recover of the defendant damages for an alleged infringement of a patent granted to the plaintiff on the 23d of August, 1831, and subsequently, under the authority of the United States, renewed and extended to him for an additional space of seven years from the expiration of the first grant.

On the trial of this suit, upon the plea of not guilty, the parties by agreement submitted their cause to the court upon a case stated. The court, on the case thus made and submitted, gave judgment in favor of the defendant; and to test the correctness of this judgment is the purpose of the investigation now before us.

The invention or improvement claimed by the plaintiff in error, and by him alleged to have been pirated by the defendant, is thus described in the schedule and specification filed with and made a part of the letters patent: "A new and useful improvement in the mode of forming and using cast or wrought iron plates or rails for railroad carriage-wheels to run upon, more especially for those to be used on the streets of cities, on wharves, and elsewhere; and I do hereby declare that the following is a full and exact description of my said inventions or improvements:

"For the purpose of carrying railroads through the streets of towns or cities, or in other situations where circumstances may render it desirable that the wheels of ordinary carriages should not be subjected to injury or obstruction, I so construct or form the rails, that the flanches of the wheels of railroad cars or carriages may be received and run within narrow grooves or channels, formed in or by said rails, said grooves not being sufficiently wide to admit the rims of the wheels of gigs or other ordinary carriages having wheels of the narrowest kind."

After some remarks descriptive of the shape and dimensions of the plates or rails, and of the grooves to be used, the specification thus

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proceeds: "Should it be preferred to use the ordinary flat wrought-iron rails, they may be laid double, at such distance apart as to form the proper channel for the flanch between them. Wrought plates may also be formed in the manner represented in figure 7. This plate is rolled so as to have a channel in it, which may be one inch and a quarter wide at top, one inch at bottom, and five-eighths of an inch deep. Where it is necessary to cross a water-gutter in the street, I use a cast-iron plate or plates to cross said gutter, the flanch channels being in such plate or plates. The whole surface between the channels is cast rough, to prevent the slipping of the feet of horses. The aforesaid cast-iron plate is best cast in one piece, as it will be stronger than if divided; although of the same thickness, it must of course be of a width sufficient for the particular gutter to which it is to be applied; and it should be strengthened by ribs cast on the lower side. In some cases, I cover the gutters the whole width of the street with such cast-iron plates, and extend them to some distance beyond the curbings. I thus make a great improvement in streets for the ordinary purposes of travel." Such being substantially, and indeed literally, as far as it is set forth, the descriptive part of the plaintiff's specification, his *claim*, or the substance and effect of his alleged invention and improvement, is given in these words: "What I claim as constituting my invention, and desire to secure by letters patent, is the employment of plates or rails either of cast or of wrought iron, constructed and operating upon the principle or in the manner herein described; having narrow grooves on each side of the track for the flanches of car-wheels to run in, by which they are adapted to the unobstructed passing over them of the various kinds of common carriages, and to the running of the wheels on slight curves without dragging. I also claim, in combination with such grooved rails or tracks, the employment of plates of cast-iron for the covering and crossing of gutters, such plates being constructed as described, and having the necessary flanch channels cast in them."

It is manifest from the description of the plaintiff, as given both in his specification and claim, that the improvement he alleges to have been made by him, whether important or otherwise, consists essentially, if not formally, in a combination. His grooves for the admission of the flanches of car-wheels, whether cast in iron plates or produced by the juxtaposition of two flat iron rails, and the rails themselves, were all of them long previously known, and long familiar in use; and it was by an application or combination of these familiar means or agents that he was to accomplish the result proposed, namely, the unobstructed passage of carriages over railroad tracks, when

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laid in streets or cities. The only idea or design in the plaintiff's description which wears the semblance of originality, is that of sinking or depressing these known agents or materials in combination to a level with the surface over which the passage of ordinary carriages was to take place. Still, these agents or materials were the same well-known grooves, the same car-wheels and flanches, and the same flat rails, which were to constitute the means of the plaintiff's operations. And the object of these operations, the essential improvement claimed, it should be constantly borne in mind, is the preventing of an inequality in the surface of streets, forming an obstruction to ordinary carriages, by reducing the railroad track to the same plane with the surface of the streets themselves.

The acts of the defendant complained of as being an infringement of the plaintiff's patent are thus set out in the case agreed by the parties, viz.: "That before and since the period of said extension of the first above-mentioned patent, the defendant, a corporation created by the General Assembly of Maryland for the business of, and engaged in, the transportation of passengers and goods by railways belonging to it, did, upon its railway, and as part thereof, in the city of Baltimore, and at the corner of two streets to be turned in the course of said transportation, construct, and has ever since kept up and used, a curve furnished and fitted as follows, to wit: On the inner side of the curve is placed a double iron rail cast in one piece, and with the interval between large enough to allow the admission of the flanch of the wheel, the rail on the outer side being the usual one throughout the curve, without difference of any kind, except that it is curved; and it is admitted that the passage of the cars round the curve is throughout, and has always been, upon the treads of the wheels; and these rails were intended and used for the purpose of enabling the cars to turn the curves of the streets above mentioned." The mechanism thus described as used by the defendant is, like that contained in the specification annexed to the patent of the plaintiff, evidently a combination, or an application of means or agencies previously known. If that mechanism can have any claim to originality, it must be in the *modus* or plan of that application,—not in the invention of the several parts of the mechanism.

It remains, then, by a comparison of these two combinations, to ascertain whether they are the same, either in form, or in the manner of their operation, or in the results they were designed to accomplish.

The combination claimed by the plaintiff as his improvement consists of the use of grooves on both sides of a railroad track, and either

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cast in iron plates, or made by the parallel position of double lines of flat rails, in which grooves the flanches only of car-wheels are to run, and which are likewise to be too narrow to admit the wheels of carriages having the most slender rims or felloes; and the whole of this combination or mechanism is to be depressed to a plane exactly corresponding with that of the street in which it may be introduced; as, without this arrangement, it is obvious that the unobstructed passage of ordinary carriages—the great object in view—could never be attained. The machinery of the defendant, complained of as an infringement of the plaintiff's patent, consists of a double flat rail of cast iron placed on the inner side of a curve or corner intended to be passed, and an ordinary flat rail on the exterior line of the same curve to be passed; and the whole of this machinery is constructed on the same plane with the general track of the road, elevated to whatever point that track may be raised, and without regard to the convenience of ordinary carriages making transverse passages through the streets; such facilities to ordinary carriages being no part of the end proposed by the defendant. From this comparison of the combinations in use by the plaintiff and the defendant respectively, and upon a just construction of the plaintiff's patent, the court, so far from regarding them as identical, either in mode, in design, or in result, is, in all their characteristics, constrained to view them as wholly dissimilar, and as not conflicting with each other. The combination, therefore, used by the defendant, cannot be regarded as an infringement of the plaintiff's patent. This conclusion is in strictest accordance with the ruling of the late Justice STORY at circuit in the case of *Prouty v. Rugles*, afterwards confirmed by this court, as will be seen in 16 Peters, 341. In the case just cited, the law is thus propounded by the Chief Justice: "The patent is for a combination, and the improvement consists in arranging different portions of the plow, and combining them together in the manner stated in the specification, for the purpose of producing a certain effect. None of the parts referred to are new, and none are claimed as new; nor is any portion of the combination less than the whole claimed as new, or stated to produce any given result. The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described. And this combination, composed of all the parts mentioned in the specification, and arranged with reference to each other and to other parts of the plow in the manner therein described, is stated to be the improvement, and is the thing patented. The use of any two of these parts only, or of two combined with a third which is substantially different in form or in the manner of its arrangement

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and connection with the others, is therefore not the thing patented. It is not the same combination if it substantially differs from it in any of its parts." The same doctrine is ruled in the case of *Carver v. Hyde*, 16 Peters, 513.

A preliminary question was raised in the argument of this cause, which, as it is connected with the practice in this court and in the courts inferior to this, and has an important bearing on the convenience both of the courts and the bar, is deserving of consideration. The question alluded to is this: Whether, as this case is not brought up either upon express or specific exceptions to the rulings of the Circuit Court, nor upon any decision of that court upon a special verdict found by the jury, but comes before us upon an agreed statement between the parties, this court can in this form take cognizance thereof? And it is insisted, for the defendant in error, that, under such circumstances, the writ of error could not be prosecuted. The objection thus urged is not one of the first impression in this court; it has been urged upon and considered by them on a former occasion, and must be regarded as having been put to rest.

This objection to the jurisdiction of the appellate court upon a case agreed between the parties in the court below, had its origin, no doubt, in the practice in the English courts, by which we are told that the appellate tribunal will not take cognizance of such a case, as it will upon one standing on exceptions, or on a special verdict.

This refusal, however, so to take cognizance, will, upon examination, be found to grow out of the peculiar modes of proceeding in the English courts, as is shown by Mr. Justice Blackstone in the third volume of his Commentaries, page 377, in his chapter on the trial by jury, in which we find the following account of the proceedings in those courts: "Another method," says this writer, "of finding a species of special verdict is, when the jury find a verdict generally for the plaintiff, but subject, nevertheless, to the opinion of the court above, on a special case stated by the counsel on both sides, with regard to the matter of law, which has this advantage over a special verdict, that it is attended with much less expense, and obtains a speedier decision; the *postea* being stayed in the hands of the officer of *nisi prius* till the question is determined, and the verdict is then entered for the plaintiff or defendant, as the case may happen. But as nothing appears on the record but the general verdict, the parties are precluded hereby from the benefit of a writ of error, if dissatisfied with the judgment of the court or judge upon the point of law, which makes it a thing to be wished, that a method could be devised of either lessening the expense of special verdicts, or else of entering

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the cause at length upon the *postea*." So, too, Mr. Stephen, in his Treatise on Pleading, page 92, speaking of the practice in England of taking verdicts subject to a special case, remarks, "that a special case is not like a special verdict entered on record, and consequently a writ of error cannot be brought on this decision."

The objection now urged, and the authorities bearing upon it, were pressed on the attention of this court, and considered by them, in the case of *The United States v. Eliason*, reported in 16 Peters, 291. In that case this court said: "It is manifest that the reason why, according to the practice in the English courts, a writ of error will not be allowed after a case agreed, is this, and this only, that in those courts the agreed case never appears upon or is made a part of the record, and therefore there is no ground of error set forth, upon which an appellate and revising tribunal can act. In the language of Justice Blackstone, nothing appears upon the record but the general verdict, whereby the parties are precluded from the benefit of a writ of error." This court goes on further to remark, that, "by a note to page 92 of Mr. Stephen's Treatise, it is said to have been enacted by the 3d and 4th of William the Fourth, chapter 42, that, where the parties on issue joined can agree on a statement of facts, they may, by order of a judge, draw up such statement in the form of a special case, for the judgment of the court, without proceeding to trial. By the settled practice anterior to this statutory provision, it was in the power of the parties to agree upon a statement of the case. It would seem reasonable and probable, therefore, that the power given to the judge, (as an exercise of his judicial functions,) to regulate the statement, was designed to impart a greater solemnity and permanency to the preparation of the proceeding, and to place it in an attitude for the action of some revising power. But should a want of familiarity with the details of English practice induce the hazard of misapprehension of its rules, or of the reasons in which they have their origin, the decisions of our own courts, and the long-established practice of our own country, are regarded as having put the point under consideration entirely at rest." The court then, after adverting to several decisions deemed applicable to the point, came to the following conclusion: "This court, therefore, has no hesitancy in declaring that the point of practice raised by the defendant's counsel presents no objection to the regularity in the mode of bringing this case before it." Regarding the above conclusion as promotive both of justice and convenience, we give it our entire concurrence; and upon the character, therefore, of the particular cause before us, as disclosed in the

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Syllabus.

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case agreed by the parties, we decide that the judgment of the Circuit Court be, and the same is hereby, affirmed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Maryland, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

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THE WASHINGTON, ALEXANDRIA, AND GEORGETOWN STEAM PACKET COMPANY, PLAINTIFFS IN ERROR, v. FREDERICK E. SICKLES AND TRUMAN COOK.

(10 Howard, 419.)

1. Where the declaration contained two counts,—viz., the first upon a special contract that the plaintiffs had placed a machine for saving fuel on board of the steamboat of the defendants, and were entitled to a certain portion of the savings; the second upon a *quantum meruit*,—it was admissible to give in evidence by the plaintiffs the experiments of practical engineers to show the value of the machine. Evidence had previously been given, tending to prove the value in the mode pointed out in the contract, and the evidence in question tended not to contradict, but to corroborate it. It was therefore admissible under the first count, and clearly so under the second.
2. On the part of the defendants, the evidence of the president of the steamboat company was then given, denying the special contract alleged by the plaintiffs, and affirming a totally different one, namely, that if the owners of the boat could not agree with the plaintiffs to purchase it, the latter were to take it away. The court should have instructed the jury, that if they believed this evidence, they should find for the defendants.
3. The court below instructed the jury, that if the president of the company, acting as its general agent, made the special contract with the plaintiffs, the company were bound by it, whether he communicated it to the company or not. This instruction was right. But the court erred in saying that the plaintiffs had a right to recover on their special count, if the machine was useful to the defendants, without regarding the stipulations of that contract as laid and proved, and the determination of the plaintiffs to adhere to it. Because, by the contract, the defendants are to use the machine during the continuance of the patent-right; and as no time is pointed out for a settlement, a right of action did not accrue until the whole service had been performed.
4. Whether, if there had been a count in the declaration for the cost of the machine, and the jury had believed that the defendants had agreed to pay it as soon as it was earned, the plaintiffs might not recover to that amount, or whether such a construction could be put on the contract as proved, are questions not before the court on this record, and upon which no opinion is expressed.

## Statement of the case.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Columbia, holden in and for the county of Washington.

It came up upon a bill of exceptions to the admission of certain evidence, and four bills of exceptions to refusals of the court below to grant certain prayers, all of which exceptions were taken by the defendants below—the plaintiffs in error here. But as two of the last-named bills of exceptions were not pressed in this court, it is not necessary to state them, or to state more of the case than is sufficient to show the points argued and decided by this court.

In March, 1846, Sickles and Cook brought an action against the Steam Packet Company. The cause of action is thus stated in the declaration :

“Whereupon the said plaintiffs, by Joseph H. Bradley, their attorney, complain, for that whereas heretofore, to wit, on the first day of July, 1844, the said defendants, at the county aforesaid, being the owners of a certain steamboat called the *Columbia*, and running in the Potomac River and Chesapeake Bay, in consideration that the said plaintiffs, being the proprietors of a certain machine called ‘Sickles’ cut-off,’ designed to effect a saving in the consumption of fuel for steam-engines, would place one of the said machines on the said steamboat *Columbia*, undertook and promised the said plaintiffs to apply the whole value of the saving of the fuel on board the said boat, which should be effected by the said machine, in the first place, to pay the cost and expenses of building the said machine, and putting the same on the said boat; and thereafter, and after having paid the said costs and expenses, that they, the said defendants, would, so long as the said steamboat should continue to be employed by the said defendants, if the patent-right for the said machine should continue so long, pay to the said plaintiffs three-fourths of the saving in fuel caused by said machine. And that the saving caused by the said machine called the cut-off, on board the said boat, should be ascertained at any time the plaintiffs should desire it, in the following manner, to wit, by taking equal quantities of wood, and using the same first with one and then with the other cut-off, (the defendants then having in use on board their said boat a machine called the throttle,) to show with which the boat would run the longest under the same circumstances. And thereupon the said plaintiffs, confiding in the said promises and undertakings of the said defendants, at great cost, to wit, at the cost of two hundred and fifty dollars, did erect and build, and place on the said steamboat *Columbia*, at the



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request of the defendants, a machine called 'Sickles' cut-off,' which said machine, and the same hath ever since, to wit, from the 20th day of August, 1844, continually, to the beginning of this action, been used by the said defendants in and upon the said boat; and that, on the 19th day of August, 1845, at the county aforesaid, the said plaintiffs gave notice to the said defendants that they would, on the next day, that is to say, on the 20th day of August, 1845, if they desired, make the said experiment in the said agreement mentioned, to test the relative value of the said machine; and, for that purpose, that one of the said plaintiffs would go from Washington to Baltimore, in the said boat, on the said 20th of August, 1845, and make the said experiment; and the said defendants, by their president, did then and there assent thereto, and did direct the officers of the said boat, or some of them, to aid in conducting the said experiment; and the said plaintiffs, in fact, further say, that one of the said plaintiffs, to wit, the said Truman Cook, did, on the said 20th day of August, 1845, proceed in the said boat from the said city of Washington to Baltimore, in the State of Maryland, and did, on the said voyage, with the assistance of the officers of the said boat, make the said experiment, and did take two piles of wood of equal dimensions and under like circumstances; the pile employed in the use of the throttle cut-off was burned in two hours and seven minutes; and the pile used by the cut-off of the plaintiffs lasted three hours and fifteen minutes, showing a saving in favor of the latter of 34 and  $\frac{175}{100}$  per cent., of all which the said defendants had due notice; whereby a great amount and value of fuel has been saved by the said defendants, to wit, the amount of twenty-five hundred dollars; and the said plaintiffs in fact say, they were and are entitled to recover of and from the said defendants, out of the said sum of money, as well as the said sum of two hundred and fifty dollars, as and for the costs and expenses of erecting and building the said machine, and placing the same on the said steamboat, as also the further sum of sixteen hundred and eighty dollars and fifty cents, being three-fourths of the said savings within said period of time after the said machine was put in operation on the said boat, and while the same was used by the said defendants, to the time of the bringing this suit; and being so entitled, the said plaintiffs, to wit, on the day and year aforesaid, and often afterwards, at the county aforesaid, demanded the whole of the said two sums of money, to wit, the sum of nineteen hundred and thirty-seven dollars and fifty cents, of and from the said defendants, and the said defendants utterly neglected and refused to pay the same, or any

## Statement of the case.

part thereof, to the said plaintiffs, and still refuse, to the damage of the plaintiffs four thousand dollars; and therefore they sue.

“JOSEPH H. BRADLEY, for Plaintiffs.

“Add a count for putting the machine on the boat at the request of the defendants, with a *quantum meruit*.

“JOSEPH H. BRADLEY, for Plaintiffs.”

The defendants pleaded *non assumpsit*, upon which issue was joined, and in March, 1847, the cause came on for trial.

The following is the evidence offered by the plaintiffs, which, being objected to by the defendants, but admitted by the court, formed the subject of the exception to evidence:

“On the trial of this cause, the plaintiffs, to maintain the issue on their part joined, offered and gave evidence tending to show that on or about the 18th day of June, 1844, at the county aforesaid, the said plaintiffs being the owners of the patent-right to a certain machine called a cut-off, of which the said Frederick E. Sickles was the inventor, and the said defendants being the owners of the steamboat called the *Columbia*, on which they had in use a certain machine called the throttle cut-off, the object of both machines being to save the consumption of fuel in the use of steam-engines, the said plaintiffs made and entered into a certain contract with William Gunton, the president of the steamboat company, and the general agent thereof, whereby it was agreed that the said plaintiffs should construct and place on board the said steamboat one of their said machines at their own cost and expense; that the same should be tried, and, if it produced any saving, that the cost of putting the said machine in operation on board the said boat, not to exceed two hundred and fifty dollars, should be first paid out of the savings of fuel effected by the said machine; that the said machine should be used by the defendants during the continuance of the patent, if the said boat should last so long; and after the payment of the said costs and expenses of putting the said machine in operation on board the said boat, the savings caused thereby, in the consumption of fuel, should be divided between the said plaintiffs and defendants in the proportion of one-fourth to the defendants and three-fourths to the plaintiffs; and, in order to ascertain the amount of such savings, an experimental trial should be made at any time the plaintiffs should direct it, after the said machine was in successful operation, in the following mode: Two piles of wood should be taken of equal dimensions; one should be used with one of the cut-offs, and the other pile with the other cut-off, under like circumstances, and the length of time required in the consumption of the

## Statement of the case.

said piles of wood, respectively, should be taken as the evidence of the difference in the amount of savings in the one over the other; and if the said machine produced no saving, it was to be taken off, and the boat restored to its former condition, at the expense of the plaintiffs.

"That the said contract was wholly in parol, and, within three days after it was made, the plaintiffs entered into a contract in writing with T. W. and R. C. Smith, of Alexandria, by the said plaintiffs, as follows: (copied in record :) and the said defendants caused their said boat to lie at Alexandria to have the said machine fitted to her engine; that the said T. W. and R. C. Smith proceeded with all convenient dispatch to make the said machine, and put the same on board the said boat, at the cost of two hundred and forty-two dollars; that the same was completed and placed on board the said boat, and in complete action, on the 9th day of November, 1844, with the knowledge of the defendants, and that the same was continually thereafter, to the bringing of this suit, used by the said defendants on board the said boat.

"That on the 19th day of August, 1844, the said Truman Cook, one of the said plaintiffs, gave notice, on board the said boat, to the said defendants, by William Gunton, president as aforesaid, that they desired on the next day, the same being the regular day for the passage of the said boat from the city of Washington to Baltimore, to go on the said trip and make the experiment, provided by their said contract, to ascertain the saving caused by the said machine; and the said William Gunton, president as aforesaid, directed the officers of the said boat, or one of them, to take care that the said Cook did not throw sand in his eyes; and on the said 20th day of August, 1844, the said Cook, one of said plaintiffs, did in fact go from the city of Washington to Baltimore on board the said boat, and the said experiment was in fact made, under the superintendence of the officers of said boat on behalf of said defendants, and by the said Cook on behalf of said plaintiffs, and the whole was, at the request of plaintiffs, carefully observed and noted by Captain Job Carson, for many years mate and captain of a steamboat, and the result of the said experiment was, that the said machine of said plaintiffs caused a saving of fuel, over and above the said 'throttle cut-off,' of  $34\frac{17\frac{5}{8}}{100}$  per cent., and full, minute, and accurate minutes of the said experiment, and of the result thereof, were taken and made in writing by the officers of the said boat, or one of them; that the average consumption of wood on her said trip to Baltimore was        cords, and on her trip from Baltimore was        cords, and the average price of wood, during the period she ran, from the 9th of November, 1844, to the bringing

## Statement of the case.

of this suit, was \$ , and, estimating the saving by the said machine at one-third, it amounted to \$ up to the impetration of the writ in this case.

“The plaintiffs further gave evidence to show, by practical and scientific engineers and builders of steam-engines, that the said experiment was the only mode by which the said savings could be ascertained with any degree of certainty; that it had been resorted to and tried by them; and one of them further proved, that, on the experiment conducted by him to test the difference between ‘Sickles’ cut-off’ and the ‘throttle cut-off,’ in a large steamboat belonging to Baltimore, and having an engine of the same construction as that on board the *Columbia*, the saving of the former over the latter was 42 per cent.; and they further proved that they were acquainted with both of the said machines, both theoretically and practically, and that no engineer would hesitate to say that ‘Sickles’ cut-off’ was far superior to the throttle, and to any other with which they were acquainted.

“They further gave evidence to show that the said machine had been applied by the plaintiffs to four other steamboats belonging to the port of the city of Washington, and the saving of fuel caused thereby ranged from 18 to 33 per cent. on board the said boats, respectively, and that the saving could not be ascertained by the amount of wood actually consumed without knowing and estimating the condition of the hull, and engine, and machinery, the state of the weather, the water, the freight, and the speed of the boat; and the only test was the experiment aforesaid, or one conducted on scientific principles which would give a proximate result.

“To introduction of which said evidence by practical and scientific engineers and others, builders of steam-engines, tending to show the operation of the said cut-off, and the savings resulting therefrom on other boats, the defendants, by their counsel, objected, because the same was inapplicable to the issue on the first count in the plaintiff’s declaration, and that the same could not be offered on the general counts, unless the plaintiffs abandoned the first.

“Which objection the court overruled, and allowed the said evidence to go to the jury; to which ruling of the court the defendants, by their counsel, excepted, and prayed that this their bill of exceptions may be signed and sealed—which is done this 25th day of March, 1847.

“JAMES S. MORSELL. [SEAL.]

“JAMES DUNLOP.” [SEAL.]

The defendants then offered evidence which is all incorporated into

## Statement of the case.

the bill of exceptions; but the following is that part upon which the prayer to the court below rested, involving the point which was argued in this court:

“The defendants, to support the issue on their part, called William Gunton, late president of the defendants’ company, who, being first sworn on his *voire dire*, stated that he had resigned the office of president of said company, and sold and transferred all the stock he held therein, and that he was in no way interested in the event of this suit between the said plaintiffs and the defendants; and the said witness, being sworn in chief, testified that he did not, as president of said company, or otherwise, make with the said plaintiffs the contract for the use of the cut-off called Sickles’ cut-off, on board the defendants’ steamboat called the *Columbia*, as the same is set forth in the first count in the plaintiffs’ declaration; that some time in the spring of the year 1844 he first met with Truman Cook, one of the plaintiffs, and after having conversed several times with the said Cook on the subject of the application of the said cut-off to the engine on board the said boat, the said Cook stated that he was very desirous to bring the cut-off to the favorable notice of the officers of the government, with the view of introducing the same into use on board the national steamships, and other steam-vessels sailing on the waters of the river Potomac and the Chesapeake Bay; that he, as president of the defendants’ company, agreed with the said Cook that he might place, at his own expense, the said cut-off on the engine of the said boat, and that if, on trial of the same on board the said boat, the said cut-off should be approved of, and the defendants should wish to purchase the same, the terms of such purchase should be afterwards determined on between the said parties; but if the said cut-off should not be approved of, or the terms proposed by said Cook for the use of the same by the said defendants on their said boat should be such that the said defendants could not accede thereto, the said Cook was to take the said cut-off from the said boat at his own expense, and restore the engine on the said boat to the same condition in which it was before the application of the said cut-off thereto; that the said cut-off was placed on the said engine pursuant to such last-mentioned agreement, and not in pursuance of any such agreement as is mentioned in the first count of the plaintiffs’ declaration; that afterwards, and when the witness, still being president of defendants’ said company, had had an opportunity to form some idea of the value of the said cut-off, he conversed with said Cook respecting the terms on which the same might be purchased for the use of the defendants on board the said boat, and the said Cook informed the said witness

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that the defendants should have the use of the said machine on as favorable terms as the same had been disposed of to the owners of the steamboat *Augusta*, or any other steamboat, but did not then, or at any other time, inform the witness at what price the same had been sold to the said steamboat *Augusta*, or any other steamboat, or make any such definite proposition for the sale of the said machine to the defendants as would enable him to lay the same before the board of directors of the said company for their approval; and that the defendants have at no time refused the said Cook or the plaintiffs permission to remove the same from the engine on board the said boat, and restore the said engine to its former condition."

The prayer to the Circuit Court, founded on this evidence, was as follows:

"Whereupon the defendants, by their counsel, prayed the court to instruct the jury, that if the jury believed, from the evidence, that the defendants agreed with the plaintiffs that they, the said plaintiffs, might, at their own expense, place the cut-off called Sickles' cut-off on the engine of the defendants' boat called the *Columbia*, that they, the said plaintiffs, might exhibit the qualities and usefulness of the said machine to the public, and thereby facilitate the introduction of the same into use on board the national steamships, and other steam-vessels sailing on the waters of the Potomac River and the Chesapeake Bay; and that if, on the trial of the same on board the *Columbia*, the said cut-off should be approved of, and the defendants should wish to purchase the same, the terms of said purchase should be afterwards determined on between the said parties; but if the said cut-off should not be approved of, or the terms proposed by the plaintiffs to the defendants, for the use thereof, should be such that the said defendants could not accede thereto, the said plaintiffs were to take the said cut-off from the said boat at their own expense, and reinstate the boat and her engine in the same condition in which she was before the application of the said cut-off thereto; and that the said cut-off was placed on the said boat pursuant to said agreement and permission as aforesaid, and not pursuant to any such contract as is set out in the first count in the plaintiffs' declaration; and that the said plaintiffs have made no definite proposition to the said defendants for the sale and use of the said cut-off, and have not been refused permission by the defendants to remove the same from their said boat, then the plaintiffs are not entitled to recover in this action, although the jury should believe from the evidence that the said machine was approved of, and has been used by, the said defendants; which instruction the court refused to give, there being only two judges on the bench, and

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they being divided in opinion on said instruction; to which refusal the defendants, by their counsel, excepted, and prayed the court that this their bill of exceptions may be signed and sealed—which is done this 25th day of May, 1847.

“JAMES S. MORSELL. [SEAL.]

“JAMES DUNLOP.” [SEAL.]

Among the evidence brought forward by the defendants, were the two following letters, which are inserted here because they are remarked upon by the court in the decision of the remaining exception:

*W. Gunton to Sickles & Cook.*

“As I am, week after week, annoyed by warrants, under a pretended contract, never entered into by me, respecting the cut-off placed under your direction on the steamer *Columbia*, and as I have repeatedly explained in writing, both to Messrs. T. W. and R. C. Smith, of Alexandria, and Mr. A. T. Smith, of this city, your agent or attorney, what the understanding between Mr. Cook and myself was in relation to the subject, and have expressed my willingness to comply therewith, I hereby give you notice, that unless you, within ten days from this date, remove the aforesaid cut-off from the *Columbia*, and replace, agreeably to that understanding, her machinery in the same condition in which it was immediately before the cut-off was applied thereto, I shall promptly thereafter cause the work to be done at your expense, and hold you liable for the same, in addition to the amount of expense incurred and loss sustained, by reason of the detentions of the *Columbia*, mentioned in my letters to your agent, Mr. A. T. Smith, before alluded to.

“W. GUNTON, *President*.

“*Washington City, 14th April, 1841.*

“MESSRS. SICKLES & COOK.”

*Reply to the above.*

“DR. WILLIAM GUNTON, *President*:

“We have received your note of the 14th instant, and hasten to reply to it, to avoid any further misapprehension on your part of the positions we respectively hold. You have chosen to make terms entirely different from those under which we contracted with you; have refused to execute your contract with us; have driven us to the necessity of a suit; and we are now resolved to bring the matter to an issue.

“You complain that you are annoyed by warrants. It is your own

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fault. You say you have repeatedly [stated] to Messrs. T. W. and R. C. Smith, of Alexandria, and Mr. A. T. Smith, of this city, what the understanding between Mr. Cook and yourself was in relation to this subject, and have expressed yourself willing to comply therewith. We have, as often as occasion and opportunity offered, stated to you, in the plainest terms, that your representations thus made were not the terms of our contract, and have as clearly and distinctly stated to you what that contract was. We now repeat it. We undertook to put Sickles' cut-off on the engine of the steamer *Columbia*, and offered to receive \$1,000 for the right to use it. You, seeming to doubt the importance of the invention, declined that offer; and we then offered to put the cut-off on, taking as a compensation for its use the value of three-fourths of the fuel saved by its use, deducting from the first savings \$250 for the construction of the machine, the saving to be ascertained by either of us by experiments with our cut-off and the old one attached to the engine of the *Columbia*, and you were to continue the use of our cut-off, provided we made it work well, so long as the boat continued to belong to your company. These terms you accepted in the most unequivocal manner. We employed the Messrs. Smith to construct the machine. This was all they had to do with it. They did make it, and it was applied, and has operated successfully. Persons were directed on board the boat to make accurate observations of the saving. It was found to be far greater than you had any idea of. We asked for compensation, and you denied the contract. Your own acts have compelled us to bring suit; and, in order to bring the matter to a close after that suit was brought, we took out a warrant against your company, so that either party might, by appeal, bring the question at once before the court for judicial decision. These are resisted on technical grounds, and now you give us notice to remove the cut-off. However much we might be disposed to avoid litigation, and to terminate all controversy by an amicable adjustment, the course you have taken has determined us, and we now give you notice that we will not only not interfere with the cut-off on board the *Columbia*, and hereby protest against your interfering with it, but we will every week bring an action to recover the amount of saving coming to us on the terms of our contract with you. Until we can get a judicial decision in the matter, you must choose for yourself.

“SICKLES & COOK.

“*Washington, 15th April, 1846.*”

The remaining prayer to the Circuit Court was as follows:

“The defendants, by their counsel, further prayed the court to



## Argument for the plaintiffs in error.

instruct the jury, that if the jury believed, from the evidence, that the contract set out in the first count of the declaration, and alleged to have been made by the plaintiffs and William Gunton, the president of the defendants' said company, was never authorized by a board or quorum of the directors of said company, as provided by their charter of incorporation, and was never sanctioned or approved of by said board or quorum of the said directors, and that the said William Gunton, in making such contract with the plaintiffs, if the jury believe the same to have been made by him, did not act within the scope of his authority as such president, then the said contract is void as respects the said defendants, and the said plaintiffs are not entitled to recover under the said first count in their declaration; which instruction the court refused, but granted the same with the following modification: But if, from the evidence, the jury shall find that William Gunton, the president of the defendants' company, and acting as their general agent, made with the plaintiffs the contract set out in the first count of the said declaration, and that the plaintiffs, under the said contract, put the said machine on the defendants' boat, and the same was used by the defendants at the time and times mentioned in the said count, and that the same was beneficial to the defendants, then the plaintiffs are entitled to recover on the said first count, notwithstanding the jury shall find that the terms of the contract were not communicated to the defendants, and the said William Gunton reported to the said defendants a different contract; to which refusal of the said instruction, and modification thereof, the defendants, by their counsel, excepted, and prayed that this their bill of exceptions may be signed and sealed—which is done this 25th day of May, 1847.

“JAMES S. MORSELL. [SEAL.]

“JAMES DUNLOP.” [SEAL.]

The jury found a verdict for the plaintiffs, and assessed the damages at \$1,800, with interest from the 9th of November, 1845. A writ of error brought these several rulings of the Circuit Court before this court for revision.

It was argued by *Mr. Lawrence*, for the plaintiffs in error, and by *Mr. Lee* and *Mr. Bradley*, for the defendants in error.

The argument on behalf of the plaintiffs in error, with respect to the admissibility of the evidence, was as follows:

1st. The same was inapplicable to the issue on the first count in the plaintiffs' declaration.

2d. That the same could not be offered on the general count, unless the plaintiffs abandoned the first.

The plaintiffs in error insist that the court erred in allowing the evidence objected to by them to go to the jury—

1st. Because it was in no way applicable to the issue on the special count in the plaintiffs' declaration. It did not tend to prove any one of the allegations contained in that count, and was therefore irrelevant and collateral.

The plaintiffs allege that a special mode of testing the value of their machine, in contrast with that previously used on board the defendants' boat, was agreed upon by the parties, and constituted part of their contract; the experiment was, as they allege, to be made on board the *Columbia*. It was therefore wholly immaterial to the point in issue on the first or special count, what had been the result of experiments made on board steamboats in Baltimore or Washington. The defendants had no notice of such experiments, were not present at them, and ought not be affected by them.

Neither was it proper to give in evidence the opinion of engineers or steamboat builders, however well informed as to the relative value of the two machines, particularly as the plaintiffs allege a special mode of ascertaining the difference in value had been agreed on by the parties in their alleged contract.

It is a familiar rule of evidence, that it must correspond with the allegations in the pleadings of the party who offered it. 1 Greenleaf on Evidence, secs. 51 and 52.

This rule excludes all evidence of collateral facts. The admission of evidence of that character tends to divert the minds of the jury, to excite prejudice, and mislead them; the adverse party is taken by surprise, and cannot be prepared to rebut it.

Thus, where the issue between a landlord and his tenant was whether rent was payable quarterly or half-yearly, evidence of the mode in which other tenants of the same landlord paid their rent was held by Lord Kenyon inadmissible. Peake's Cases, 95.

So the opinions of engineers, and the results of experiments on other boats, ought not to have been allowed.

2d. This evidence was not admissible under the *quantum meruit* count.

Where there is an express contract, and a stipulated mode of compensation, the party rendering the services cannot waive the contract, and resort to an action on a *quantum meruit*, or an implied assumpsit. *Champlin v. Butler*, 18 Johns., 169.

Where the special agreement subsists in full force, the plaintiff

## Argument for the plaintiffs in error.

cannot recover under the common counts, but the remedy is on the contract. Buller's N. P., 139; *Raymond v. Bearnard*, 12 Johns., 274; *Jennings v. Camp*, 13 Johns., 94; *Clarke v. Smith*, 14 Johns., 326; *Wood v. Edwards*, 19 Johns., 205; *Perkins v. Hart's Executor*, 11 Wheat., 237.

In the case before the court, the contract was subsisting and continuing; it was to last as long as the defendants should continue to employ the boat *Columbia*, if the patent for the machine continued so long. The plaintiffs had declared upon it as a subsisting contract. The *quantum meruit* count was for the same subject-matter as the special contract.

In the case of *Cooke v. Munstone*, 1 Bos. & Pull. N. R., 354, the declaration contained a count on a special contract, and a count for money had and received to the use of the plaintiff; the plaintiff failed to prove the contract laid, but proved another variant from it; he claimed to recover on his common count; the court decided that the plaintiff could not proceed on the common counts. The court said: "The cases in which the plaintiff had been allowed to proceed on these counts are those in which the special contract is put altogether out of the case. It would be very strange to allow the plaintiffs to recover on the general *indebitatus assumpsit*, and still leave him to his right to recover for non-performance of his special contract. It is said he has a right to proceed at the same time on the special and on the general count; but the cases only warrant a permission to resort to the latter when the former has failed altogether. In this case, if we were to allow the plaintiff to go into the evidence he offered, it would amount to saying that there was no evidence of a subsisting special agreement, when in truth there was such evidence."

In *Clarke v. Smith*, 14 Johns., 326, the declaration contained a count on a special agreement, and the common counts relative to the same subject-matter. The plaintiff, at the trial, proceeded to give evidence under the common counts; the witness, on cross-examination, said there was a written contract between the parties, under which the work was done; objection was then made to the plaintiff's giving evidence under the common counts, which was overruled by the court.

On appeal, this was held to be error, and it was decided, that whenever the special contract is still subsisting, and no act done or omitted by the one party which would authorize the other to consider the contract rescinded, the remedy must be on the special contract, which principle will be found to run through all the cases.

While the contract is still subsisting, part performance will not

entitle the plaintiff to resort to the common counts to recover the value of that which he has done in part fulfillment of the contract.

If the plaintiffs could not resort to the common count, they ought not to have been allowed, the defendants objecting, to give evidence applicable only to that count. There was conflicting testimony respecting the value of the machine, and the minds of the jury must have been affected by the testimony thus improperly offered.

With respect to the exception founded on the refusal of the court to grant the first prayer made by the defendants below, the error alleged was this :

If the plaintiffs acted under a special agreement with the defendants in putting the said machine on the defendants' boat, and there was any failure on the part of the defendants to comply therewith in any respect, the proper and only remedy for the plaintiffs was by action on that special agreement.

Whether the agreement was such as the plaintiffs pretended, or such as the defendants pretended, while such agreement was subsisting, there could be no remedy for the plaintiffs on the common counts.

If the argument was such as the plaintiffs have set out in the first count in their declaration, and the jury believe the evidence introduced to prove the same by the plaintiffs, then they were entitled to recover on that count.

But if the jury gave greater credence and weight to the evidence offered by the defendants to sustain the issue on their part, and believe the contract to be proved to be such as the defendants set up, then the plaintiffs were not entitled to recover—

1st. Because of their failure to prove the contract set out by them.

2d. Because a different contract was proved by the defendants, of which there was no breach on their part alleged or proved, and which was still subsisting.

It is clear, from the terms of the agreement, as shown by the defendants' evidence, that the machine was not put on the defendants' boat to be used by them under a contract of purchase, nor was the use thereof to be paid for by the defendants. It was put on board by permission of the defendants at the request of the plaintiffs, and for their advantage. The plaintiffs were at liberty to remove it at their pleasure. If the defendants should wish to acquire the right to use it permanently, it was to be made the subject of a future agreement.

If the jury believed this, and certainly the defendants' evidence tended to prove it, and no subsequent contract was alleged or proved, and no offer by the plaintiffs to remove the machine from the boat,

## Argument for the plaintiffs in error.

and refusal by the defendants to allow it, either alleged or proved, then the plaintiffs made out no case against the defendants; and, when asked by the defendants, it was the duty of the court so to tell the jury, and their refusal was an error.

The court seemed to have been of opinion, that notwithstanding the jury might believe, from the evidence, that the defendant did not contract with the plaintiffs, either for the purchase or use of the machine, and that the same was put on board the plaintiffs' boat for their own benefit and advantage with the public, yet, as the same had been used by the defendants, and they had derived benefit therefrom, they ought to pay for it; and if they refused to do so, the plaintiffs had a right to recover for such use.

Respecting the last prayer, the plaintiffs in error contend that the court erred in refusing the instruction as originally asked for, and in giving the same with said modification.

In the third section of defendants' said charter, it is provided that the affairs of the company shall be conducted by four directors and a president; that two directors and the president shall form a quorum for transacting all the business of the company.

In the fifth section, it is provided that the president and directors shall have full power to use, employ, and dispose of the funds and property of the company for the interest and benefit of the stockholders, and agreeably to the objects of the said act of incorporation.

The president of the company has, as such, no power to bind the company by contract; he may be authorized to act as the *special agent* of the company in some particular case, or *generally* in the performance of some prescribed duties. His power as agent of the company cannot be without scope or limit. An act of the board authorizing the president to act as *universal agent*, with unlimited authority to act for and dispose of the property of the company, would be a violation of the charter, and void.

If it is assumed that Mr. Gunton made with the plaintiffs the contract set out in the declaration, he acted, in doing so, as the president or agent of the company, and within some supposed limits. If the act done was within the scope of his authority, the company was bound by it. If, however, the act done was not within the scope of this authority, then the company was not bound by it.

It is not contended that third persons are to be affected by the private restrictions which a principal may impose on his agent. It is conceded, that whenever the act is within the scope of the agent's authority, the principal is bound. Story on the Law of Agency, sec. 127.

In the instruction which the court refused, they were asked to say to the jury, that if they believed, from the evidence, that Mr. Gunton, in making the said contract, did not act within the scope of his authority as such president, and that the said contract was never authorized or sanctioned by the board of directors, then the same was void as respects the defendants.

In refusing this instruction, the court left the jury to understand that the contract was binding on the defendants, notwithstanding it was not within the scope of Mr. Gunton's authority as president, and so agent of the company, to make it; and the same had never been authorized or sanctioned by the board of directors.

This ruling on the part of the court, as the subsequent modification shows, had its basis in an opinion held by them, that the defendants, having had the use of the machine, if they were benefited thereby, were, at all events, bound to pay for it.

The subsequent granting of this instruction, with the modification attached to it by the court, magnified the error of their first refusal.

The plain and fair construction of the whole is this: That if the jury believe Mr. Gunton, in making said contract, acted beyond the scope of his authority as president of the company, and that the contract was never authorized or sanctioned by the board of directors, the contract was void; yet, if he, being the president of the defendants' company, and acting as their general agent, did make the said contract, even if he did exceed his authority, and the plaintiffs, under said contract, put their machine on the defendants' boat, and it was used by the defendants, and was beneficial to them, then the plaintiffs are entitled to recover under the special count in the declaration; that is, they are entitled to recover for the beneficial use on the first or special count in the declaration.

One of the terms of the contract, as set out in the declaration, is that the whole of the value of the savings which should be effected by the plaintiffs' machine over the old throttle cut-off, should be applied to pay for the cost of the machine, &c., and after that three-fourths of the savings thus effected should be paid to the plaintiffs, and the amount was to be ascertained in a certain way.

The instructions given by the court to the jury do not limit the right of the plaintiffs to recover according to the terms of their alleged agreement, but they affirm their right to recover, if the jury believed the machine was used, and was beneficial to the plaintiffs. The court say they may recover for the beneficial use, and that under the special contract. The jury are not told that the beneficial use of the plaintiffs' machine must, in their judgment, exceed that of the old throttle cut-

## Argument for the defendants in error.

off. It is sufficient, in the judgment of the court, that the defendants had used the machine, and that that use was beneficial, to authorize the plaintiffs to recover to the extent of the value of such use.

If the ruling of the court had been, that if the jury believed that Mr. Gunton, in making the contract, exceeded his authority, and therefore that the contract was void as against the defendants, in the absence of any contract binding the defendants, the plaintiffs might recover under<sup>t</sup> the common count, if they believed the defendants used the plaintiffs' machine, and it was beneficial to them, there would have been no error in their instruction; but such is not the ruling of the court. They say, that if the machine was put on the boat under the special contract, and was used by the defendants and proved beneficial, the plaintiffs may recover the value of such use on the count on that contract.

The following authorities were relied on: *Bank of Columbia v. Patterson's Administrator*, 7 Cranch, 306; *Head and Amory v. Providence Insurance Co.*, 2 Cranch, 127; *Fleckner v. Bank of United States*, 8 Wheat., 338; *Bank of United States v. Dandridge*, 12 Wheat., 64.

The counsel for the defendants in error, with respect to the admissibility of the evidence, conceded that the evidence was not admissible under the first count in the declaration, and that it was not offered as applicable to that count, but contended that it was clearly admissible under the second count. The propriety of joining a count on the special agreement with a common count cannot be doubted. It is the usual and proper course. Arch. Civ. Pl., 174.

Where there is a special agreement, the rules are—

1st. So long as the contract is executory, to declare specially; when executed, and the payment is to be in money, the general counts may be used. *Streeter v. Horlock*, 1 Bing., 34, 37; *Study v. Sanders*, 5 Barn. & Cres., 628; *Tuttle v. Mayo*, 7 Johns., 132; *Robertson v. Lynch*, 18 Johns., 451.

2d. Where the contract has been partly performed, and has been abandoned by mutual consent, or rescinded by some act of defendant, plaintiff may use the common counts. *Robson v. Godfrey*, 1 Stark., 275.

3d. Where work has been done under a special agreement, but not in the time or manner stipulated, has been accepted by and is beneficial to defendants, the common counts may be resorted to. *Keck's Case*, Bull. N. P., 139; *Burn v. Miller*, 4 Taunt., 745; *Streeter v. Horlock*, 1 Bing., 34; *Jewell v. Schroepel*, 4 Cow., 564; *Taft v. Montague*, 14 Mass., 282.

These are general principles now universally admitted.

But it is supposed the plaintiffs were bound to waive or abandon their first count before they could resort to the common count. Is this so?

It was contested, and they had a right to give evidence as to both. They were both good counts. It was competent for them to have the verdict entered on whichever count they pleased, or the court might have instructed the jury at the instance of either party. If the contract had been admitted, the case would have been different. Here the whole matter was *in pais*, and the court was right in admitting the evidence.

As to the first prayer.

The rules already presented furnish a conclusive answer to this. If the machine was placed on the boat under the agreement assumed by this prayer, it is still quite clear the plaintiffs were entitled to compensation for the time it was used by the defendants, if it was beneficial to them, although they should not have agreed on the terms.

It proceeds on the hypothesis that the plaintiffs would place the machine on the boat at their own expense, and for their own benefit; and if, on trial, it should be approved of by the defendants, and they should desire to purchase it, the terms of such purchase should be afterwards determined on between the parties; but if it should not be approved, or the terms proposed by said Cook for the use of the same should be such that defendants could not accede thereto, plaintiffs should remove it at their own expense, and replace the boat in as good condition as before. This is, however, but a partial statement of the evidence. It was approved of. The defendants conferred with Cook about the price, and he said they should have the use of the machine on as favorable terms as the same had been disposed of to the *Augusta*, or any other steamboat; but he did not state what those terms were.

The *Augusta* was a boat running in the same waters; the *Osceola* was another. The means of ascertaining the price were within the reach of defendants. The defendants understood this to be a distinct and binding offer. They did not reject it; but continued to use the machine after these terms were proposed.

It was a contract of sale or use. The plaintiffs had done their part, executed the contract, and the payment was to be made in money. They might resort to the common count. See cases under the first rule above. They gave evidence to show the terms on which the *Osceola* had it. This was the measure of the sum which they could recover



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on the common count. It was competent for defendants to have proved that the terms with the *Augusta* were more favorable, if they had chosen to do so. But the court was asked to say they could not recover at all in this action, rejecting the second count altogether.

As to the fourth exception.

The instruction assumes that the defendants' president must have been authorized by a board or quorum of the directors, or his act sanctioned and approved by such board or quorum, to make it binding on the company.

It admits the making of the contract. It was a contract eminently beneficial to the company, saving more than one-third of the fuel. It was made by the general agent of the company in the ordinary discharge of his duties. They were bound to know its terms. If they chose to avail themselves of the benefits without inquiring into those terms, or if they believed, from the report of their said agent, that he had made a different contract, they are still bound by the contract which he did make. *Bank of Columbia v. Patterson's Adm.*, 7 Cranch, 299; *Mechanics' Bank v. Bank of Columbia*, 5 Wheat., 326; *Fleckner v. Bank of United States*, 8 Wheat., 338; *Bank of United States v. Dandridge*, 12 Wheat., 64; *Bank of Metropolis v. Guttschlick*, 14 Pet., 27.

Mr. Justice GRIER delivered the opinion of the court.

Sickles and Cook, plaintiffs below, filed their declaration in assumpsit, containing two counts.

The first sets forth a parol contract made with William Gunton, president of the steamboat company and general agent thereof, in which it was agreed that the plaintiffs should construct and place on board the steamboat *Columbia* a certain machine, invented by Sickles, called a "cut-off," at their own cost; that the machine should be tried, and if it was found to produce any saving of fuel, that the cost of putting it in operation, not exceeding two hundred and fifty dollars, should be first paid out of the savings of fuel effected by the machine; that the machine should be used by the defendants during the continuance of the patent, if the boat should last so long; and after paying for its erection, the savings caused thereby in the consumption of fuel should be divided between the plaintiffs and defendants, in the proportion of one-fourth to defendants and three-fourths to plaintiffs. The mode of ascertaining the amount of saving is specially set forth; and the plaintiffs aver that they erected their cut-off on said steamboat, at the cost of \$242, on the 9th of November, 1844, and that it was afterwards ascertained, in the mode agreed upon, that

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the saving of fuel caused by using plaintiffs' cut-off exceeded that of the "throttle cut-off," before used by defendants, by  $34\frac{1}{8}\%$  per cent.; and that the amount saved over and above the price of erection when this suit was brought was \$2,500. For the amount of the \$242, and three-fourths of the latter sum, this suit is brought.

There is a second count, for putting the machine on the boat at request of defendants, with a *quantum meruit*.

On the trial of the cause below, evidence was given tending to prove the special contract as laid in the first count, and that the experiment to test the value had been made in the manner agreed upon, with the result as stated in the declaration. The plaintiffs then offered to show experiments made by practical engineers on other boats, and the result thereof, with the opinion of the said engineers as to the value of their cut-off. This evidence was objected to, and its admission is the subject of the first bill of exceptions, sealed at request of defendants.

The objection to this evidence is, that the mode of ascertaining the value of plaintiffs' cut-off is specially stated in the declaration, and no other could be resorted to. But we think that, even if there were no other count in the declaration than that on the special contract, this objection cannot be sustained. The plaintiffs have given in evidence the experiment made in pursuance of their alleged agreement, and as this testimony tended only to corroborate it, and not to contradict it, or enlarge the claim of the plaintiffs beyond that ascertained by the experiment made by the parties, it cannot be said to be irrelevant or incompetent—at most, it could only be said to be superfluous. But assuming that it was irrelevant on the first count, it is clearly not so as regards the common count on a *quantum meruit*. The plaintiffs had an undoubted right to give evidence which might enable them to recover on the latter count, in case the defendants should succeed in establishing their plea of *non assumpsit* as to the first. In this view of the case, the competency and relevancy of the testimony cannot be doubted.

To support the issue on their part, the defendants then called William Gunton, the late president of the company, who wholly denied that he made such a contract as that declared on by plaintiffs, and stated that plaintiffs expressed to him a desire to bring their "cut-off" to the favorable notice of the government, with a view of introducing it on board the national steamships; that he gave them leave to erect their machine on the boat at their own expense, and agreed that if, on trial, the machine should be approved by the defendants, they would purchase it, on terms to be afterwards agreed upon; but

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if not approved, or the terms of purchase offered by plaintiffs should be such as defendants would not accept, then plaintiffs should have leave to take off their machine at their own expense; that afterwards, when the plaintiffs' terms were asked, they said defendants should have the machine on the same terms as the steamboat *Augusta*, and other boats, but would not then, or at any other time, state definitely what those terms were, or what price the *Augusta* had given, or the plaintiffs would be willing to take, so that it could be laid before the company for their approval; that defendants had never refused permission to plaintiffs to take away the machine from the boat, if they so desired to do. Certain letters were also given in evidence, the contents of which it is not necessary to state, in order to understand the instructions given to the jury, which are now the subject of exception.

Four several bills of exception have been taken to the refusal of the court to give four items of instruction of the jury. Two of these only are relied on here. The first may be briefly stated thus: That if the jury believed the testimony of William Gunton, and that the contract between the parties was such as he stated, defendants were entitled to a verdict. This instruction was refused by a divided court.

We are of opinion that the defendants were clearly entitled to have this instruction given to the jury, as the testimony, if believed by them, fully supported the defendants' plea, and showed that the plaintiffs were not entitled to recover on either count in their declaration. They could not recover on the first count, for this testimony showed that there was no such contract between the parties as that set forth in it; nor on the count on a *quantum meruit* for the use of the machine, for that would be a repudiation of the contract as proved. If the plaintiffs put their machine on board of defendants' boat for the purpose of experiment, on an agreement that defendants should pay for it if, on trial, they approved it, and were willing to give the price asked, otherwise the plaintiffs should have leave to take it away, it certainly needs no argument to show that, without stating their terms, or offering to fulfill their contract by a sale of the machine, the plaintiffs cannot repudiate it and sue for the use of the machine. This would be a palpable fraud on the defendants.

The only other exception urged to the charge of the court below is in the answer given by the court to the fourth instruction prayed, which is as follows:

"If, from the evidence, the jury shall find that William Gunton, the president of the defendants' company, and acting as their general agent, made with the plaintiffs the contract set out in the first count

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of the said declaration, and that the plaintiffs, under the said contract, put the said machine on the defendants' boat, and the same was used by the defendants at the time and times mentioned in the said count, and that the same was beneficial to the defendants, then the plaintiffs are entitled to recover on the said first count, notwithstanding the jury shall find that the terms of the said contract were not communicated to the defendants, and the said William Gunton reported to the said defendants a different contract."

We find no fault with this instruction, so far as it states the liability of defendants for the acts of Gunton as their general agent, whether he reported his agreement to the defendants or not. If he was their general agent, and had power to make such contract, his failure to communicate it to his principals cannot affect the case. But we are of opinion that the court erred in stating that the plaintiffs had a right to recover on their special count, if the machine was useful to the defendants, without regarding the stipulations of said contract as laid and proved, and the fact that the plaintiffs had refused to rescind it, and had expressed their determination to adhere to it and "to bring an action *every week* to recover the amount of saving on the terms of the contract."

If the plaintiffs had complied with the request of the president of the company, in a letter addressed to them on the 14th of April, 1841, after the dispute about the nature of the contract had arisen, and taken their cut-off from the boat, and thus put an end to the contract, the instructions given by the court would have been undoubtedly correct. But as the record shows that the plaintiffs have refused to annul the contract, a very important question arises—whether this action, and five hundred others which the plaintiffs have expressed their determination to continue to institute, can be supported on this *one* contract. By the contract as proved and declared on, the defendants, after the machine has been erected on their boat, are to continue to use it "during the continuance of the patent," if the boat should last so long. The compensation to be paid by the defendants is to be measured by the amount of saving of fuel which the machine shall effect. The mode of ascertaining this saving is pointed out, and the ratio in which it is to be divided. The first \$250 saved are all to go to the plaintiffs, and three-fourths of all the balance. But the contract is wholly silent as to the time when any account shall be rendered or payments made. The defendants have not agreed to pay by the trip, or settle their account every day, or week, or year, or at the end of  $27\frac{1}{2}$  weeks, the time for which this suit is instituted. The agreement on the part of the plaintiffs is, that the defendants

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Syllabus.

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shall use their machine for a certain time, in consideration of which defendants are to pay a certain sum of money. It is true, the exact sum is not stated; but the mode of rendering it certain is fully set forth. It is one entire contract, which cannot be divided into a thousand, as the plaintiffs imagine. If the defendants had agreed to pay by installments at the end of every week, or twenty-seven weeks, doubtless the plaintiffs could have sustained an action for the breach of each promise, as the breaches successively occurred. But it is a well-settled principle of law, that "unless there be some express stipulation to the contrary, whenever an entire sum is to be paid for the entire work, the performance or service is a condition precedent; being one consideration and one debt, it cannot be divided." It was error, therefore, to instruct the jury that the plaintiffs were entitled to recover on the first count, if their machine was used by the defendants, and was beneficial to them, without regard to the fact of the rescission, or continuance, or fulfillment of the contract on the part of the plaintiffs.

Whether, if there had been a count in the declaration for the \$242, and the jury had believed that the defendants had agreed to pay it as soon as it was earned, the plaintiffs might not recover to that amount, or whether such a construction could be put on the contract as proved, are questions not before us, and on which we therefore give no opinion.

The judgment of the Circuit Court must therefore be reversed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Columbia, holden in and for the county of Washington, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs, and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

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CHARLES J. GAYLER AND LEONARD BROWN, PLAINTIFFS IN ERROR,  
v. BENJAMIN G. WILDER.

(10 Howard, 477.)

1. An assignment of a patent-right, made and recorded in the Patent Office before the patent issued, which purported to convey to the assignee all the inchoate right which the assignor then possessed, as well as the legal title

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- which he was about to obtain, was sufficient to transfer the right to the assignee, although a patent afterwards was issued to the assignor.
2. When an assignment is made, under the fourteenth section of the act of 1836, of the exclusive right within a specified part of the country, the assignee may sue in his own name, provided the assignment be of the entire and unqualified monopoly. But any assignment short of this is a mere license, and will not carry with it a right to the assignee to sue in his own name.
  3. Therefore, an agreement that the assignee might make and vend the article within certain specified limits, upon paying to the assignor a cent per pound, reserving, however, to the assignor the right to establish a manufactory of the article upon paying to the assignee a cent per pound, was only a license; and a suit for an infringement of the patent-right must be conducted in the name of the assignor.
  4. Where a person had made and used an article similar to the one which was afterwards patented, but had not made his discovery public, using it simply for his own private purpose, and without having tested it so as to discover its usefulness, and it had then been finally forgotten or abandoned, such prior invention and use did not preclude a subsequent inventor from taking out a patent.
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THIS was a writ of error to the Circuit Court of the United States for the Southern District of New York.

The defendant in error, who was plaintiff in the court below, brought an action against Gayler and Brown, the plaintiffs in error, for an alleged infringement of a patent-right for the use of plaster of Paris in the construction of fire-proof chests.

In the declaration, it was averred that one Daniel Fitzgerald was the original and first inventor of a new and useful improvement in fire-proof chests or safes, and that letters patent were granted him therefor, bearing date the 1st day of June, 1843. The patent was in the usual form, and was set out in the declaration, the specification annexed to which was as follows:

“To all whom it may concern: Be it known, that I, Daniel Fitzgerald, of the city, county, and State of New York, and a citizen of the United States, have discovered and made an improvement, new and useful, in the construction of iron chests or safes, intended to resist the action of fire, and for the safe-keeping and preserving books and papers, and other valuables, from destruction by fire, which I call a Salamander safe or chest.

“The following is a full and exact description of the safe or chest, with my improvement combined therewith:

“I make two iron chests, in the common and ordinary way of making iron chests, which is well known to those engaged in this branch of business, one smaller than the other, which, when the safe is put together, forms the inner chest, or inner part of the safe. The

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other chest is made about three inches larger than the inner one, and so as, when put together, it will form the outer part or crust of the safe, and leave a space between the inner and outer chests of the safe of about three inches, which space may vary a little, more or less, when the chests are put together, but should be the same all round and in every direction. The inner and outer doors, where two doors are used, are prepared in the same way, leaving a space, as above, between the inner and outer crust of each door, which space is left for a like purpose with that left between the inner and outer chest of the safe. Where one door is used, it should be made in the same manner, leaving a like space between the inner and outer crust or face of the door, and for a like purpose, and should be fitted to the chest or safe with great accuracy. The edges and openings for the doors are to be neatly finished, as in other chests. I then take plaster of Paris or gypsum, and, having boiled it or baked it in an oven, and calcined it, and reduced it to a powder, I mix it with water till it is about the consistency of cream or thin paste, so fluid as that it may readily be poured into the space left as above to receive it, and I then fill all the space with the plaster of Paris, putting in some sheets of mica between the inner and outer chest, to aid, if necessary, in checking the progress of the heat.

“But where pains are taken to have all the space left for the purpose properly filled with the plaster of Paris, as above, so that when set it will expand and adhere firmly to the surrounding parts, and completely fill the whole space, and all the cracks and joints, the mica may be dispensed with, and every other substance, and the plaster may be used alone. It may also be reduced to a powder, without being prepared as above, and used in that state; but I have not found it as good.

“The inner case or chest may be made of wood instead of iron, as for a book-case, and if the space left between that and the outer chest be filled in the manner and with the materials above named, it will make a very durable safe, that will effectually resist the fire, as I have found by experience; but the safe may not be so strong or durable, though somewhat cheaper.

“The above composition or preparation of gypsum may be mixed with several other articles not contrary to its nature, with a view to increase its efficacy in resisting the action of fire; but, from my experience, I doubt if they have much effect. The gypsum alone, when properly prepared and properly placed in the space left to receive it, and made to fill it completely, is quite sufficient to resist, for a long space of time, the most intense heat. The chemical properties of

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this article are such, that, by the application of intense heat, it imparts a vapor or gas, or some other properties, which effectually stay the progress of the fire, and arrest the influence and effects of the heat. This I have ascertained by various experiments; and I believe I am the first man that discovered the utility and devised the method of applying gypsum, or plaster of Paris, to increase the safety of an iron chest. I am not aware that this article was ever used for the purposes above set forth, until I used it in the manner above described.

"I therefore claim, as my discovery and invention and improvement, the application and use of plaster of Paris, or gypsum, in its raw state, or prepared as above, either alone or with mica, in the construction of all iron chests or safes, in the manner above described, or in any other manner substantially the same.

"DANIEL FITZGERALD.

"Witnesses: G. H. PATTERSON, BEVERLEY R. HENSON, JR."

It was also averred in the declaration, that before the date of said letters patent, to wit, on the 7th day of April, 1839, the said Daniel Fitzgerald made an assignment, which was duly recorded in the Patent Office of the United States, on the 1st day of June, 1839, as follows:

"Whereas I, Daniel Fitzgerald, of the city, county, and State of New York, have invented certain improvements in safes, which invention I call the 'Salamander safe,' for which I am about to make application for letters patent of the United States; and whereas E. Wilder, of New York aforesaid, has agreed to purchase from me all right and title and interest which I have, or may have, in and to the said invention, in consequence of the grant of letters patent therefor, and has paid to me, the said Fitzgerald, the sum of five thousand dollars, the receipt whereof is hereby acknowledged:

"Now, this indenture witnesseth, that, for and in consideration of the said sum to me paid, I have assigned and transferred to E. Wilder aforesaid the full and exclusive right to all the improvements made by me, as fully set forth and described in the specification which I have prepared and executed preparatory to obtaining letters patent therefor. And I hereby authorize and request the Commissioner of Patents to issue the said letters patent to the said E. Wilder and his legal representatives.

"In testimony whereof, I have hereunto set my hand and affixed my seal, this 11th day of April, 1839.

"DANIEL FITZGERALD. [SEAL.]

"Witnesses: OWEN G. WARREN, CHARLES H. FOSTER."



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The declaration then proceeded as follows:

“And the said plaintiff further saith, that the said Enos Wilder, in his lifetime, after the making of the said assignment by the said Daniel Fitzgerald to the said Enos Wilder as aforementioned, and before the committing of the several grievances hereinafter mentioned, to wit, on the first day of September, in the year of our Lord 1843, and within the Southern District of New York aforesaid, did execute a certain instrument or agreement to the said plaintiff, whereby the said Enos Wilder, in consideration of the agreement made with the said plaintiff, and of one dollar to him, the said Enos Wilder, in hand paid by the said plaintiff, bargained, sold, conveyed, and assigned to the said plaintiff all the right, title, and interest of him, the said Enos Wilder, in and unto the patent granted to the said Daniel Fitzgerald for an improvement in fire-proof safes and chests, by the use of prepared gypsum, dated June 1, 1843; and of which patent he, the said Enos Wilder, was the sole owner and assignee, as will appear by the records of the Patent Office; and which patent he, the said Enos Wilder, had good right to sell and convey to the said plaintiff, to be by him, the said plaintiff, held as his own property, free from all claims from the said Enos Wilder, or any one claiming under him, the said Enos Wilder, as by the said instrument or agreement, sealed with the seal of the said Enos Wilder, ready in court to be produced, will, reference thereunto being had, fully and at large appear.”

This last-mentioned instrument was averred to have been recorded in the Patent Office of the United States on the 10th day of October, 1843.

It was then averred, that, by virtue of the last-mentioned instrument, plaintiff became, and ever since hath been, sole owner of said improvement, &c., yet, the defendants well knowing, &c.

The defendants pleaded the general issue, and gave notice that they would offer evidence that Daniel Fitzgerald was not the first and original inventor of the improvement patented.

The bill of exceptions was as follows:

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Be it remembered, that, on the trial of the aforesaid issue, the plaintiff, to maintain the same, after having read said patent in evidence as set forth in the declaration, read the following conveyance and agreement, which was duly recorded, and a copy of which was, at the date of said patent, indorsed on the same, viz.:

[Here was inserted the conveyance from Fitzgerald to Enos Wilder of the 11th of April, 1839, already set out in full in the declaration.]

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Statement of the case.

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And thereupon the defendants insisted that said instrument did not convey the legal title of said patent to the said Enos Wilder, and that, upon such conveyance, he could not have brought a suit on the same; but said court decided that said instrument operated to convey the interest in said patent to said Enos Wilder, so that during his life he could have maintained an action at law on the same—to which opinion of said court the counsel for the defendants then and there excepted.

*First Exception.*—And the plaintiff then read the conveyance from said Enos Wilder to him, as stated in his said declaration, which he insisted made out a right in him to sustain his aforesaid action; but the defendants, to show that, after the date of the conveyance to the plaintiff, and before he commenced this action, he made, executed, and delivered to Silas C. Herring, Esq., the following agreement and conveyance, namely:

“Benjamin G. Wilder agrees with Silas C. Herring to grant to him the sole and exclusive right to make the safe called the Salamander safe, according to the terms and upon the plan pointed out and described in the patent and specification of Daniel Fitzgerald, which patent is dated June 1, 1843, and was assigned to Enos Wilder, and by him to Benjamin G. Wilder, who now owns the same; and this license is to be for the city, county, and State of New York; and said Herring is to have and enjoy the full and exclusive right to make and vend said safes in the city, county, and State of New York, and nowhere else; the said Herring is to have the same for the residue of the unexpired term of said patent, with all the improvements which may be made in the manufacture of said safes which said B. G. Wilder may have a right to use during said term; and said Herring agrees that said Wilder may use all the improvements which he may make, or have a right to use, during said term. In consideration whereof, said Herring agrees with said Benjamin G. Wilder to pay to him, for the use of the right aforesaid, one cent a pound for each and every pound said safes may weigh when finished and sold, which sum is to be paid monthly so long as said patent remains in full force, and until the same has been set aside by the highest court of the United States to which the same may be carried; but said Herring agrees to pay the one cent a pound for the space of two years, at all events, and whether said patent shall be declared good or not. If sustained, then said Herring is to pay as aforesaid for the full term as aforesaid. All the safes so made and sold by said Herring are to have said Wilder's patent marked thereon, the same as heretofore,

## Statement of the case.

in a plate or cast in letters, 'Wilder's patent safe.' Said Herring agrees to keep an accurate account of all the safes by him made, or caused to be made, under said contract and patent, with the weight of each when sold, and the names of the persons to whom sold, and their places of abode, and to render said account monthly, if so often called on for it, and to pay accordingly. Said Herring is to manufacture all the safes he may sell, or offer to sell, under and according to said patent, with such improvements as he may have a right to use, and be marked as above with the words, in large, legible letters, 'Wilder's patent safe.' Said Wilder reserves to himself the right to manufacture, in this city and State of New York, or elsewhere, safes to sell out of this State and city; but if sold within this State or city, then said Wilder is to pay said Herring one cent a pound on each safe so made and sold within this city or State. Said Wilder is not himself to set up or establish, nor authorize any one else to set up and establish, any manufactory or works for making Salamander safes, or safes similar to said Salamander safes, at any place within fifty miles of this city. Said Herring is to make all safes like Wilder's, and not vary in any substantial part therefrom, with such improvements as may be added.

"In presence of S. P. Staples, witness to both signatures.

"NEW YORK, *January 6, 1844.*

"If said patent should not be decided to be good till the end of three years, then for the time over the two years, till decided good, said Herring pays nothing. It is further understood and agreed, that all safes made by said Herring, or in the making of which, or the selling thereof, he shall in any way be directly or indirectly concerned, consisting of a double case or box, with the intermediate space filled with plaster or any non-conducting substance, shall be considered within this agreement, and be paid accordingly.

"B. G. WILDER.

"SILAS C. HERRING."

"(Received and recorded 30th January, 1844.)"

*Second Exception.*—And thereupon the defendants insisted that the plaintiff had parted with all his interest in said patent by virtue of said agreement, so that he could not sustain his aforesaid action. But said court decided that the plaintiff had not, in and by said agreement, so far parted with his interest in said patent as to deprive him of the right to sustain his aforesaid action—to which opinion of said court the defendants did then and there except.

*Third Exception.*—And the defendants then and there objected, that the invention and improvement set forth and claimed in said patent as the invention of the patentee, was not the subject of a patent; that it was the mere application of an old, well-known material to a new purpose, which they insisted could not be the subject of a patent. But said court overruled said objection, and instructed the jury as herein set forth—to which, as well as to the said instructions to said jury, the defendants excepted.

And the plaintiff, to maintain his aforesaid issue, called sundry witnesses to prove, and claimed that he had proved, that he made the discovery which was the foundation of his invention and improvement as early as some time in the year 1830; that he made experiments in various ways, to test the utility of his discovery and improvement, at different times, in the different years from 1830 to 1836, when, he applied for his patent; and that he pursued with due diligence that application until he obtained his aforesaid patent; and that the delay which had arisen in obtaining said patent was not caused by the fault or negligence of the patentee, or his assignee, Enos Wilder, nor any one else, but arose from the burning of the Patent Office, and other causes not under the control of the applicants for the patent; and that the defendants had infringed said patent, as set forth in said declaration.

And the defendants introduced evidence to prove, and claimed that they had proved, that said Daniel Fitzgerald was not the first and original inventor of what he claimed in said patent as his improvement. Among other witnesses, James Conner testified, that, between 1829 and 1832, he was engaged in business as a stereotype founder, and, knowing that plaster of Paris was a non-conductor of heat, he constructed a safe with a double chest, and filled the space between the inner and outer one with plaster of Paris,—the same, substantially, as testified to and claimed by Fitzgerald, except there was no plaster used on the top of the safe. It was made for his own private use in his establishment, and was used by him as a safe from the time it was made till 1838, when it passed into other hands. It was kept in his counting-room while he used it, and known to the persons working in the foundry.

This testimony was confirmed by his brother, John Conner, except that he fixes the time of constructing the safe in the year 1831 or 1832. But one safe was made by Conner, and since it passed out of his hands he has used others of a different construction.

The defendants also claimed, that if said Daniel Fitzgerald was the first and original inventor of said improvement, as he claimed, yet

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Statement of the case.

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that he had made said iron safes, and sold them, under such circumstances as that he had thereby abandoned the same, and suffered the same to go into public use in such manner as to lose all right to said invention and improvement, if any he ever had.

And the court thereupon instructed the jury, that if they found that Daniel Fitzgerald, the patentee, was the first and original inventor of the said improvement claimed in said patent, and that the use of plaster of Paris, in combination with and in the construction of an iron safe, is new and useful, as in the specification of said patent is set forth and claimed, then they would find that the patent was valid, and protected the invention and improvement as claimed, unless the plaintiff, or those under whom he claimed, had abandoned said improvement to the public, and suffered the same to go into public use before the application for said patent, of which facts the jurors were the judges.

And said court further instructed said jury, that if they found that the use made by James Conner of plaster of Paris was confined to a single iron chest, made for his own private use, after said Fitzgerald's discovery and experiments, then it was not in the way of Fitzgerald's patent, and the same was valid; but if the jury found that said James Conner made his said safe, as claimed, and tested it by experiments before Fitzgerald's invention and improvement, and before he tested the same, then said Fitzgerald was not the first inventor, as claimed, and was not entitled to said patent.

The court further charged, that, independently of these considerations, there was another view of the case, as it respected the Conner safe: that it was a question whether the use of it by him had been such as would prevent another inventor from taking out a patent; that if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not the first, inventor or discoverer of the improvement.

*Fourth Exception.*—And said court, in summing up said case to said jury, further instructed them, that if they found that Daniel Fitzgerald was the first and original inventor of said improvement, as set forth in said patent, and had not abandoned or dedicated the same to the public, but had, with reasonable diligence, pursued his invention till he had perfected the same, and used due diligence in applying for and in pursuing his application for a patent, until he obtained

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Argument for the plaintiffs in error.

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the same, and if they found the defendants had made and sold safes, as charged in the plaintiff's declaration, then they would find their verdict for the plaintiff for such actual damages as they judged just and reasonable; but if they found otherwise, then they would find for the defendants. To each and all of these instructions given to the jury, the counsel for the defendants excepted.

And forasmuch as the facts aforesaid, and the decisions of the court thereon, do not appear of record, the defendants pray that this their bill of exceptions may be allowed.

Filed 23d February, 1848.

S. NELSON. [SEAL.]

The cause was argued by *Mr. Cuyler*, for the plaintiffs in error, and by *Mr. Staples* and *Mr. Webster*, for the defendant in error.

*Mr. Cuyler, for plaintiffs in error.*

1. The second error assigned is, that the learned judge erred in ruling that the conveyance of April 11th, 1839, by Fitzgerald to Enos Wilder, of the invention for which he was about to seek a patent, operated to convey said patent to Enos Wilder, so that in his lifetime he could have maintained thereon an action in his own name.

This conveyance is dated April 11th, 1839. The patent did not issue until 1843, and then it issued to Fitzgerald, the inventor, and not to Enos Wilder, the transferee.

It will be readily conceded that the right of an assignee to sue in his own name must, if it exist, be *statutory*. But no section of any Patent Law in force bestows this right upon the assignee of an improvement about to be patented, such as was Enos Wilder.

The act of 1793 says every "*invention*" shall be assignable. The eleventh section of the act of 1836 provides that "every patent shall be assignable in law," etc. It speaks of the "exclusive right under any patent," and of "the thing patented." Yet here there was no patent. The assignment is of an improvement intended to be patented. The patent did not exist until four years afterwards, and then it issued to the inventor, and not to the assignee of the improvement.

The sixth section of the act of 1837 provides for this very case, by permitting the issuing of the patent, in such cases, directly to the assignee of the improvement. Which should have been, but was not, done in this instance.

As no statute, therefore, creates a right in the assignee of an unpatented improvement to sue in his own name, it is submitted that Enos Wilder was an equitable, but not a legal, holder of the title to

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Argument for the plaintiffs in error.

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this patent, and that the learned judge erred in his ruling on this point.

2. The third error assigned is, "that the learned judge erred in ruling that the agreement of B. G. Wilder and Silas C. Herring, dated January 6, 1844, did not divest the said B. G. Wilder of all his interest in the patent, so far as the State of New York was concerned, and that the plaintiff could thereafter maintain his action."

By its terms, it expressly divests the plaintiff, for the remainder of the time of the patent, of all interest in said patent, so far as the city, county, and State of New York are concerned, and imposes upon the plaintiff a penalty to prevent the exercise of any rights by him under said patent in that State.

How, then, can damage be alleged, where the right said to be invaded has no existence? Or, rather, how can the plaintiff suffer damage by the invasion of a right, the whole property in which has been passed by him to another?

The hardship of this doctrine will be more apparent, when it is considered, that if the plaintiff recover, the defendants will not be thereby exonerated from liability to Herring, the local assignee, but may be held accountable to him, and thus be compelled to pay these very damages a second time to another party.

There can be no damage without an injury done to some right possessed by the plaintiff. But here the plaintiff possesses no right. How, then, can he be damaged?

By this agreement, the advantages and profits of the patent in the city and State of New York are the property of Herring; and yet, if the plaintiff recover damages in this action, he will indirectly take to himself those profits, and thus contravene his own agreement. *Herbert v. Adams*, 4 Mason, 15; *Park v. Little*, 3 Wash. C. C., 196, 197.

3. The fifth and sixth errors assigned have relation to the instruction given by the learned judge with regard to the Conner safe.

It is submitted that, by the requirements of the Patent Law, the patentee must be not only *an* original inventor, but *the* original inventor, and that the patent will in all cases be defeated by proof of a prior invention.

It is especially urged, that even if the doctrine of the learned judge, in his charge, were correct, it is inapplicable to a case where the invention had been for eight years in open, notorious public use by the prior inventor at his counting-house, accessible to those in his employ, and then, at the expiration of eight years, and still before even an application for plaintiff's patent had been made, had passed into the possession of others.

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Argument for the plaintiffs in error.

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It is submitted that this is not such a use as leaves it in any respect "a question whether the use made by Conner of the safe constructed by him had been such as would prevent another from taking out a patent."

The Patent Law of 1836, sec. 6, gives its privileges to an inventor whose invention was "not known or used by others before his discovery."

It exacts an oath from an inventor to this effect.

This safe, if Conner's invention be prior, was both known and used before; and nowhere in the act can there be found any qualifying words upon such knowledge or use, or any reservation of circumstances, under which prior knowledge and use will not, if proven, defeat a patent.

The following authorities are in point, premising that the language of the Patent Act of 1793, in relation to the novelty of the invention, is the same as that employed in the act of 1836, namely, "not known or used before."

"The plaintiff cannot object to the originality or priority and use of another machine, alleged to have been similar to his own, on the ground that it had gone into disuse, or was not *notoriously* in use; since it is essential to his case to prove he was the original inventor of the machine for which he has a patent." *Evans v. Hettich*, 3 Wash. C. C.; 408.

Under the sixth section of the Patent Law, if the thing secured by patent had been in use, or had been described in a public work, anterior to the supposed discovery, the patent is void, whether the patentee had a knowledge of this previous use or not. *Evans v. Eaton*, 3 Wheat., 454.

If the original inventor of a machine abandons the use of it, and does not take out a patent for it, no other person can entitle himself to a patent for it. *Evans v. Eaton*, 1 Pet. C. C., 323.

In an action for a violation of a patent granted by the United States for an alleged original invention, the plaintiff must satisfy the jury that he was the original inventor, in relation to every part of the world.

Although no proof was made that the patentee knew that the discovery had been made prior to his, still he could not recover if, in fact, he was not the original inventor. *Dawson v. Follen*, 2 Wash. C. C., 311; *Reutgen v. Kanours*, 1 Wash. C. C., 168; *Whitney v. Emmett*, 1 Bald., 303. Also, Curtis on Patents, sec. 40, note.

The same construction of the act of Congress is given by Judge Story, in *Reed v. Cutter*, 1 Story, 590.



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Argument for the plaintiffs in error.

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After ruling that the applicant must be not only *an* original inventor, but *the* original inventor, he says: "And it is of no consequence whether the invention is extensively known and used, or whether the knowledge and use thereof is limited to a few persons, or even to the first inventor himself, or is kept a secret by him."

And again: "The language of the Patent Act of 1836, page 357, sec. 6, *not known or used, &c.*, does not require that the invention should be known or used by more than one person, but merely indicates that the use should be by some other person than the patentee."

And again: "The decision in Dolland's case may be a correct exposition of the English statute of monopolies, (21 James I.) but is not applicable to the Patent Law of the United States."

4. But there is another view of the case, from this point, which is entitled to consideration.

It is submitted that, measured by the seventh section of the act of 1839, the construction and use of the Conner safe had been such as necessarily and absolutely to defeat the plaintiff's patent, and that the learned judge erred in not thus instructing the jury. (Fifth, sixth, and seventh exceptions.)

That section provides—

"That every person or corporation who has, or shall have, purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor, or to any other person interested in such invention; and no patent shall be held to be invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public; or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent."

In this section, the words "newly-invented machine, manufacture, or composition of matter" have been decided by this court to be synonymous with "invention or thing patented." *Mc Clurg v. Kingsland*, 1 Howard, 202.

Now, it is the distinct and uncontradicted fact, that in this case the invention or thing patented had been "constructed," and was in use by another, at least eight years before the application for a patent. And yet, by the final clause of the section just quoted, if there is proved such use "two years prior to the application for a patent," such "patent shall be held to be invalid."

## Argument for the defendant in error.

It is stated by one witness, that between the years 1829 and 1832, and by another, that in the year 1831 or 1832, Conner made a safe constructed precisely as is the patented safe; that it was used as the safe for his establishment; was kept in his counting-room, and was known to the persons working in his foundry; and so continued to be until 1838, when it passed from Conner's into other hands.

The plaintiff's application for a patent bears date April 11, 1839.

It is submitted, therefore, that this patent cannot be sustained without flatly contravening the clear and express language of the seventh section of the act of 1839, just quoted.

This case is one in which a recovery by the plaintiff below cannot be sustained without imposing great hardships upon the defendants. The patent issued in 1843—more than four years after application for it was made, and more than thirteen years after the applicant had perfected his invention. The very same invention had been made by a stranger at least thirteen, and perhaps fourteen, years before the date of the patent, and had been publicly used by him, with the knowledge of many, for eight years before plaintiff's application for a patent, and had then passed from him into the hands of others.

Such a use for two years, by the seventh section of the act of 1839, defeats a patent.

Added to this, it was in evidence that the plaintiff no longer possessed the right for the invasion of which this action was brought, and the recovery, if had, must be for an injury done, not to him, but to another, in whom the very same cause of action will continue to exist.

*Mr. Staples, contra.*

1. The first question is, whether the conveyance from Fitzgerald to Enos Wilder, before the issuing of the patent, conveyed the patent itself when issued. The error on the other side is in considering an invention as a sort of chose in action. An invention, however, is as much property as a horse or a house, and, when patented, becomes the *exclusive* property of the patentee. It is consequently assignable as well before as after the granting of letters patent. The very terms employed in the eleventh and fourteenth sections of the act of 1836, (5 Stat. at Large, 121, 122,) and which are relied on by the other side as showing that the *patent* only was assignable, show, on the contrary, that reference was not had to anything in the nature of a chose in action, but that the *interest* of the inventor in the thing invented was the subject of assignment. *Herbert v. Adams*, 4 Mason, 15, is to the effect, that a conveyance of an invention operates as a conveyance of

Argument for the defendant in error.

the patent, whether dated before or after the patent. So also Curtis on Patents, secs. 189, 260.

2. The next assignment of error is, that the court did not decide that the agreement of the plaintiff with Silas C. Herring did not divest the former of all interest in the patent, so that he could not thereafter maintain an action thereon. We say not,—because Wilder did not give up *all* his interest, he reserving one cent a pound on all safes made under the patent in the city and State of New York; because he reserved the right to manufacture in the city of New York on the terms named; because the agreement was a mere license; and because it is obvious, from the face of the agreement itself, that Wilder was to bring suits to sustain the patent. *Brooks v. Byam*, 2 Story, 541. The latter part of the agreement with Wilder was equivalent to this, viz.: Wilder sells to Herring the right to manufacture and vend safes within the city, county, and State of New York; but, he reserves to himself the right to make *in* the city safes to be sold *out* of the city. He also reserves the right to make safes to be sold *within* the city, upon payment to Herring of one cent per pound. This shows that Wilder had not sold his entire right, and could therefore maintain this action.

3. As to the Conner safe. The object of the law was to protect genius and at the same time to invite something useful to the country. A prior experiment, locked up in a man's own bosom, not divulged to the public, not rendered useful to the public, is surely not such an invention as will exclude a *bonâ fide* inventor of the same thing from the benefits of the Patent Laws, if he has used diligence in embodying his invention and reducing it to practice. Such, on the contrary, was the very person intended to be benefited. It is not correct to say that an inventor must have been the first man who has ever thought of the subject, or that mere speculations are within the meaning of the act; but he is an inventor under the law who has first put the invention into such a shape as to be useful to the public.

*Mr. Webster*, on the same side.

It is agreed that, under the previously existing laws, the invention would have been assignable. But it is supposed that the act of 1836, which repeals all former laws, only makes the patent assignable, but says nothing of the invention. Now, two things are to be considered. 1st. In a country where the principle of the Patent Laws is recognized, where an *invention* is regarded as property which may be set apart for a person's own exclusive use, is it not assignable, independent of any statute enactment? If not, *why* is it not? What is the *reason* that

## Argument for the plaintiffs in error.

an invention which is recognized as *property* shall not be transferable, like other property, there being nothing in the statute to prohibit it? 2d. Does the language of the eleventh section of the act of 1836 restrict assignability to the patent? I think not. Every other portion of the act has a different aspect.

Wilder has clearly the right to maintain an action, for the reason that he has not parted with all his interest. He still has an interest to the value of one cent per pound. But the agreement itself was a mere license. It uses the term *license*, and does not run to the heirs and assignees.

With regard to the Conner safe, it could not be considered such a prior invention as would take away the right of Fitzgerald to a patent. There are *dicta* in Judge STORY's decision in the case of *Reed v. Cutter*, which, if not limited, would be of dangerous tendency. Now, the instruction objected to supposes an invention to be made, but kept within the inventor's own bosom. The question is, whether an original inventor, (that is, one who did not derive his knowledge from another,) who has put his invention into practice, shall be deprived of his patent by such a mere thought, gendered in another's brain, and to which he "gives no tongue." The object of the Patent Law, and of the Constitution under which the law was passed, was the public benefit. If this be so, how does a man bring himself within its provisions who locks his secret in his own breast? And why is he less a benefactor to the public who invents a machine which had been before invented and afterwards forgotten, than he who invents something never before known?

*Mr. Cuyler*, in reply and conclusion.

It is said that the invention would be assignable, independent of the Patent Law. It is submitted that this is not correct. Except by statute, the inventor has no right of property in his invention. The statute was intended to confer that very right. Now, the act of 1793 gave the right of assigning an *invention*, and yet, with this before them, Congress, in the act of 1836, make only the *patent* assignable. If, then, the patent is made assignable only by the law, how can it be said that the invention does not stand in need of such a provision?

It is said that the plaintiff has reserved one cent per pound, and can therefore maintain this action. It will be seen, however, that this part of the agreement is a penalty. If he, Wilder, makes safes in New York to be sold in New York, he shall pay, &c. A licensee can maintain an action.

The facts as to the Conner safe should have been left to the jury.

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Opinion of the court.

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This was not a case where the invention had been lost or forgotten; but, within a few years, a man makes for his own use, and actually uses in his own counting-house, a safe constructed upon the same principles as that which is the foundation of this suit. The law requires that a patented article should not have been made or used before.

Mr. Chief Justice TANEY delivered the opinion of the court.

Three objections have been taken to the instructions given by the Circuit Court at the trial, and neither of them is, perhaps, entirely free from difficulty.

The first question arises upon the assignment of Fitzgerald to Enos Wilder. The assignment was made and recorded in the Patent Office before the patent issued. It afterwards issued to Fitzgerald. And the plaintiffs in error insist that this assignment did not convey to Wilder the legal right to the monopoly subsequently conferred by the patent, and that the plaintiff who claims under him cannot, therefore, maintain this action.

The inventor of a new and useful improvement certainly has no exclusive right to it until he obtains a patent. This right is created by the patent, and no suit can be maintained by the inventor against any one for using it before the patent is issued. But the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires. Fitzgerald possessed this inchoate right at the time of the assignment. The discovery had been made, and the specification prepared to obtain a patent. And it appears, by the language of the assignment, that it was intended to operate upon the perfect legal title which Fitzgerald then had a lawful right to obtain, as well as upon the imperfect and inchoate interest which he actually possessed. The assignment requests that the patent may issue to the assignee. And there would seem to be no sound reason for defeating the intention of the parties, by restraining the assignment to the latter interest, and compelling them to execute another transfer, unless the act of Congress makes it necessary. The court think it does not. The act of 1836 declares that every patent shall be assignable in law, and that the assignment must be in writing, and recorded within the time specified. But the thing to be assigned is not the mere parchment on which the grant is written. It is the monopoly which the grant confers—the right of property which it creates. And when the party has acquired an inchoate right to it, and the power to make that right perfect and abso-

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lute at his pleasure, the assignment of his whole interest, whether executed before or after the patent issued, is equally within the provisions of the act of Congress.

And we are the less disposed to give it a different construction, because no purpose of justice would be answered by it, and the one we now give was the received construction of the act of 1793 in several of the circuits; and there is no material difference in this respect between the two acts. As long ago as 1825, it was held, by Mr. Justice STORY, that in a case of this kind an action could not be maintained in the name of the patentee, but must be brought by the assignee. 4 Mason, 15. We understand the same rule has prevailed in other circuits; and if it were now changed, it might produce much injustice to assignees who have relied on such assignments, and defeat pending suits, brought upon the faith of long-established judicial practice and judicial decision. Fitzgerald sets up no claim against the assignment, and to require another to complete the transfer would be mere form. We do not think the act of Congress requires it; but that, when the patent issued to him, the legal right to the monopoly and property it created was, by operation of the assignment then on record, vested in Enos Wilder.

The next question is upon the agreement between the defendant in error and Herring. Is this instrument an assignment to Herring for the State or city of New York, upon which he might have sued in his own name? If it is, then this action cannot be maintained by the defendant in error.

Now, the monopoly granted to the patentee is for one entire thing; it is the exclusive right of making, using, and vending to others to be used the improvement he has invented, and for which the patent is granted. The monopoly did not exist at common law, and the rights, therefore, which may be exercised under it cannot be regulated by the rules of the common law. It is created by the act of Congress; and no rights can be acquired in it unless authorized by statute, and in the manner the statute prescribes.

By the eleventh section of the act of 1836, the patentee may assign his whole interest, or an undivided part of it. But if he assigns a part under this section, it must be an undivided portion of his entire interest under the patent, placing the assignee upon an equal footing with himself for the part assigned. Upon such an assignment, the patentee and his assignees become joint owners of the whole interest secured by the patent, according to the respective proportions which the assignment creates.

By the fourteenth section, the patentee may assign his exclusive

## Opinion of the court.

right within and throughout a specified part of the United States, and upon such an assignment the assignee may sue in his own name for an infringement of his rights. But in order to enable him to sue, the assignment must undoubtedly convey to him the entire and unqualified monopoly which the patentee held in the territory specified,—excluding the patentee himself as well as others. And any assignment short of this is a mere license; for it was obviously not the intention of the legislature to permit several monopolies to be made out of one, and divided among different persons within the same limits. Such a division would inevitably lead to fraudulent impositions upon persons who desired to purchase the use of the improvement, and would subject a party who, under a mistake as to his rights, used the invention without authority, to be harassed by a multiplicity of suits instead of one, and two successive recoveries of damages by different persons holding different portions of the patent-right in the same place. Unquestionably, a contract for the purchase of any portion of the patent-right may be good as between the parties as a license, and enforced as such in the courts of justice. But the legal right in the monopoly remains in the patentee, and he alone can maintain an action against a third party who commits an infringement upon it. This is the view taken of the subject in the case of *Blanchard v. Eldridge*, J. W. Wallace, 337, and we think it the true one.

Applying these principles to the case before us, the action was properly brought by the plaintiff below, and could not have been maintained by Herring.

The agreement is singularly confused and complicated. It purports to grant to Herring the exclusive right to make and vend the Salamander safe in the city, county, and State of New York; and Herring agrees to pay to the defendant in error a cent a pound for every pound the safes might weigh, to be paid monthly. But, at the same time, it reserves to Wilder the right to set up a manufactory or works for making these safes in the State of New York, provided it is not within fifty miles of the city, and to sell them in the State of New York, paying to Herring a cent a pound on each safe so sold within the State.

It is evident that this agreement is not an assignment of an undivided interest in the whole patent, nor the assignment of an exclusive right to the entire monopoly in the State or city of New York. It is therefore to be regarded as a license only, and, under the act of Congress, does not enable Herring to maintain an action for an infringement of the patent-right. The defendant in error continues the legal owner of the monopoly created by the patent.

The remaining question is upon the validity of the patent on which the suit was brought.

It appears that James Conner, who carried on the business of a stereotype founder in the city of New York, made a safe for his own use between the years 1829 and 1832, for the protection of his papers against fire; and continued to use it until 1838, when it passed into other hands. It was kept in his counting-room, and known to the persons engaged in the foundry; and after it passed out of his hands, he used others of a different construction.

It does not appear what became of this safe afterwards. And there is nothing in the testimony from which it can be inferred that its mode of construction was known to the person into whose possession it fell, or that any value was attached to it as a place of security for papers against fire, or that it was ever used for that purpose.

Upon these facts, the court instructed the jury, "that if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald or those claiming under him, if he be an original, though not the first, inventor or discoverer."

The instruction assumes that the jury might find from the evidence that Conner's safe was substantially the same with that of Fitzgerald, and also prior in time. And if the fact was so, the question then was, whether the patentee was "the original and first inventor or discoverer," within the meaning of the act of Congress.

The act of 1836, ch. 357, sec. 6, authorizes a patent where the party has discovered or invented a new and useful improvement, "not known or used by others before his discovery or invention." And the fifteenth section provides, that if it appear on the trial of an action brought for the infringement of a patent that the patentee "was not the original and first inventor or discoverer of the thing patented," the verdict shall be for the defendant.

Upon a literal construction of these particular words, the patentee in this case certainly was not the original and first inventor or discoverer, if the Conner safe was the same with his, and preceded his discovery.

But we do not think that this construction would carry into effect the intention of the legislature. It is not by detached words and phrases that a statute ought to be expounded. The whole act must be taken together, and a fair interpretation given to it, neither extending nor restricting it beyond the legitimate import of its language and its obvious policy and object. And in the fifteenth section, after



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making the provision above mentioned, there is a further provision, that if it shall appear that the patentee, at the time of his application for the patent, believed himself to be the first inventor, the patent shall not be void on account of the invention or discovery having been known or used in any foreign country, it not appearing that it had been before patented or described in any printed publication.

In the case thus provided for, the party who invents is not, strictly speaking, the first and original inventor. The law assumes that the improvement may have been known and used before his discovery. Yet his patent is valid if he discovered it by the efforts of his own genius, and believed himself to be the original inventor. The clause in question qualifies the words before used, and shows that by knowledge and use, the legislature meant knowledge and use existing in a manner accessible to the public. If the foreign invention had been printed or patented, it was already given to the world and open to the people of this country, as well as of others, upon reasonable inquiry. They would therefore derive no advantage from the invention here. It would confer no benefit upon the community, and the inventor therefore is not considered to be entitled to the reward. But if the foreign discovery is not patented, nor described in any printed publication, it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach; and, as far as their interest is concerned, it would be the same thing as if the improvement had never been discovered. It is the inventor here that brings it to them, and places it in their possession. And as he does this by the effort of his own genius, the law regards him as the first and original inventor, and protects his patent, although the improvement had in fact been invented before, and used by others.

So, too, as to the lost arts. It is well known, that centuries ago discoveries were made in certain arts, the fruits of which have come down to us, but the means by which the work was accomplished are at this day unknown. The knowledge has been lost for ages. Yet it would hardly be doubted, if any one now discovered an art thus lost, and it was a useful improvement, that, upon a fair construction of the act of Congress, he would be entitled to a patent. Yet he would not, literally, be the first and original inventor. But he would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention.

Upon the same principle and upon the same rule of construction, we think that Fitzgerald must be regarded as the first and original

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inventor of the safe in question. The case as to this point admits, that although Conner's safe had been kept and used for years, yet no test had been applied to it, and its capacity for resisting heat was not known; there was no evidence to show that any particular value was attached to it after it passed from his possession, or that it was ever afterwards used as a place of security for papers; and it appeared that he himself did not attempt to make another like the one he is supposed to have invented, but used a different one. And upon this state of the evidence, the court put it to the jury to say, whether this safe had been finally forgotten or abandoned before Fitzgerald's invention, and whether he was the original inventor of the safe for which he obtained the patent; directing them, if they found these two facts, that their verdict must be for the plaintiff. We think there is no error in this instruction. For if the Conner safe had passed away from the memory of Conner himself, and of those who had seen it, and the safe itself had disappeared, the knowledge of the improvement was as completely lost as if it had never been discovered. The public could derive no benefit from it until it was discovered by another inventor. And if Fitzgerald made his discovery by his own efforts, without any knowledge of Conner's, he invented an improvement that was then new, and at that time unknown; and it was not the less new and unknown because Conner's safe was recalled to his memory by the success of Fitzgerald's.

We do not understand the Circuit Court to have said that the omission of Conner to try the value of his safe by proper test would deprive it of its priority; nor his omission to bring it into public use. He might have omitted both, and also abandoned its use, and been ignorant of the extent of its value; yet, if it was the same with Fitzgerald's, the latter would not upon such grounds be entitled to a patent, provided Conner's safe and its mode of construction were still in the memory of Conner before they were recalled by Fitzgerald's patent.

The circumstances above mentioned, referred to in the opinion of the Circuit Court, appear to have been introduced as evidence tending to prove that the Conner safe might have been finally forgotten, and upon which this hypothetical instruction was given. Whether this evidence was sufficient for that purpose or not, was a question for the jury, and the court left it to them. And if the jury found the fact to be so, and that Fitzgerald again discovered it, we regard him as standing upon the same ground with the discoverer of a lost art, or an unpatented and unpublished foreign invention, and, like him, entitled to a patent; for there was no existing and living knowledge

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of this improvement, or of its former use, at the time he made the discovery; and whatever benefit any individual may derive from it in the safety of his papers, he owes entirely to the genius and exertions of Fitzgerald.

Upon the whole, therefore, we think there is no error in the opinion of the Circuit Court, and the judgment is therefore affirmed.

Mr. Justice McLEAN.

I dissent from the opinion of a majority of the judges in this case. The point of difference, I think, is essential to the maintenance of the rights of the public and also of inventors.

It was proved by James Conner, as appears from the bill of exceptions, "that between 1829 and 1832 he was engaged in business as a stereotype founder, and, knowing that plaster of Paris was a non-conductor of heat, he constructed a safe with a double chest, and filled the space between the inner and outer one with plaster of Paris; the same substantially as testified to and claimed by Fitzgerald, except there was no plaster used on the top of the safe. It was made for his own private use in his establishment, and was used by him as a safe from the time it was made till 1838, when it passed into other hands. It was kept in the counting-room while he used it, and was known to the persons working in the foundry." This evidence was confirmed by another witness.

By the sixth section of the Patent Act of 1836, it is provided, "that any person or persons having discovered or invented any new or useful art, machine, manufacture, or composition of matter, or any new or useful improvement on any art, machine, manufacture, or composition of matter, *not known or used by others before his or their discovery or invention thereof*," may apply for a patent, &c. The applicant is required to "*make oath or affirmation that he does verily believe that he is the original and first inventor*," &c., "*and that he does not know or believe that the same was ever before known or used*."

The seventh section authorizes and requires the Commissioner of Patents "to make or cause to be made an examination of the alleged new invention or discovery; and if on such examination it shall not appear to the Commissioner that the same had been *invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country*," &c., the Commissioner may grant a patent.

In the fifteenth section, it is provided, "that whenever it shall satisfactorily appear that the patentee, at the time of making his

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application for the patent, believed himself to be the first inventor or discoverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been before known or used *in any foreign country*, it not appearing that the same or any substantial part thereof had before been patented or described in any printed publication."

From the above extracts, it is seen that the patentee must be the inventor of the machine, or the improvement of it, or he can have no right. If the thing was known or used by others, he cannot claim a patent. Or if it was patented in a foreign country, or described in any publication at home or in any foreign country, he has no right to a patent. To this there is only the exception in the fifteenth section, above cited. But this can have no influence in the present case.

Let these provisions of the statute be compared with the last two paragraphs of the charge of the court, as stated in the third exception :

"And said court further instructed the jury, that if they found that the use made by James Conner of plaster of Paris was confined to a single iron chest, made for his own private use after said Fitzgerald's discovery and experiments, then it was not in the way of Fitzgerald's patent, and the same was valid; but if the jury found that said James Conner made his said safe, as claimed, *and tested it by experiments*, before Fitzgerald's invention and improvement, *and before he tested the same*, then said Fitzgerald was not the first inventor, as claimed, and was not entitled to said patent."

This charge stands disconnected with any other facts in the case, except those named, and, in my judgment, it is erroneous. If Conner's safe was identical with Fitzgerald's, and though it was of prior invention, *yet if it were not tested by experiments* before Fitzgerald's improvement, and before he tested the same, the jury, under the instruction, were bound to find for Fitzgerald. And the case was thus made to turn, not on the priority of invention only, but upon that *and the fact of its having been tested by experiments*. This introduces a new principle into the Patent Law. The right under the law depends upon the time of the invention. An experimental test may show the value of the thing invented, but it is no part of the invention.

"The court further charged, that, independently of these considerations, there was another view of the case, as it respected the Conner safe; that it was a question whether the use of it by him had been such as would prevent another inventor from taking out a patent; that if Conner had not made his discovery public, but had used it simply for his own private purpose, and it had been finally forgotten

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or abandoned, such a discovery and use would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not the first, inventor or discoverer of the improvement."

If there be anything clear in the Patent Law, it is that the original inventor means the first inventor, subject only to the provision stated in the fifteenth section. This instruction presupposes that the safes are the same in principle.\* Now, if the invention was patented abroad, or was described in a foreign publication, both of which were unknown to the inventor in this country, still his patent is void. So it is void if such invention has been known to any person in this country. The instruction says, if Conner's invention "had been forgotten or abandoned," it was no obstacle to Fitzgerald's right. Can a thing be forgotten or abandoned that never was known? If known before Fitzgerald's invention, it is fatal to it. By whom must it have been forgotten? By the inventor or the public, or both? And how must it have been abandoned? When an invention is abandoned, it is said to be given up to the public; and this is the sense in which the term *abandonment* is used in the Patent Law. Such an abandonment would be fatal to the right of Fitzgerald.

Conner's safe, as appears from the bill of exceptions, was used in his counting-house, being accessible to every one, some six or eight years. In 1838, it passed into other hands; but into whose hands it does not appear. In 1843, Fitzgerald obtained his patent. How long before that, he made experiments to test the invention, is not proved. At most, the time must have been less than five years. This is a short period on which to found a presumption of forgetfulness. The law authorizes no such presumption. It can never become the law. It is not founded on probability or reason. The question is, was Conner's invention prior to that of Fitzgerald? That it was of older date, by some ten or twelve years, is proved. And the instruction, it must be observed, was founded on the supposition that both inventions were similar.

The instruction seems to attach great importance to the fact that Conner's safe was used only for his private purpose. This is of no importance. The invention is the question, and not the manner in which the inventor used it. The safe was constructed at the foundry, and must have been known to the hands there employed. How can it be ascertained that Fitzgerald was not informed by some of these hands of the structure of Conner's safe, or by some one of the many hundreds who had seen it in his counting-house in the city of New York? It was to guard against this, which is rarely if ever suscep-

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tible of proof, that the act is express,—*if the thing patented was known before*, the patent is void. If the fact of this knowledge in any one be established, it is immaterial whether the patentee may have known it or not, it avoids his patent.

The law on this subject is not founded upon any supposed notions of equity. A foreign patent for the same thing, or a description of the thing in a foreign publication, is as effectual to avoid the patent as if the patentee had seen the prior invention. Notice to him is not important. The law is adopted on a settled public policy, which, while it is just to inventors, protects the rights of the public. Any other basis would open the door to endless frauds, by pretended inventors, without the probability of detection. And especially does this new doctrine of forgetfulness or abandonment, used in any other sense than as recognized in the Patent Law, leaving such matters to a jury, overturn what I consider to be the settled law on this subject. Of the same character, is the fact that the invention was used for private purposes. A thing may be used in that way, and at the same time be public, as was the case with the Conner safe; and yet the jury are necessarily misled by such an instruction.

Mr. Justice DANIEL, dissenting.

Differing from the majority in the decision just pronounced, I proceed to state the grounds on which my dissent from that decision is founded.

On two essential points in this cause, it seems to me that the learned justice who tried it at the circuit has erred, and that the decision here should therefore have been for a reversal of his judgment. Those points involve, first, the right of the plaintiff below to maintain his action upon the title or right of action deduced from Fitzgerald through Enos and Benjamin Wilder; and, secondly, a right to or interest in the subject of the suit on the part of the plaintiff below, admitting that subject to have been originally invented and used by some other person than Fitzgerald,—a right founded upon an assumption that this subject had been used in *private only*, or had, in the language of the learned justice, been “finally forgotten or abandoned” by such first inventor. These points are presented by the first and third exceptions of the plaintiffs in error to the rulings at the trial below. The plaintiff in the Circuit Court claimed by assignment from B. G. Wilder, assignee of Enos Wilder, assignee of Daniel Fitzgerald, alleged to have been the inventor of the Salamander safe. By the paper deduction of title, it appears that on the 11th day of April, 1839, Fitzgerald, alleging that he had invented an

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improvement called the Salamander safe, for which he was about to apply for letters patent, for the consideration of five thousand dollars, sold the interest he then had, or might thereafter have, in this invention, to Enos Wilder; that Enos Wilder, on the 1st day of September, 1843, for the consideration of one dollar, assigned and transferred to the plaintiff all the right, title, and interest which he had derived from Fitzgerald under the agreement of the 11th of April, 1839; that no patent issued for this Salamander safe until the year 1843, when a patent was granted to *Daniel Fitzgerald*, as the original inventor; that no patent for his invention has ever been granted either to Enos or B. G. Wilder, either as inventor or assignee of this safe; that the title, whatever it may be, rests upon the agreement between Fitzgerald and Enos Wilder, of the 11th of April, 1839, before the patent to the former.

It must be recollected, that this is an action *at law*; and in order to maintain it, the plaintiff was bound to set out and to prove a *legal title*. Has he done either? What was the character of the interest or title transferred from Fitzgerald to Enos Wilder? This could not transcend the interest or title possessed by Fitzgerald himself; and what was this? A title to any specific machine which he may have constructed, and of which no person could rightfully deprive him; and a claim upon the good-will and gratitude of the community, if in truth he should have conferred upon them a benefit by the discovery and construction of his machine. I speak now in reference to rights derivable from the common law, and independently of the Constitution or of statutory provisions. The mere circumstances of inventing and constructing a machine, could no more inhibit its imitation, than would the structure or interior arrangement of a house of peculiar ingenuity or convenience prevent the like imitation by any one who could possess himself of its plan. The mere mental process of devising an invention enters not into the nature of property, according to the common law; it forms no class or division in any of its enumerations or definitions of estates or property, and is a matter quite too shadowy for the practical character of that sturdy system.

A doctrine contrary to this, though with some discrepancy amongst the judges as to its extent, seems at one time to have obtained in the King's Bench, as propounded in the case of *Miller v. Taylor*, in 4 Burrow, 2305, in opposition to the profound and unanswerable reasoning of Mr. Justice Yeates; but upon a review of the same question in the Lords, in the case of *Donaldson v. Beckett and others*, the doctrine of the King's Bench was repudiated, and that of the com-

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mon law, as asserted by Justice Yates, vindicated and restored. And, indeed, if, according to the opinions of some of the judges in the case of *Miller v. Taylor*, the mere mental process of invention constituted an estate or property at the common law, and property vested *in perpetuo*, except so far as it should be transferred by the owner, it is difficult to perceive the necessity of a cautious and complicated system for the investment and security of interests already perfect, and surrounded with every guard and protection which is inseparable under the common law from every right it has created or recognized. But if the mere mental and invisible process of invention, apart from the specific, sensible, and individual structure, can be classed at all as property at law, it must partake of the character of a chose in action, much more so than an obligation or contract, the terms and conditions of which are defined and assented to by the contracting parties. To choses in action, it can scarcely be necessary here to remark, assignability is imparted by the statutory enactment only, or by commercial usage. To hold that the single circumstance of invention creates an estate or property at law, and an estate and legal title transmissible by assignment, appears to me a doctrine not merely subversive of the common law, but one which contravenes the origin and course of legislation in England in relation to patent-rights, and renders useless and futile both the constitutional provision and all the careful enactments of Congress for the security and transmissibility of the same rights. For why, as has been already remarked, should that provision and these enactments have been made for the establishment and security of that which was established and safe independently of both? I hold it, then, to be true, that the circumstance of *invention* invests no such perfect estate or right of property as can be claimed and enforced at law or in equity against the *user* of the same invention, either by subsequent inventors or imitators, and that any estate or property in the mere mental process of invention must be traced to and deducible from the Constitution and the acts of Congress alone. I cannot but regard as mischievous and alarming, an attempt to introduce a *quasi* and indefinite, indefinable, and invisible estate, independently of the Constitution and acts of Congress, and unknown to the rules and principles of the common law.

It is the *patent alone* which creates an estate or interest in the *invention* known to the law, and which can be enforced either at law or in equity, either by the inventor or by the person to whom, by *virtue of the statute*, he may assign his rights. Down to the act of Congress of 1837, nothing but the estate, interest, or property created or invested by the *patent itself*, was made assignable. The language of the law is,



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that "*every patent*," "*the exclusive right under any patent*," "*the thing patented*," may be assignable. The fact or existence of a patent is in every instance inseparable from the right given. It is this fact, and this only, which impresses the quality of assignability. Of course, under these provisions there could be no transfer of the legal title previously to a patent.

By section six of the act of Congress approved March 3, 1837, it is provided, that *thereafter* any patent *to be issued* may be made to the assignee of the inventor or discoverer, upon the conditions set forth in this section. Yet, still it is presumed, that until the issuing of a patent, so far is it from being true that a legal estate or title existed in such assignee, it is clear, on the contrary, that no *legal title* existed before the patent in the inventor himself; for it is the patent which constitutes his title. Of course, then, the assignee can, at most, hold nothing but an equity under such an assignment, which he may insist upon under this assignment against the inventor or against the government; but he has no legal title by force merely of such an assignment; and, *a fortiori*, he has no legal title if the patent, notwithstanding such an assignment, is in fact issued to the inventor, but is thereby entirely excluded from all pretension to a legal title. Thus, in the case before us, the patent under which the plaintiff claims was, subsequently to the agreement between Fitzgerald and Enos Wilder, issued to Fitzgerald, the inventor, and, according to the proofs in the cause, has never been renewed to Enos Wilder, nor to any claimant under him, nor been assigned to any such claimant, but remains still in the alleged inventor, Fitzgerald. It seems to me, then, indisputable, that the legal title indispensable for the maintenance of this suit *at law* never was in the plaintiff, and that he could not maintain the action.

The second instance in which I hold the learned justice who tried this cause to have erred, is that in which he instructed the jury as follows: "That if Conner had not made his *discovery public*, but had used it simply for his own private purpose, and it had been *finally forgotten or abandoned*, such *discovery and use* would be no obstacle to the taking out of a patent by Fitzgerald, or those claiming under him, if he be an original, though not *the first inventor or discoverer* of the improvement." In considering this instruction of the learned judge, the first vice with which it appears to be affected is its violation of a rule thought to be universally applicable to instructions to juries in trials at law; and that rule is this, that instructions should always arise out of, and be limited to, the facts or evidence in the cause to which the questions of law propounded from the bench should be

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strictly applicable; and that instructions which are general, abstract, or not springing from, and pertinent to, the facts of the case, are calculated to mislead the jury, and are therefore improper. Tried by this rule, the instruction of the learned judge, so far as it relates to Conner's not having made his discovery *public*, or having finally forgotten or abandoned it, is certainly irrelevant to, and unsustained by, any evidence in the record. So far is the existence of such testimony from being shown, the converse is proved and is justly inferable throughout; for although it does not appear that Conner advertised his invention in the public papers, or claimed a patent for it, it is admitted that he used this safe in an extensive business establishment, to which it is certain, from the nature of his business, the public had access; and it is not pretended that he made any effort at concealment of what he had invented, and the record is entirely destitute of evidence of an abandonment of his invention. As to the assumption of his having forgotten it, there is neither a fact, an inquiry, nor conjecture in the testimony pointing to such a conclusion. The instruction appears to me to be wholly gratuitous and irrelevant. But supposing this instruction to have been founded upon testimony introduced before the jury, let us consider for a moment its correctness as a rule of law applicable to this cause. This charge, it must be recollected, admits that Conner was, or might have been, the first inventor; and, notwithstanding, asserts that Fitzgerald, though posterior in time, might, upon the conditions and considerations assumed by the judges, become the owner of the right. Are these conditions warranted, either by the rules of public policy, or by the terms and language of legislative provisions on such subjects? It is said that patent privileges are allowed as incitements to inventions and improvements by which the public may be benefited. This position, that may be conceded in general, should not be made a means of preventing the great and public purposes its legitimate enforcement is calculated to secure. The admission of this principle leaves entirely open the inquiries, whether he is more the benefactor of the public who makes a useful improvement which he generously shares with his fellow-citizens, or he who studies some device which he denies to all, and limits, by every means in his power, to a lucrative monopoly; and still more, whether the latter shall be permitted to seize upon that which had already (as is here admitted) been given to the public, thereby to levy contributions, not only on the community at large, but upon him even who had been its generous benefactor. It was doubtless to prevent consequences like those here presented, that the *priority* and *originality* of inventions are so uniformly

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and explicitly insisted upon in all the legislation of Congress, as will presently be shown. The tendency of the learned judge's charge to mislead the jury, from its want of precision, and its failure to define any certain predicament upon which the action of the jury should be founded, is, of itself, an insuperable objection to that charge. Thus, it is said if Conner "had not *made his discovery public*." In what mode? it may be asked. What form of publicity did the learned judge intend the jury should require? It is shown that Conner used his safe publicly; that is, he concealed it from no one; and if any mode or kind of publication or concealment was requisite, either to establish or conclude the right of Conner, or to conclude common right, (a delinquency in the nature of a forfeiture,) surely that mode, if found either in any statute or in the rules of the common law, ought to have been clearly laid down, so as to guard the rights of all. In the next place, it is said, by the learned judge, that if Conner had *abandoned* this improvement which the charge admits him to have invented, this would justify a patent to another who had not known of the improvement, although a subsequent inventor. I have always understood it to be indisputable law, that wherever an inventor abandons or surrenders an invention or improvement which he has certainly made, and neither claims an exclusive right in himself nor transfers it to another, the invention or improvement is given to the public; but by the charge in this case, such an abandonment transfers an *exclusive right* to one who, by the case supposed, is *admitted not to be the first inventor*. So, too, with respect to the hypothesis of the learned judge, that the invention had or might have been forgotten. To this, the same objections of vagueness and uncertainty, and the graver objection of injustice to the real inventor or to the public, are applicable. By whom, and for what interval of time, must this improvement have been forgotten, in order to transfer it from the originator thereof? For a term of years? And if so, for how long a term? But suppose he forgets it for his lifetime, shall his executor or his posterity, upon the exhibition of indisputable proofs of the invention, yea, the very machine itself, perfect in all its parts and in its operation, be cut off? This surely cannot be; but, at any rate, the jury should have been furnished with some rule or measure of obliviousness, if this was to be made the substantive cause of deprivation as to the original inventor, or the foundation of right, and of exclusive right, in one confessedly not the first inventor. An attempt has been made to compare the doctrine propounded by the court to what it might be thought is the law as applicable to the discovery, or rather *recovery*, of the processes employed in what have been called *the lost arts*;

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This illustration is, in itself, somewhat equivocal, and by no means satisfactory; for if that process could certainly be *shown* to be the same with one claimed by the modern inventor, his discovery could scarcely have the merit of originality, or be the foundation of exclusive right. But, in truth, the illustration attempted to be drawn from a revival of a lost art is not apposite to the present case. The term *lost art* is applicable peculiarly to certain monuments of antiquity still remaining in the world, the process of whose accomplishment has been lost for centuries, has been irretrievably swept from the earth, with every vestige of the archives or records of the nations with whom those arts existed, and the origin, or even the identity, of which process none can certainly establish. And if a means of producing the effect we see and have amongst us be discovered, and none can, either by history or tradition, refer to a similar or to the identical process, the inventor of that means may so far claim the merit of originality, though the work itself may have been produced possibly by the same means. But not one principle drawn from such a state of things can be applied to a recent proceeding, which counts from its origin scarcely a period of fifteen years. In fine, this ruling of the learned judge is regarded as being at war not less with the policy and objects than it is with the express language of all the legislation by Congress upon the subject of patent-rights, which legislation has uniformly constituted *priority of invention* to be the foundation and the test of all such rights. Thus, in the act of April 10, 1790, the first Patent Law, (1 Statutes at Large, 109,) it is declared, by the first section, "That upon the application of any person or persons, &c., setting forth that he, she, or they hath or have invented or discovered any useful art, &c., *not before known or used*," &c.; and the second section of the same statute, requiring a specification of any invention or discovery, declares that it shall be so described "as to distinguish it from all other things known or used."

The act of February 21, 1793, (1 Statutes at Large, 318,) provides, that when any citizen or citizens of the United States shall allege that he or they have invented any "*new and useful art, &c., not known or used before the application*," &c.

By the act of April 17, 1800, (2 Statutes at Large, 38,) which extends the privilege of patents to aliens, proof is required that the art, invention, or discovery hath not *been known or used* in that or any foreign country. It is true, that this requisition has been so far relaxed as to admit of the patenting in this country inventions which had been invented and used abroad; but, with respect to this country, the invention, &c., must still be original.

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Syllabus.

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In the act of July 4, 1836, (5 Statutes at Large, 117,) reorganizing the Patent Office, the language of the sixth section is as follows: "That any person or persons having discovered or invented any new and useful art, &c., *not known or used by others before his or their discovery*," &c. The language and import of the laws here cited are too plain to require comment; and I think that the production of a single instance from the statute-book may safely be challenged, by which the requisites above mentioned have been dispensed with. Every law, on the contrary, has emphatically demanded originality and priority as indispensable prerequisites to patent privileges, and every aspirant to such privileges is expressly required to swear to these prerequisites, as well as to establish them. These tests ordained by the laws are not only founded upon the true reason for the privileges conferred, but they are simple and comprehensible; whereas the innovations permitted by the ruling of the learned judge not only conflict with the true reason and foundation of patent privileges, but tend to an uncertainty and confusion which cannot but invite litigation and mischief. I think that the judgment of the Circuit Court should be reversed, and the cause remanded for a *venire facias de novo*.

Mr. Justice GRIER also dissented.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs, and damages at the rate of six per centum per annum.

AFFIRMED WITH COSTS.

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CHARLES J. GAYLER AND LEONARD BROWN, PLAINTIFFS IN ERROR, v.  
BENJAMIN G. WILDER.

(10 Howard, 509.)

1. After a case has been decided, and judgment pronounced by this court, it is too late to move to open the judgment for the purpose of amending the bill of exceptions, upon the ground that material evidence which might have influenced the judgment of this court was omitted in the bill.
2. If there was any error or mistake in framing the exception, it might have been corrected by a *certiorari*, if the application had been made in due time and

## Opinion of the court.

upon sufficient cause. But after the parties have argued the case upon the exception, and judgment has been pronounced, it is too late to reopen it.

At a subsequent day of the term, a petition was filed by the plaintiffs in error, that the foregoing case might be reopened for the purpose of amending the bill of exceptions, and reargued on such amended bill.

The petition recited certain portions of the opinion of this court in the case relating to the Conner safe, wherein the court, after recapitulating the evidence applicable thereto, as well as the instruction given by the court below, decide that there was no error in such instruction, which "put it to the jury to say, whether this safe had been finally forgotten or abandoned before Fitzgerald's invention, and whether he was the original inventor of the safe for which he had obtained the patent; directing them, if they found these two facts, that their verdict must be for the plaintiff." The petition then avers, that the existence and use of the Conner safe, from the time of its construction to the time of the trial, was proved in the court below, and that it was so stated in a bill of exceptions prepared by the counsel of the petitioners and submitted to the court. That the original plaintiff did not make any specific objections to petitioners' statement of the evidence as to the Conner safe, (as is alleged to be the practice settled by the Supreme Court of New York,) but proposed a different bill of exceptions as a substitute therefor, which the court below adopted, against the remonstrance of petitioners' counsel. The petition then insists, that if the facts stated in petitioners' bill of exceptions respecting the Conner safe had been set forth substantially in any bill of exceptions, this court, upon the principles contained in their opinion, must have determined this cause in favor of plaintiffs in error.

Mr. Coxe moved for a reargument on the grounds stated in the petition.

Mr. Chief Justice TANEY delivered the opinion of the court.

This case was argued early in the present term, and the judgment of the Circuit Court affirmed.

A motion is now made to open the judgment for the purpose of amending the bill of exceptions and rehearing the case, upon the ground that material evidence offered by the plaintiffs in error, which might have influenced the judgment of this court, has been omitted in the bill of exceptions contained in the record.

If any error or mistake was committed in framing this exception, it might undoubtedly have been corrected by a *certiorari*, if the appli-

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Statement of the case.

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cation had been made in due time and upon sufficient cause. But this application is too late, even if the evidence which the plaintiffs in error propose to introduce would have influenced the decision. We by no means intend to say that it would have done so. But they rested satisfied with the exception as it stood; made no objection to it here; and argued the case and awaited the judgment of the court upon the evidence as stated in the exception. After that judgment has been pronounced, it is too late to say that the statement was imperfect or erroneous, and to make a new case by the introduction of new evidence, and a new exception.

The motion is therefore

OVERRULED.

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JULIA P. HOTCHKISS, EXECUTRIX OF JOHN G. HOTCHKISS, DECEASED,  
JOHN A. DAVENPORT, AND JOHN W. QUINCY, PLAINTIFFS IN ER-  
ROR, v. MILES GREENWOOD AND THOMAS WOOD, PARTNERS IN TRADE  
UNDER THE NAME OF M. GREENWOOD & Co.

(11 Howard, 248.)

1. A patent granted for a "new and useful improvement in making door and other knobs, of all kinds of clay used in pottery, and of porcelain," by having the "cavity in which the screw or shank is inserted, by which they are fastened, largest at the bottom of its depth, in form of a dovetail, and a screw formed therein by pouring in metal in a fused state," was invalid.
2. The invention claimed in the schedule was manufacturing knobs as above described, of potter's clay, or any kind of clay used in pottery, and shaped and finished by moulding, turning, burning, and glazing; and also of porcelain.
3. The knob was not new, nor the metallic shank and spindle, nor the dovetail form of the cavity in the knob, nor the means by which the metallic shank was securely fastened therein. Knobs had also been used made of clay.
4. The only thing new was the substitution of a knob made out of clay in that peculiar form for a knob of metal or wood. This might have been a better or cheaper article, but is not the subject of a patent.
5. The test was, that, if no more ingenuity and skill was necessary to construct the new knob than was possessed by an ordinary mechanic acquainted with the business, the patent was void; and this was a proper question for the jury.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Ohio.

It was a question involving the validity of a patent-right under the following circumstances. The patent and specification were as follows:

"The United States of America to all to whom these letters patent shall come:

## Statement of the case.

"Whereas, John G. Hotchkiss, New Haven, Conn., John A. Davenport, and John W. Quincy, New York, have alleged that they have invented a new and useful improvement in making door and other knobs, of all kinds of clay used in pottery, and of porcelain, which they state has not been known or used before their application; have made oath that they are citizens of the United States, that they do verily believe that they are the original and first inventors or discoverers of the said improvement, and that the same hath not, to the best of their knowledge and belief, been previously known or used; have paid into the treasury of the United States the sum of thirty dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose: These are, therefore, to grant, according to law, to the said John G. Hotchkiss, John A. Davenport, and John W. Quincy, their heirs, administrators, or assigns, for the term of fourteen years from the 29th day of July, 1841, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said Hotchkiss, Davenport, and Quincy, in the schedule hereunto annexed, and is made a part of these presents."

"In testimony whereof, I have caused these letters to be made patent, and the seal of the Patent Office has been hereunto affixed.

"Given under my hand, at the city of Washington, this 29th day of July, A. D. 1841, and of the independence of the United States of America the sixty-sixth.

"DANIEL WEBSTER,

*"Secretary of State."*

"Countersigned and sealed with the seal of the Patent Office.

"HENRY L. ELLSWORTH,

*"Commissioner of Patents."*

"The schedule referred to in these letters patent, and making a part of the same.

"To all whom it may concern: Be it known, that we, John G. Hotchkiss, of the city and county of New Haven, and State of Connecticut, and John A. Davenport and John W. Quincy, both of the city, county, and State of New York, have invented an improved method of making knobs for locks, doors, cabinet furniture, and for all other purposes for which wood and metal or other material knobs are used. This improvement consists in making said knobs of potter's clay, such as is used in any species of pottery; also of porcelain; the operation is the same as in pottery, by moulding, turning, and



## Statement of the case.

burning and glazing; they may be plain in surface and color, or ornamented to any degree in both; the modes of fitting them for their application to doors, locks, furniture, and other uses will be as various as the uses to which they may be applied, but chiefly predicated on one principle—that of having the cavity in which the screw or shank is inserted, by which they are fastened, largest at the bottom of its depth, in form of a dovetail, and a screw formed therein by pouring in metal in a fused state. In the annexed drawing, A represents a knob with a large screw inserted, for drawers and similar purposes; B represents a knob with a shank to pass through and receive a nut; C, the head of the knob calculated to receive a metallic neck; D, a knob with a shank calculated to receive a nut on the outside or front. What we claim as our invention, and desire to secure by letters patent, is the manufacturing of knobs, as stated in the foregoing specifications, of potter's clay, or any kind of clay used in pottery, and shaped and finished by moulding, turning, burning, and glazing; and also of porcelain.

“JOHN G. HOTCHKISS.

“J. A. DAVENPORT.

“JOHN W. QUINCY.

“Witnesses: ALPS. SHERMAN, JAMES MONTGOMERY.”

In October, 1845, the plaintiffs in error brought an action, in the Circuit Court of the United States for Ohio, against the defendants, for a violation of the patent-right.

The defendants pleaded not guilty, and gave the following notice:

“The plaintiffs will please take notice, that on the trial of the above cause the defendants will give in evidence to the jury, that the said John G. Hotchkiss, John A. Davenport, and John W. Quincy were not the original and first inventors and discoverers of making or manufacturing knobs of potter's clay or of porcelain. They will also prove that the making of knobs from potter's clay, and also from porcelain and other clays used by potters, was known and practiced, and such knobs were made, used, and sold in the cities of New York, Albany, Troy, and Brooklyn, in the State of New York; also in Jersey City, in the State of New Jersey; also in the city of Philadelphia, State of Pennsylvania; by John Mayer, Thomas Frere, William Lundy, Jr., and Charles W. Vernereck, residing in the city of New York; also by John Harrison, residing in Jersey City, in the State of New Jersey; and by Littlefield, Hattrick & Shannon, of Philadelphia, in the State of Pennsylvania, long before the 29th day of July, in the year 1841, the date of the patent in the declaration mentioned. They will also prove that similar knobs were manufactured of potter's clay,

## Statement of the case.

and also of porcelain, and were also used and sold, long prior to the said 29th day of July, 1841, in the town of Burslem, in Staffordshire, England; also in the town of Sandyford, near Tunstall; also in the town of Hanley, Staffordshire, England; also at Woodenbose village, in the county of Derbyshire, England. And the said defendants will prove the manufacture and use of said knobs, so made of clay and porcelain, by Godfrey Webster and John Webster, who now reside in East Liverpool, Columbiana county, Ohio; and also by Enoch Bulloch, who now resides in Wellsville, in the same county; also by Daniel Bennett, who now [resides] in the city of Pittsburg, Pennsylvania,—all of whom formerly resided in Staffordshire, England. The defendants will also prove that the said patentees, John G. Hotchkiss, John A. Davenport, and John W. Quincy, at the time of making application for the said patent, well knew that the said knob so patented had been previously made and sold in a foreign country, to wit, in the kingdom of Great Britain, and also in Germany, and did not believe themselves to be the first inventors or discoverers of manufacturing knobs from potter's clay or porcelain. All of which will be insisted upon in bar of the action.

“CHARLES FOX,

*“Attorney for the Defendants.”*”

And in July, 1848, the following additional notice :

“The plaintiffs in this cause will please take notice, that on the trial of the cause the defendants will give in evidence to the jury, that the said John G. Hotchkiss, John A. Davenport, and John W. Quincy were not the original and first inventors and discoverers of making or manufacturing knobs of potter's clay, or of porcelain. They will also prove, that knobs made of potter's clay, and of porcelain and other clays, had been previously publicly used and sold in the cities of New York, Albany, Troy, and Brooklyn, in the State of New York; also in Jersey City, in the State of New Jersey; also in New Haven and Middletown, in the State of Connecticut, long before and at the date of the patent under which the plaintiffs claim. The defendants will likewise prove, on said trial, that John Mayer, residing in Staten Island; Hoop & Lee, residing in the city of Brooklyn, in the State of New York; Edward H. Higgins, John Penfield, John Duntze, residing in New Haven, in the State of Connecticut; Matthew Fifo, William Fifo, Jane Fifo, John C. Smith, and certain persons doing business under the name of Smith, Fifo & Co., residing in the city of Philadelphia, in the State of Pennsylvania, as early as the year 1831, and from that time on, and until and at the time of

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## Statement of the case.

obtaining the patent under which the plaintiffs claim, and before the alleged discovery and invention set forth in said patent, made, manufactured, and publicly sold and used knobs made of potter's clay, and of other clays, and of porcelain, in the several cities and places named."

The following bill of exceptions was taken during the trial:

"The plaintiffs offered in evidence the patent, specifications, and drawings, and other evidence tending to prove the originality, novelty, and usefulness of the inventions as described in said specification; and other evidence tending to show the violation of said patent by the defendant, and rested. Whereupon the defendants offered evidence tending to show that the said alleged invention was not originally invented by any one of the said patentees; and that if said invention was original with any of the said patentees, it was not the joint invention of all of said patentees; and other evidence tending to show that the mode of fastening the shank or collet to the knob, adopted by the plaintiffs, and in said specification described, had been known and used in Middletown, Connecticut, prior to the alleged inventions of the plaintiffs, as a mode of fastening shanks or collets to metallic knobs. And the evidence being closed, the counsel for the plaintiffs insisted, in the argument, that although the knob, in the form in which it is patented, may have been known and used in the United States prior to their invention and patent; and although the the shank and spindle by which it is attached may have been known and used in the United States prior to said invention and patent, yet if such shank and spindle had never before been attached to a knob made of potter's clay or porcelain; and if it required skill and thought and invention to attach the said knob of clay to the metal shank and spindle, so that the same would unite firmly and make a solid and substantial article of manufacture; and if the said knob of clay or porcelain so attached were an article better and cheaper than the knob theretofore manufactured of metal or other materials, that the patent was valid, and asked the court so to instruct the jury, which the court refused to do;—but, on the contrary thereof, instructed the jury, that if knobs of the same form and for the same purposes with that described by the plaintiffs in their specifications, made of metal or other material, had been known and used in the United States prior to the alleged invention and patent of the plaintiffs; and if the spindle and shank, in the form used by the plaintiffs, had before that time been publicly known and used in the United States, and had been theretofore attached to metallic knobs by means of the dovetail and the infusion of melted metal, as the same is directed, in the speci-

fication of the plaintiffs, to be attached to the knob of potter's clay or porcelain; so that if the knob of clay or porcelain is the mere substitution of one material for another, and the spindle and shank be such as were theretofore in common use, and the mode of connecting them to the knob by dovetail be the same as was theretofore in use in the United States, the material being in common use, and no other ingenuity or skill being necessary to construct the knob than that of an ordinary mechanic acquainted with the business, the patent is void, and the plaintiffs are not entitled to recover. The counsel for the defendants asked the court to instruct the jury, that if they should be satisfied that any one of the patentees was the original inventor of the article in question, and that the same was new and useful, yet if they should be satisfied from the evidence that all the patentees did not participate in the invention, the patent is void, and the plaintiffs cannot recover. The court gave the above, modified by the remark, that the patent was *prima facie* evidence that the invention was joint, though the fact might be disproved on the trial; and the court remarked, there was no evidence except that of a slight presumption against the joint invention as proved by the patent; to which refusal of the court to instruct the jury as asked by the counsel for the plaintiffs, and to the instructions given, the plaintiffs, by their counsel, except, and pray the court to sign this their bill of exceptions.

"JOHN MCLEAN." [SEAL.]

Upon this exception, the case came up to this court, and was argued by *Mr. Ewing*, for the plaintiffs in error, and by *Mr. Chase*, for the defendants in error.

*Mr. Ewing*, for the convenience of reference, divided the instructions of the court into paragraphs, as follows:

The court instructed the jury—

1. That if knobs of the same form and for the same purposes with that described by the plaintiffs in their specifications, made of metal or other material, had been known or used in the United States prior to the alleged invention and patent of the plaintiffs;
2. And if the spindle and shank, in the form used by the plaintiffs, had before that time been publicly known in the United States, and had been theretofore attached to metallic knobs by means of the dovetail and infusions of melted metal, as the same is directed, in the specifications of the plaintiffs, to be attached to the knob of potter's clay or porcelain;
3. So that if the knob of potter's clay or porcelain is the mere sub-

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Argument for the plaintiffs in error.

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stitution of one material for another, and the spindle and shank be such as were theretofore in use in the United States;

4. The material being in common use, and no other ingenuity or skill being necessary to construct the knob than that of an ordinary mechanic acquainted with the business;

5. The patent is void, and the plaintiffs are not entitled to recover.

It will be seen that the court, in the paragraph of the instructions which I have numbered 4, take upon themselves to determine, in the negative, the question "whether it required skill and thought and invention to attach the knob of clay to the metal shank and spindle, so that they would unite firmly and make a solid, substantial article of manufacture," instead of submitting it to the jury. It was a question of fact, not arising upon the construction of a written or printed paper, but depending upon evidence, and ought to have been submitted to the jury if material in the case.

It will also be seen that the court rejected entirely one clause of the instructions asked, namely, "whether the knob of clay or porcelain thus attached to the metallic shank and spindle were an article better and cheaper than the knob theretofore manufactured of metal or other materials," and gave nothing as a substitute for it, leaving the jury to understand that it was immaterial whether it were a better and cheaper article or not.

The court seemed to have been of opinion, first, that it could not, in the nature of things, require skill and thought and invention so to unite the metal and clay as to make them, together, a firm and substantial article of manufacture; or, second, that the new manufacture produced by the substitution of one material for another in part of the article, and the uniting of the two materials, though of dissimilar qualities, and never before united for that purpose, was not patentable, even though it required skill and thought and invention to unite them, and though the new manufacture thus produced were cheaper and better than any like article ever before known.

1st. The first position, I respectfully contend, the court had no right to assume. The counsel had the same right to appeal from the court to the jury on a question of fact, that they had to appeal from that tribunal to this on a question of law. The right to refer this question to the jury was distinctly insisted upon by counsel, and as distinctly denied by the court. For this, I contend, the judgment ought to be reversed.

But if the court had the right to settle this question of fact, as they would have to determine the effect of a written instrument, I think I am able to show that they erred in their opinion on the question.

Knobs had been in use many hundred years; potter's ware and porcelain, many thousand; but no one ever before succeeded in uniting the clay and the iron so as to make of the two a substantial and useful article. There are many difficulties in uniting them, which can be best explained by a careful examination of the new manufacture itself; and if it were proper for the court below to pronounce upon the question connected with it absolutely, on inspection, as a legal conclusion drawn from the article itself, it is equally so for the court here to inspect the article, and determine on inspection whether the decision below was right. *Curtis on Patents*, secs. 10, 14, (note 2,) 15, 16; *Webster on Patents*, 29, 30.

2d. But the second alternative position is the one on which I understood the court to rest, namely, that the new manufacture produced by the substitution of one material for another, as in this case the substitution of clay or porcelain in the place of metal for the knob, using metal as theretofore for the collet and spindle, was not patentable, though the materials are dissimilar, and were never before united for that or a like purpose, and though it required skill and thought and invention to unite them, and though the new manufacture thus produced was cheaper and better than any like article ever before known.

This position cannot be maintained, either by reason or authority. The clay or porcelain knob, connected with the metallic shank, is a new and useful manufacture, according to the letter, as well as the spirit and intent, of our statute.

1st. "That it is 'a manufacture,' can admit of no doubt; it is a vendible article, produced by the art and hand of man." Per C. J. Tindall, in *Cornish v. Keene*, *Webs. on Pat.*, 517; *Boulton v. Bull*, 2 H. Black., 492, 495, and *Id.*, 463, 464, note (a); and *Rex v. Wheeler*, 2 Barn. & Ald., 349, 350.

2d. As the court refused to submit to the jury the question whether the article produced by the substitution of clay or porcelain for metal, &c., in the manufacture of knobs, was better and cheaper than the old article, the charge must rest on the admission that it was better and cheaper. The manufacture which is the result of that combination is, therefore, by concession, "a useful manufacture."

And it is clear that it is, in fact, a very useful manufacture. The potter's ware and porcelain knobs are almost everywhere taking the place of the metal knob.

3d. It is also a new manufacture.

"The mere substitution of one metal for another in a particular manufacture might be the subject of a patent, if the new article were

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Argument for the plaintiffs in error.

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better, more useful, or cheaper than the old." Curtis on Patents, sec. 8, note 3.

"No one can say that a silver and an earthen tea-pot are the same manufacture." Webster on Patents, page 25, note.

As little can any one say that a metal and an earthen knob are the same manufacture.

"If there be anything material and new which is an improvement of the trade, that will be sufficient to support a patent." Per Buller, J., in *Rex v. Arkwright*, Webster's Patent Cases, 71. See Godson on Patents, 63, 70, 124, 126; also Hindmarch on Patents, 124, 126. A list of cases sustaining this point are collected in Curtis on Patents, sections 9 and 10,—Lord Dudley's patent being the substitution of pit-coal for charcoal in the manufacture of iron (Webster's Patent Cases, 14); Neilson's patent, the hot blast instead of the cold (*Id.*, 152); Crane's patent, the substitution of anthracite for soft coal in connection with the hot blast (*Id.*, 273); Durome's patent, the application of charcoal, long used in filtering, to the filtering of sugar (*Id.*, 152); in Ball's case, the use of the flame of gas instead of the flame of oil to singe off the superfluous fibers of lace (*Id.*, 99, and note, in which many other similar cases are referred to).

Our invention is a combination of dissimilar materials (not a composition of matter) never before united, which produces a new manufacture. Tindall, C. J., in *Crane v. Price et al.*, in speaking of the hot-air blast combined with anthracite coal in the production of iron, says:

"We are of opinion, that if the result produced by such combination is either a new article or a cheaper article to the public than that produced by the old method, such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent." "And it falls within the doctrine of Lord Eldon, that there may be a valid patent for a new combination of materials previously in use for the same purpose, or even for a new method of applying such materials." Webster's Patent Cases, 409.

Mr. Curtis, after a review of the cases, says, sec. 14: "It appears, then, according to the English authorities, that the amount of the invention may be estimated from the result, although not capable of being directly estimated on a view of the invention itself." And in sec. 15: "The utility of the change is the test to be applied for the purpose. As there cannot be a decidedly new result without some degree of invention to effect that result, where a real utility is seen to exist, a sufficiency of invention may be presumed." And Mr. Webster, in his treatise on the subject-matter, says that "whenever

the change and its consequences, taken together and viewed as a sum, are considerable, there must be a sufficiency of invention to support a patent." Pages 29, 30.

Our courts have applied the same tests as the courts in England. Curtis on Patents, sec. 18.

As in the case of *Kneass v. The Schuylkill Bank*, 4 Wash., 9-11, where steel plates were used instead of copper plates in printing bank-notes, the question left to the jury, was whether the substitute of steel for copper plates was an improvement. See Curtis on Patents, sec. 24 and note 1, citing *Ryan v. Godwin*, 3 Sumner, 514, 518.

In the case at bar, the question of skill and invention, and the question of utility, which are the universally acknowledged test questions in this class of cases, were withheld from the jury; the question of skill and invention determined by the court; the question of utility thrown out of the case.

We have, then, by all the rules heretofore recognized in this class of cases, "a new and useful manufacture."

The letter of the statute embraces it; so, clearly, does the spirit and intent of the act. It is indeed an invention of much more than common importance and merit. It is the combination of two materials, metal and earth, never before united in this manner, so as to give to the new manufacture the strength of iron, with the durability and beauty of the clay or porcelain; its exemption from the corrosive action of acids and other chemical agents, and its consequent freedom from tarnish.

There are some cases of the application of old inventions to obvious new uses, for which courts have refused to sustain a patent. They are referred to by Lord Abinger in *Losh v. Hague*, Webster's Patent Cases, 208; Curtis, sec. 7, note 2. Or the case of a double use, where no new manufacture or a cheapening of the old is the result. *Ib.*, note 3.

In the case of *Rex v. Fusell*, the dampening of cloth by steam instead of hot water would have been held patentable had it been useful. It was frivolous. *Crane v. Price*, Webster's Patent Cases, 409.

And it is said by Mr. Webster, in a note to *Crane v. Price*, and others, "that no case is reported or mentioned in any of the books in which a patent has failed simply on the ground of the invention not being the subject-matter of letters patent,—some other ground, as want of novelty or defective specification, having been the real cause of failure."



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Argument for the defendants in error.

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The counsel for the defendants in error made the following points:

The court now is called upon to decide whether this patent, or whether any patent, can be sustained merely for applying a common, well-known material to a use to which it had not before been applied, without any new mode of using the material, or any new mode of manufacturing the article sought to be covered by the patent.

And here we will first ask the court for a construction of this patent. Does the patent and specification confine its claim to a mere right to use clay or porcelain for the purpose of making or manufacturing knobs, or does it claim to cover the manufacturing knobs of clay and porcelain in the manner or mode set forth in the specification?

The language of the claim, in the closing part of the specification, is as follows:

“What we claim as our invention, and desire to secure by letters patent, is the manufacturing of knobs, as stated in the foregoing specification, of potter’s clay, or any kind of clay used in pottery, and shaped and finished by moulding, turning, burning, and glazing,” &c. The patentees had previously stated, in their specification, that “the modes of fitting them for their application to doors, locks, and furniture, and other uses will be as various as the uses to which they may be applied, but chiefly predicated on one principle—that of having the cavity in which the screw or shank is inserted, by which they are fastened, largest at the bottom of its depth, in form of a dovetail, and a screw formed therein by pouring in metal in a fused state.”

The concluding clause of the specification then claims by the patent to cover the manufacture of knobs made of clay in the manner described in the specification, and the great principle of the manner of forming the knob is by a cavity which, with hot metal poured in, will make a dovetail-shaped fastening or holding of the knob on to the shaft.

We think it clear the claim is for manufacturing knobs of clay in the particular manner specified, so that, when manufactured, they shall be held to the shank by force of the dovetail.

We think it clear, that had not the defendants established the fact on the trial, that knobs for door-handles and for locks had been previously patented to a person in Middletown, which were made and fastened in the same identical way as the ones described in the plaintiffs’ specification, the plaintiffs would have claimed the right to recover against us for making and fastening the knobs in that particular way. We suppose the plaintiffs, in the absence of such testimony, would have claimed that their specification covered the

form and manner of fastening the knobs to the handle, as well as the material out of which the knob was made. Indeed, such was their claim, made at the trial of the cause.

It is now well settled, that, in order fairly to construe a patent, the whole specification must be examined; and if we can gather from the whole paper the meaning of the inventor, and the extent of his claim, the object of the statute is attained. 2 Phillips on Patents, 169, 170; 3 Sumner, 520; Curtis on Patents, sec. 123, 130, 141; 1 Mason, 477.

This case is very similar to the case of *Barrett et al. v. Hall*, 1 Mason, 477, where Judge STORY held, that, taking the whole, specification, it was manifest the patentee claimed as his invention a mode of dyeing and finishing silks, and not a mode of dyeing alone; and the patent being too broad, the whole not being his invention, the patent was void.

It is also well settled, that whatever appears to be covered by the claim of the patentee as his own invention must be taken as part of the claim; for courts of law are not at liberty to reject any part of the claim; and, therefore, if it turns out that anything claimed is not new, the patent is void, however small or unimportant such asserted invention may be. Curtis on Patents, sec. 131; 2 Story, 412.

We claim, therefore, that this is in fact a claim for making knobs of clay, combined with the particular manner of fastening the same to the shank by a dovetail fastening, and is in truth a claim for a combination.

If we are correct in this view of the case, then it is clear that the patent is void, as the jury have found that the claim of fastening knobs to handles by dovetail fastenings was not new, but was known and used before the plaintiffs' patent. *Winans v. Boston and Providence Railroad Co.*, 2 Story, 413; *Hill v. Thompson*, Webster's Patent Cases, 226, 228.

But suppose that the claim in the patent was the mere right to make knobs of clay or porcelain, without regard to any particular mode of making or fastening the knobs into the shaft, the question arises, could such a patent be sustained?

The plaintiffs claim that they have the right to the exclusive use of clay for fourteen years to come, in making knobs for doors, locks, and drawers, by making such a claim known at the Patent Office. They don't even claim to be the discoverers of clay; but they claim the exclusive right to appropriate and use clay in making knobs.

It is a strange claim, to say the least of it. According to the principle of the claim, one man may claim a patent for making a stove

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of sheet-iron; another may claim a patent for making stoves of cast-iron; another may claim a patent for making stoves of copper; and each may claim, not the right to make a stove of a particular form and shape only, or by any peculiar process of making, but the exclusive right to make all sorts and shapes of stoves out of the particular material named.

So another man claims the exclusive right of using ice to cool water; another claims the exclusive right to use ice for cooling wine; another, to use the same article to cool brandy; and a physician claims the exclusive right to use the article of ice to cool a fevered patient's head.

Again, one man has been long accustomed to make window-sashes of pine wood; another comes and says he can make window-sashes of cast-iron, and claims the exclusive right to make all the cast-iron sashes the country may want for the next fourteen years.

Another has discovered that he can make the whole of a house out of cast-iron; he therefore claims the exclusive right to make all the cast-iron houses that are wanted for fourteen years to come.

Another says he has discovered that he can build splendid railroad-cars for the conveyance of passengers out of sheet copper or tin; he therefore obtains a patent for the exclusive use of copper and tin in making such carriages.

Another discovers that tea-kettles have been made of cast-iron for years past, but tea and coffee pots have not as yet been made of that material, and he immediately obtains a patent for the exclusive right to make cast-iron tea and coffee pots for fourteen years.

We know that cast-iron has been extensively used for making machinery of different shapes and forms; for making columns, fences, floors, and indeed everything whose shape can be impressed upon sand; and can it be pretended that any one at this day can claim the right to make some new thing out of cast-iron, and thereby exclude all other persons from making the same article out of the same material?

To allow such a claim, it appears to us, would be violating the spirit of the act of Congress. The object of the act of Congress is to encourage men to devote their time and talent in making new and useful discoveries in the arts, manufactures, and compositions of matter. Why does the act provide so carefully for new compositions of matter, if an individual could obtain a patent for a use of an element of matter without any composition at all?

The patentee in this case is endeavoring to add a new clause to the Patent Law. He is claiming the right to apply a common element of nature to a new purpose, without the aid of any new mode or process

of working it, and without combining it with any other portions of matter so as to make it a composition.

The only causes authorizing the issuing of a patent are declared and set forth in the sixth section of the act of 1836. That section enacts "that any person or persons, having discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements on any art, machine, manufacture, or composition of matter, not before known or used, &c., may make application."

To satisfy the terms of the statute, there must be some new art, machine, manufacture, or composition of matter discovered, or there can be no patent.

It is well settled, that a patent cannot be granted for a new use of the thing, or, as it is commonly stated, a double use. The application of an old machine to some new purpose is not the foundation of a patent; but an improvement of an old machine, in order to apply it to the same purposes more advantageously, is the subject of a patent. But in this latter case, it is the particular improvement made in the machine which constitutes the basis of the patent,—not the result.

If in the present case the patentees had invented an improvement in the mode of fastening the knobs to the handles, or if they had invented a new mode of making knobs out of clay or other materials, their patent might have been sustained; but we maintain they cannot obtain a patent for a new use, or double use, of the article of clay, any more than they could sustain a patent for a new use of an old machine.

It has been decided, that where a certain description of wheels had been used on other than railway carriages, a patent could not be sustained for the use of such wheels on railway carriages. Curtis, note to sec. 87. The court distinguished between applying a new contrivance to an old object, and applying an old contrivance to a new object. *Losh v. Hague*, Webster's Patent Cases, 207. The learned judge stated that a patent cannot be had for applying a well-known thing, which might be applied to fifty thousand different purposes, to an operation which is exactly analogous to what was done before. 2 Story, 412.

So it has been held that a patent for curling palm-leaf for mattresses could not be sustained, where the same process had been long in use for curling hair. *Howe v. Abbott*, 2 Story, 190, 193.

In this latter case, the judge remarked that it was the mere application of an old process and old machinery to a new use,—the same as if a coffee-mill were employed to grind corn, or a flax-machine

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were employed to spin cotton. There must be some new mode or process to produce the result.

If new effects are produced by an old machine in its unaltered state, no patent can be supported for it, as such a patent would be for an effect only. 1 Gallison, 478, 481.

So in the new use of medicines or compositions, as is said in *Boulton v. Hall*, 2 H. Bl., 487. Suppose the world were better informed than it is how to prepare Dr. Jayne's fever-powder, and an ingenious physician should find out that it was a specific cure for a consumption, if given in particular quantities, could he have a patent for the sole use of Jayne's powders in consumption, or to be given in particular quantities? I think it must be conceded that such a patent would be void, and yet the use of the medicine would be new, and the effect of it as materially different from what is now known as life is from death.

So the same judge says the use of arsenic for curing agues could not be patented, because the medicine would not be new, and a new use of it is not the subject of a patent.

We claim, therefore, that this patent cannot be sustained as a patent for the exclusive privilege of using clay for the manufacture of knobs, instead of brass, silver, or metallic compositions. That such a claim does not rise to the dignity of an invention or discovery, but is a mere substitution of one material in place of another, for making the same common article. There is no change proposed in the manner of working the clay, no improvement in machinery used to produce the result, and no new result is obtained; the same identical knobs are produced and applied in the same way; the only change is in the material used, and we suppose that a mere change of one material for another cannot be the subject of a patent.

The case, then, comes within the principle laid down in Phillips on Patents, page 113: "The use of the ordinary known materials cannot be monopolized by patent. We must understand this doctrine to be limited to known materials, and to such as naturally exist, whether known or not; for the discovery of a new elementary substance or material, by analysis or otherwise, does not give a right of a monopoly of it." 2 H. Bl., 487.

On the argument of this latter case, the court put the question to counsel, "Whether, if a man by science were to devise the means of making a double use of a thing known before, he could have a patent for that? It was rightly and candidly admitted that he could not." Page 486.

And Justice Eyre says of Hartley's patent: "He did not invent

those means. The invention wholly consisted in the new manner of using, or, I would rather say, of disposing, a thing in common use, and which thing every man might make at his pleasure; and which, therefore, I repeat, could not, in my judgment, be the subject of the patent."

We claim that there can be no patent in the United States founded upon the material used, unless where a new combination of materials is made use of, and then it comes under that clause of the Patent Law which authorizes a patent for any new composition of matter.

Without a new composition of matter, or a new mixture of the ingredients used, or a new proportion of ingredients used, there can be no patent for the material used in the production of the article. To hold otherwise, would be to repeal this clause of the statute, or rather to add a new clause to it. The act has declared a man may obtain a patent for discovering a new composition, or mixing of substances, so as to produce a new substance; but it has not declared that any one can obtain a patent for the exclusive use of an element of matter, where no combination or mixture of different portions of matter is set forth.

Clay, and its suitability for being manufactured into articles of different shapes, and to be applied to different purposes, is well known. The mode of moistening and using it, and making it into knobs, tea-pots, plates, bowls, cups and saucers, &c., and of glazing, staining, and baking it, is also well known, and no change is proposed in these operations. The use of brass, iron, silver, and glass for the manufacture of knobs for doors and drawers, is also well known. The particular mode of fastening claimed by the plaintiffs is shown not to be new; and, as before remarked, all that can be now claimed in this record, is the exclusive right to use clay instead of metal in making these knobs.

We know of no case in which such a claim has been sustained. We have shown, from the authorities, that the new use of an old machine to produce a new effect is not the subject of a patent.

We have shown that the new use of an old machine or composition of matter cannot be patented; and surely if a composition of matter (which requires mind and skill) could not be applied to a new use, the application of one of the substances of which the composition was made could not be applied to a new use, and thereby lay the foundation for a patent. And we have also shown that the substitution of one material for another is not a patentable subject.

We claim, therefore, in conclusion, that this patent is void—

1st. Because it claims in its specification to have invented the

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mode of fastening the knob to the handle, which the verdict of the jury has shown to be untrue, and therefore the claim is larger than the invention.

2d. Because a patent for the substitution of one material for another, without any combination, or any new mode or process of manufacturing the article, cannot be sustained.

3d. Because no patent for the manufacture of an article can be sustained, unless the particular mode of manufacturing the article is specified and is new, and the difference between the old and new mode of manufacturing is pointed out.

Mr. Justice NELSON delivered the opinion of the court.

This is a writ of error to the Circuit Court of the United States for the District of Ohio.

The suit was brought against the defendants for the alleged infringement of a patent for a new and useful improvement in making door and other knobs of all kinds of clay used in pottery, and of porcelain.

The improvement consists in making the knobs of clay or porcelain, and in fitting them for their application to doors, locks, and furniture, and various other uses to which they may be adapted; but more especially in this, that of having the cavity in the knob in which the screw or shank is inserted, and by which it is fastened, largest at the bottom and in the form of dovetail, or wedge-reversed, and a screw formed therein by pouring in metal in a fused state; and, after referring to the drawings of the article thus made, the patentees conclude as follows:

“What we claim as our invention, and desire to secure by letters patent, is the manufacturing of knobs, as stated in the foregoing specifications, of potter’s clay, or any kind of clay used in pottery, and shaped and finished by moulding; turning, burning; and glazing; and also of porcelain.”

On the trial, evidence was given, on the part of the plaintiffs, tending to prove the originality and usefulness of the invention, and also the infringement by the defendants; and on the part of the defendants, tending to show the want of originality; and that the mode of fastening the shank to the knob, as claimed by the plaintiffs, had been known and used before, and had been used and applied to the fastening of the shanks to metallic knobs.

And upon the evidence being closed, the counsel for the plaintiffs prayed the court to instruct the jury, that although the clay knob, in the form in which it was patented, may have been before known and

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used, and also the shank and spindle by which it is attached may have been before known and used, yet if such shank and spindle had never before been attached in this mode to a knob of potter's clay, and it required skill and invention to attach the same to a knob of this description, so that they would be firmly united and make a strong and substantial article, and which, when thus made, would become an article much better and cheaper than the knobs made of metal or other materials, the patent was valid, and the plaintiffs would be entitled to recover.

The court refused to give the instruction, and charged the jury, that if knobs of the same form and for the same purposes as that claimed by the patentees, made of metal or other material, had been before known and used; and if the spindle and shank, in the form used by them, had been before known and used, and had been attached to the metallic knob by means of a cavity in the form of dovetail and infusion of melted metal, the same as the mode claimed by the patentees, in the attachment of the shank and spindle to their knob; and the knob of clay was simply the substitution of one material for another, the spindle and shank being the same as before in common use, and also the mode of connecting them by dovetail to the knob the same as before in common use, and no more ingenuity or skill required to construct the knob in this way than that possessed by an ordinary mechanic acquainted with the business, the patent was invalid, and the plaintiffs were not entitled to a verdict.

This instruction, it is claimed, is erroneous, and one for which a new trial should be granted.

The instruction assumes, and, as was admitted on the argument, properly assumes, that knobs of metal, wood, &c., connected with a shank and spindle, in the mode and by the means used by the patentees in their manufacture, had been before known, and were in public use at the date of the patent; and hence the only novelty which could be claimed on their part was the adaptation of this old contrivance to knobs of potter's clay or porcelain; in other words, the novelty consisted in the substitution of the clay knob in the place of one made of metal or wood, as the case might be. And in order to appreciate still more clearly the extent of the novelty claimed, it is proper to add, that this knob of potter's clay is not new, and therefore constitutes no part of the discovery. If it was, a very different question might arise; as it might very well be urged, and successfully urged, that a knob of a new composition of matter, to which this old contrivance had been applied, and which resulted in a new and useful article, was the proper subject of a patent.



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The novelty would consist in the new composition, made practically useful, for the purposes of life, by the means and contrivances mentioned. It would be a new manufacture, and none the less so, within the meaning of the Patent Law, because the means employed to adapt the new composition to a useful purpose were old or well known.

But in the case before us, the knob is not new, nor the metallic shank and spindle, nor the dovetail form of the cavity in the knob, nor the means by which the metallic shank is securely fastened therein. All these were well known, and in common use; and the only thing new is the substitution of a knob of a different material from that heretofore used in connection with this arrangement.

Now, it may very well be, that, by connecting the clay or porcelain knob with the metallic shank in this well-known mode, an article is produced better and cheaper than in the case of the metallic or wood knob; but this does not result from any new mechanical device or contrivance, but from the fact, that the material of which the knob is composed happens to be better adapted to the purpose for which it is made. The improvement consists in the superiority of the material, and which is not new, over that previously employed in making the knob.

But this, of itself, can never be the subject of a patent. No one will pretend that a machine, made, in whole or in part, of materials better adapted to the purpose for which it is used than the materials of which the old one is constructed, and for that reason better and cheaper, can be distinguished from the old one; or, in the sense of the Patent Law, can entitle the manufacturer to a patent.

The difference is formal, and destitute of ingenuity or invention. It may afford evidence of judgment and skill in the selection and adaptation of the materials in the manufacture of the instrument for the purpose intended; but nothing more.

I remember having tried an action in the circuit in the District of Connecticut, some years since, brought upon a patent for an improvement in manufacturing buttons. The foundation of the button was wood, and the improvement consisted in covering the face with tin, and which was bent over the rim so as to be firmly secured to the wood. Holes were perforated in the center, by which the button could be fastened to the garment. It was a cheap and useful article for common wear, and in a good deal of demand.

On the trial, the defendant produced a button, which had been taken off a coat on which it had been worn before the Revolution, made precisely in the same way, except the foundation was bone.

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The case was given up on the part of the plaintiff. Now, the new article was better and cheaper than the old one; but I did not then suppose, nor do I now, that this could make any difference, unless it was the result of some new contrivance or arrangement in the manufacture. Certainly it could not, for the reason that the materials with which it was made were of a superior quality, or better adapted to the uses to which the article is applied.

It seemed to be supposed, on the argument, that this mode of fastening the shank to the clay knob produced a new and peculiar effect upon the article, beyond that produced when applied to the metallic knob, inasmuch as the fused metal by which the shank was fastened to the knob prevented the shank from acting immediately upon the knob, it being inclosed and firmly held by the metal; that for this reason the clay or porcelain knob was not so liable to crack or be broken, but was made firm and strong, and more durable.

This is doubtless true. But the peculiar effect thus referred to is not distinguishable from that which would exist in the case of the wood knob, or one of bone or ivory, or of other materials that might be mentioned.

Now, if the foregoing view of the improvement claimed in this patent be correct, it is quite apparent that there was no error in the submission of the questions presented at the trial to the jury; for unless more ingenuity and skill in applying the old method of fastening the shank and the knob were required in the application of it to the clay or porcelain knob than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skillful mechanic,—not that of the inventor.

We think, therefore, that the judgment is, and must be, affirmed.

Mr. Justice WOODBURY dissented.

I feel obliged to dissent from my brethren in this case. It is chiefly, however, in regard to the manner in which some of the facts were submitted to the jury; but, involving as it does an important principle in the practice under our patent system, it may be useful to explain the grounds of my dissent.

It is agreed, that in July, 1841, John G. Hotchkiss and two others obtained a patent for what they described as “a new and useful improvement in making door and other knobs of all kinds of clay used in pottery, and of porcelain.”

The first question of law which arises on the record, is whether the

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patent covered merely the knob, the bulbous handle, or included also the shank or spindle, and the mode of fastening it to the handle.

The charge of the judge at the trial, as drawn up in the exceptions, seems to have proceeded on the ground that the patent and invention covered both the knob and mode of fastening. Whether this was a correct construction; does not, however, seem to be very material, when we consider the instructions given to the jury in other respects; and that they were equally applicable to the bulbous handle alone, or the handle with its dovetail hollow, or the handle and the shank combined.

If both parties acquiesced below in the idea that the patent was not only for such a knob, but the combination of such a knob with the shank in the mode described, and the charge was predicated on that view, it is, perhaps, not allowable here to take a different position.

In order to understand clearly what is deemed objectionable in the course pursued below, it may be noticed that the chief grounds of objection to the patent thus construed below seem to have been, that the invention was not original, nor of a character to be patentable.

The statement in the bill of exceptions is in some respects obscure. But the substance of the instruction on this, as set out there, is, that if the invention had been made before or was now confined, "so that the knob of clay or porcelain is the mere substitution of one material for another,"—"the material being in common use, and no other ingenuity or skill being necessary to construct the knob than that of an ordinary mechanic acquainted with the business,—the patent is void," &c.

The counsel for the plaintiffs next requested the court to proceed further, and charge the jury, that "if the said knob of clay or porcelain so attached were an article better and cheaper than the knob theretofore manufactured of metal or other materials, the patent was valid." But the court did not give any such instruction. In this, I think, was the chief error. From the record, I feel bound to believe that evidence was offered on both sides as to the originality and utility of the knob, and its mode of combination with the shank. It would seem, then, to have been the duty of the court below to instruct the jury, that it was their province to decide not only on which side the evidence preponderated, but if the invention was cheaper and better than what preceded it, that protection should be given to it as patentable.

In either view, considered as an invention of the knob alone, or the knob and handle combined, the chief question is still the same,

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whether proper instructions as to its being patentable, and all the proper instructions which the circumstances required, were given.

Now, on the point as to the invention being patentable, the direction virtually was to consider it not so, if an ordinary mechanic could have made or devised it; whereas, in my view, the true test of its being patentable was if the invention was new, and better and cheaper than what preceded it. This test, adopted by the Circuit Court, is one sometimes used to decide whether the invention for which a patent has been obtained is new enough or distinguished enough from a former invention to prevent it from being an infringement, and to justify a new patent for it,—and not, as here, whether it is valuable or material enough *per se* to be protected by any patent.

Whenever the kind of test adopted below is used otherwise than to see if there has been an infringement or not, it is to ascertain whether the invention is original or not, that is, whether it is a trifling change, and merely colorable, or not. Webster on Sub. Mat., 25; Curtis on Patents, secs. 6, 7; 2 Gallis. C. C., 51; 1 Mason C. C., 182. But it is impossible for an invention to be merely colorable, if, as claimed here, it was better and cheaper; and hence this last criterion should, as requested by the plaintiffs, have been suggested as a guide to the jury.

Then, if they became convinced that the knob in this case, by its material, or form inside, or combination with the shank, was in truth better and cheaper than what had preceded it for this purpose, it would surely be an improvement. It would be neither frivolous nor useless, and, under all the circumstances, it is manifest that the skill necessary to construct it, on which both the court below and the court here rely, is an immaterial inquiry, or it is entirely subordinate to the question whether the invention was not cheaper and better. Thus, some valuable discoveries are accidental rather than the result of much ingenuity, and some happy ones are made without the exercise of great skill, which are still in themselves both novel and useful. Such are entitled to protection by a patent, because they improve or increase the power, convenience, and wealth of the community.

Chancellor Kent has truly said, (2 Kent's Com., 371,) "The law has no regard to the process of mind by which the invention was accomplished, whether the discovery be by accident, or by sudden or by long and laborious thought." See, also, *Earl v. Sawyer*, 4 Mason C. C., 1, 6; *Crane v. Price*, Webster's Pat. Cases, 411.

In this last case, Chief Justice Tindall goes quite as far as Chancellor Kent, and says: "In point of law, the labor of thought or experiment and the expenditure of money are not the essential grounds

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of consideration on which the question whether the invention is or is not the subject-matter of a patent ought to depend. For if the invention be new and useful to the public, it is not material whether it be the result of long experiments and profound research, or whether by some sudden and lucky thought, or mere accidental discovery."

So in *Earle v. Sawyer*, 4 Mason, 1, the doctrine settled is, that "a combination, if simple and obvious, yet if entirely new, is patentable. And it is no objection to it, that up to a certain point it makes use of old machinery." And Justice STORY says, in so many words: "It is of no consequence whether the thing be simple or complicated, whether it be by accident, or by long, laborious thought, or by an instantaneous flash of the mind, that it was first done." "The law looks to the fact, and not the process by which it is accomplished." Page 6.

It is thus apparent, to my mind, that the test adopted below for the purpose to which it was applied, and which has just been sanctioned here, has not the countenance of precedent, either English or American; and, at the same time, it seems open to great looseness or uncertainty in practice.

But it has been urged here, that this invention was merely applying clay and porcelain to a new purpose, and that merely a new purpose, in our patent system, is not entitled to protection. 2 Story, 190, 412; *Losh v. Hague*, Webster Pat. Cases, 207; Curtis on Patents, 87. The meaning of this rule, however, as eviscerated from all the cases, is that the application of an old machine or old composition of matter, before patented, to a new object, or what is termed a double use, does not entitle one to a patent connected with this new object; because then there is no new machinery or new combination of old parts, as in merely applying a patent grist-mill to a new purpose of grinding plaster.

But it is entirely different if you apply an old earth, or old mechanical power, or old principle in physics, to a new object. There is then a new form adopted, or a new combination for the purpose. And though the elementary material be old, or the elementary principle operating be old, it being difficult to discover a new substance or new elementary principle, yet there is a new shape and consistency and use given, or a new *modus operandi*, which, if cheaper and better, benefits the world, and deserves protection and encouragement.

If these are the effects, however small the skill or ingenuity required to imitate them, they are not excluded from the aid of the laws by either principles or precedents. They are not mere double uses of a previous machine or composition; but a double or additional form or composition of an article for a new purpose.

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There is a new manufacture, as here of clay into knobs, or knobs with a dovetail hollow combined with a shank. The books are full of such slight changes in structure, composition, or mode of application, which were novel, and better in their results, and therefore upheld, and were not and could not be regarded merely as the application of an old machine to new purposes. Beside the new material and the new mode of fastening, when the results, as here, are considerably improved, they suffice to make the invention patentable. Webster on the Sub. Matter, 29, 30. These are, then, all required by the strictest law, viz., "diversity of method" and "diversity of effect." Phillips on Patents, 122.

Here, the new material for a knob, instead of former materials, was more durable than wood, was cheaper than iron, and very beautiful to the eye, instead of looking coarser. Its structure to receive a dovetailed shank and secure it by fused metal, rather than by a hole through and a screw at the end, appears to have been highly important; and if embraced in the patent, as was probably considered in the court below, furnished an additional reason for instructing the jury to consider whether the knob in controversy was not cheaper and better than what preceded it.

The precedents are quite full on this, and some of them, in all respects, nearly in point. Similar to this was the hot blast, substituted for the cold in making iron, and a patent for it upheld. Nelson's Case, Webster P. C., 14. The blast was still air, but in a different condition, leading to new and useful results. So the use of the flame of gas to finish cloth rather than the flame of oil. Webster P. C., 99. So steel plates used instead of copper in engraving. *Kneass v. Schuyllkill Bank*, 4 Wash. C. C., 9, 11. That very closely resembles the present case.

So pit-coal, substituted for charcoal in making iron, has been deemed patentable (Webster P. C., 14); and anthracite for bituminous coal (273). There are also some strong opinions, besides these decisions, in favor of a change in metal for an instrument being alone sufficient for a patent, if more useful or cheaper. See Webster on Sub. Matter, 25, note, and Curtis on Patents, sec. 8. Phillips on Patents, 134,—if there be any contrivance connected with it. Indeed, why should it not be sufficient? A new mode of operating, or a new composition to produce better results, is the daily ground for a patent. All which the act of Congress itself requires, is that the invention be for "any new and useful improvement on any art, machine, manufacture, or composition of matter," &c. 5 Stat. at Large, p. 119, sec. 6.

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Syllabus.

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Must it not, then, be considered such an improvement, if operating with new materials both cheaper and more durable?

Who cannot realize, that since the improved mode of cutting, boring, and shaping, the substitution of iron for wood in many manufactures might not often be a gain in strength and durability, quite beyond any difference in expense, and be justly patentable? Who, too, would not deem it material to gain by the use of wood or leather, or a cheap metal, instead of gold and silver, for some manufacture or mechanical purpose, when it can be done with increased benefit as well as cheapness? And why is he not a benefactor to the community, and to be encouraged by protection, who invents a use of so cheap an earth as clay for knobs, or in a new form or combination, by which the community are largely gainers?

On the whole case, then, it seems to me that justice between these parties, as well as sound legal principle, requires another trial on instructions upon some points omitted, and instructions in some other respects different in law, from what were given in this instance at the first trial.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Ohio, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

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PETER HOGG AND CORNELIUS H. DELAMATER, PLAINTIFFS IN ERROR,  
v. JOHN B. EMERSON.

(11 Howard, 587.)

1. The decision of this court in the case of *Hogg v. Emerson*, 6 Howard, 437, reviewed and affirmed.
2. The specification of Emerson's patent "for certain improvements in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land," constituted a part of the patent, and must be construed with it. Anterior to 1836, the law did not imperatively require that the specification be made a part of the patent, but the inventor had a right to advise the Commissioner of Patents to make the specification a part of the patent, and it was peculiarly proper that he should comply with the request.
3. This court again decides that the patent is sufficiently clear and certain, and does not cover more ground than one patent may cover. Only one is necessary for two kindred and auxiliary inventions.

## Statement of the case.

4. The drawings which accompany the specification may be referred to for illustration. Within what time drawings ought to have been replaced, after the destruction of the Patent Office by fire, so as to avoid the imputation of negligence or of a design to mislead the public, was a question which was properly left to the jury.
5. The principles stated, within whose operation a jury can properly act in assessing damages against the maker of a patented machine.

THIS case was brought up from the Circuit Court of the United States for the Southern District of New York.

It was reported in 6 Howard, 437, and at the conclusion of the report of that case is the following note :

“NOTE.—After the delivery of this opinion, the counsel for the plaintiffs in error suggested that other questions were made below, which they desired to be considered, and therefore moved for another *certiorari* to bring them up. This was allowed, and judgment suspended till the next term.”

Another *certiorari* was issued, which brought up the entire record. The case, as now to be reported, consists of three records, in parts. Instead of republishing those parts already reported, they will only be referred to; and if the reader is desirous to investigate the case thoroughly, he must read this report in conjunction with that in 6 Howard.

On the 8th of March, 1834, John B. Emerson obtained a patent for a new and useful improvement in the steam-engine, which is set forth, together with the schedule, in 6 Howard, 437, *et seq.*

At April Term, 1844, he brought an action of trespass on the case against Hogg and Delamater for an infringement of his patent-right. The declaration is inserted *in extenso* in 6 Howard. The defendants filed the general-issue plea, and gave the following notices :

“Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit.

“PETER HOGG AND CORNELIUS DELAMATER

v.

JOHN B. EMERSON.

“SIR: You will please to take notice, that, on the trial of the above-entitled cause, without waiving the right to require the plaintiff to make out all facts essential to support and prove his declaration and cause, and without admitting any part thereof, the defendants will, under the plea of the general issue aforesaid, give in evidence, prove, and insist upon the following special matter, of which notice is hereby given, pursuant to the statute, in addition to such other defense as they are by law entitled to make.



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Statement of the case.

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“I. That the patent granted to John B. Emerson, bearing date the 8th day of March, 1834, under which the said plaintiff claims, is void, for the following among other reasons :

“1. Because, although it is, in and by the schedule annexed to the said patent, recited that the said John B. Emerson had alleged that he had invented a new and useful improvement in the steam-engine, and in the mode of propelling therewith either vessels on the water or carriages on the land; and it is claimed that, in and by the said patent, the exclusive right and liberty of making, using, and vending to others to be used the said improvement was granted to the said John B. Emerson, his heirs, executors, administrators, or assigns, for the term of fourteen years from and after the date of the said patent; yet the said patentee did not, according to law, deliver with his application for the said patent, or at any other time, to any of the officers who were to consider his application, a written description of his said improvement or invention, and of the manner of using the same, in such full, clear, and exact terms as to distinguish the same from all other things before known, and to enable any person skilled in mechanics to make and use the said invention; and that the improvements claimed by the said John B. Emerson are not, in the said patent, or in the schedule thereto annexed, described in such full, clear, and exact terms as to distinguish the same from all other things before known, or to enable any person skilled in mechanics to make or use the said improvements; and that the said John B. Emerson did not deliver, with his said application for the said patent, or at any other time, to any of the officers who were to consider his application, a full explanation of his said improvements, and the several modes in which he had contemplated the application of the principle, by which they could be distinguished from other inventions, and he did not accompany his application with drawings and written reference, as required by law.

“2. Because the said patent is granted for an improvement in the steam-engine; and, in the schedule annexed to the said patent, the said John B. Emerson has claimed as his invention different and distinct improvements, to wit, in the steam-engine and in the paddle-wheel, either of which may be used singly and separately for the purpose indicated in said schedule. And although the said John B. Emerson, in the schedule annexed to the said patent, does not claim the invention of spiral paddle-wheels, but claims merely the invention of an improvement in spiral paddle-wheels already essayed, yet he has not, in the said schedule annexed to the said patent, described in what his said improvement in the said spiral paddle-wheels con-

## Statement of the case.

sists, so that any person skilled in mechanics can know wherein the paddle-wheels mentioned in the said schedule differ from spiral paddle-wheels before known and used; and because no distinction or discrimination is made between the parts and portions of the said propelling-wheel of which the said John B. Emerson may be the inventor or discoverer; the said defendants protesting, at the same time, that the said John B. Emerson has not been the inventor or discoverer of any part or portion of the alleged improvements.

"3. Because the thing patented, as set forth in the said patent, is different from the things claimed as the invention of the patentee in the schedule annexed to the patent. The thing patented is a new and useful improvement in the steam-engine; but, in the schedules annexed to the said patent, the thing claimed by the said patentee as his inventions is not only the alleged improvement in the steam-engine, but also the spiral propelling-wheel, and the application of the revolving vertical shaft to the turning of a capstan on the deck of a vessel; while the specification indicates only an improvement in the spiral paddle-wheel, without describing the same in such full, clear, and exact terms as to distinguish the same from all other things before known, or to enable any person skilled in mechanics to make or use the said improvement.

"4. Because the drawings of his alleged invention, as deposited in the Patent Office, do not agree with each other, nor with the specification to his letters patent annexed, and render it altogether doubtful and uncertain what his alleged invention truly and really was.

"II. And the said defendants will further give in evidence, and prove on the trial of the issue aforesaid, that the machine for propelling boats, alleged to have been made by them in violation of the right of the plaintiff in this case, was made, if made at all, under certain letters patent heretofore granted by the United States to one John Ericsson, to wit, on the 1st day of February, in the year 1838.

"III. And the said defendants will further give in evidence, and prove on the trial of the issue aforesaid, that there was at no time on file, or deposited in the Patent Office, whilst they were engaged in making machines under the said John Ericsson's patent, any specifications or drawings deposited by the said John B. Emerson, from which any person skilled in mechanics could construct a machine similar to the machines they have constructed under the patent of the said John Ericsson.

"IV. And the said defendants will further give in evidence, and prove on the trial of the issue aforesaid, that the specification to the letters patent of the said John B. Emerson annexed contained no

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Statement of the case.

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description of the inventions and improvements now alleged and pretended to be covered by his said letters patent, and claimed to be included therein.

“V. And the said defendants will further give in evidence, and prove on the trial of the issue aforesaid, that the said John B. Emerson was not the original inventor or discoverer of any part or parts of the propelling-wheel described in his said letters patent, or of any improvement in any part or parts of the said machine.

“VI. And the said defendants will further give in evidence, on the trial of the issue aforesaid, a printed description of a certain propelling-wheel, invented by Archibald Robinson, of London, which said description was published in one or more public works, and particularly in the seventh volume of the London Journal of Arts and Sciences, edited by W. Newton, and published in London in the year 1831, and extensively known to mechanics and engineers in the United States, tending to prove that the plaintiff was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, but that it had been described as aforesaid, in public works, before the supposed discovery thereof by the plaintiff.

“VII. And the said defendants will further give in evidence, on the trial of the issue aforesaid, the printed description of certain improvements in machinery for propelling steam-vessels, invented by Jacob Perkins, of London, as early as the year 1829, which said description was published in a public work, printed in London, in the year 1831, to wit, in the seventh volume of the London Journal of Arts and Sciences, edited by W. Newton, a well-known scientific journal, published in London in the year aforesaid. And the said defendants will further give in evidence, a plate, number nine in the said volume, containing an engraved delineation of the said invention,—all tending to prove that the plaintiff was not the original and true inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, but that it had been described as aforesaid, in a public work, before the supposed discovery thereof by the plaintiff.

“VIII. And the said defendants will further give in evidence, on the trial of the issue aforesaid, a printed description of a certain mode of propelling boats in the water by the application of sculling-wheels, or screw propelling-wheels, invented by Benjamin M. Smith, which said description was published, in the year 1830, in the sixth volume of the new series of the Franklin Institute, a scientific journal published in the city of Philadelphia, in the State of Pennsylvania, tend-

## Statement of the case.

ing to prove that the plaintiff was not the original and true inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new, but that it had been described as aforesaid, in a public work, before the supposed discovery thereof by the plaintiff.

“IX. And the said defendants will further give in evidence, and prove on the trial of the issue aforesaid, that the said machine, alleged in the plaintiff’s writ in this cause to have been made by the said defendants, does not in any of its parts resemble the machine described in the schedule annexed to the letters patent granted to the said plaintiff.

“X. And the said defendants will further give in evidence, and prove on the trial of the issue aforesaid, that the said John B. Emerson, if he was really the inventor of the improvements now alleged, pretended, and claimed by him, voluntarily abandoned the same to the public.

“XI. And the said defendants will further give in evidence, and prove on the trial of the issue aforesaid, that they have never made, used, or sold the machine patented by the said John B. Emerson, or any part thereof, nor any imitation of the said machine, nor of any part thereof.

“XII. And the said defendants will further give in evidence, and prove on the trial of the issue aforesaid, that the description and specification filed by the said plaintiff do not contain the whole truth relative to this invention or discovery.

“Dated New York, October 26, 1844.

“Yours, &c.,

P. A. HANFORD,

*“Attorney for Defendants.”*

“To PETER CLARK, Esq., *Attorney for Plaintiff.*”

“Circuit Court of the United States of America for the Southern District of New York, in the Second Circuit.

“PETER HOGG AND CORNELIUS DELAMATER

v.

JOHN B. EMERSON.

“SIR: You will please to take notice, that, on the trial of the above-entitled cause, the defendants, in addition to the various matters set forth in the notice heretofore given in this cause, under date of the 26th of October, 1844, will, under the plea of the general issue, prove and insist upon the following special matter, of which notice is hereby given pursuant to statute.

“The said defendants will give in evidence, on the trial of the issue

## Statement of the case.

aforesaid, the letters patent granted to John Ericsson, by the English government, in 1836, and the letters patent granted him, by the government of the United States, in the years 1838 and 1840.

"The said defendants will also give in evidence copies of letters patent, granted by the United States government, to Josiah Copley, for a spiral propeller, under date of May 22, 1830; and to John L. Sullivan, under date of March 24, 1817, for a submarine propeller; and to Edward P. Fitzpatrick, under date of November 23, 1835, for a screw for propelling boats; and to James Widdifield, under date of October 11, 1815, for propelling boats by screw-wheel; and to John L. Smith, under date of September 18, 1835, for propelling boats by screw-wheel; and to Henry W. Wheatley, under date of December 30, 1818, for propelling boats by screw-power; and to Jesse Ong, on the 22d of May, 1837, for propelling paddle-wheels.

"The said defendants will also give in evidence the Digest of Patents issued by the United States, published under the superintendence of the Commissioner of Patents, in 1840, and more particularly pages 219-225 of the same.

"The said defendants will also give in evidence a description of certain improvements in propelling vessels, communicated by Charles Cummerow, of London, and published in Newton's London Journal, second series, eighth volume, page 144; which volume the said defendants will give in evidence.

"The said defendants will also give in evidence a description of certain improvements in the construction and adaptation of a revolving spiral paddle, for propelling boats and other vessels, patented by the British government to Bennet Woodcroft, of Manchester, in the county palatine of Lancaster, printed and published in Newton's Journal, third series, first volume, page 349; which volume the said defendants will give in evidence.

"The said defendants will also give in evidence the seventh volume of the Repertory of Patent Inventions, for 1837, published in London, and the copy, printed at page 172 of the same, of certain letters patent granted to F. P. Smith for an improved propeller.

"The said defendants will also give in evidence certain letters patent, issued by the government of the United States, to Francis P. Smith, for an improved propeller, bearing date the 12th day of November, 1841.

"The said defendants will also give in evidence, that the alleged invention of the said plaintiff, or so much thereof as the said plaintiff may allege or claim that the said defendants have infringed, was invented, known, and used before the same was patented or invented

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by the said plaintiff. And the said defendants will prove the said prior use and knowledge of the said alleged improvement or invention, and where the same had been used, by Dr. Thomas P. Jones, who resides in the city of Washington, in the District of Columbia.

"The said defendants will also give in evidence the sixth volume of the Journal of the Franklin Institute, new series, page 149, where is contained an account of the spiral propeller above referred to, patented to Josiah Copley, and the fifth volume of the same, new series, page 136, where is contained a notice of the propeller patented to Benjamin P. Smith.

"The said defendants will also give in evidence certain letters patent granted to John S. Trott, of Boston, by the government of the United States, under date of June 2, 1818, for propelling wheels for boats by animal-power.

"Dated New York, October 27, 1845.

"Yours, &c.,

P. A. HANFORD,

*"Attorney for Defendants."*

"To PETER CLARK, ESQ., *Attorney for Plaintiff.*"

In May, 1847, the cause came on for trial. Both plaintiff and defendant examined many witnesses. The substance of the testimony, on the part of the defendants, is stated in the argumentative opening of their counsel in this court, which is copied in order to show their view of the evidence. After it was closed, the counsel for the defendants made the following prayers to the court to instruct the jury:

"1. That the claim of the plaintiff, as set forth in his specification annexed to his letters patent, embraces the entire spiral paddle-wheel. The claim is, therefore, too broad upon the face of it, and the letters patent are void upon this ground, and the defendants are entitled to a verdict.

"2. That if the court should depart from the language of the patentee, in which he has made his claim, for the purpose of giving to that claim a limitation which may not be too broad, it could not clearly, or with any reasonable certainty, or without resorting to conjecture, be determined by the court what the claim was; and the patent is, therefore, void for ambiguity, and the defendants are entitled to a verdict.

"3. That the patent is void upon its face, for this: that, purporting to be a patent for an improvement, and specifying that the invention is of an improved spiral paddle-wheel, differing essentially from any which have been heretofore essayed, without pointing out in what the difference consists, or in any manner whatever indicating the im-

## Statement of the case.

provement by distinguishing it from the previously-essayed spiral wheels, it is wanting in an essential prerequisite to the validity of letters patent for an improvement.

"4. That the patent is void upon its face, for this: that it embraces several distinct and separate inventions, as improvements in several distinct and independent machines susceptible of independent operation, not necessarily connected with each other in producing the result aimed at in the invention, and the subject-matter of separate and independent patents.

"5. That inasmuch as it appears conclusively, by the deposition of Arthur L. McIntyre, the officer in the Patent Office of the United States who has the care and custody of the drawings therein filed, that on the 12th day of February, 1844, the plaintiff filed a drawing, sworn to by him as a correct delineation of his invention, which drawing had been on file since the 5th day of May, 1841, when it was there deposited by the plaintiff, unattested; that said drawing became a part of the record of the plaintiff's patent, and that the said record was then complete; and the rights and privileges of the plaintiff, under the act of Congress of March 3, 1837, were exhausted by the filing of said attested drawing, and therefore said drawing was the one which (if any) should have been introduced in evidence as the recorded delineation of the invention, and the second drawing subsequently filed and introduced in evidence should be disregarded by the jury.

"6. Though inasmuch as it appears conclusively, by the deposition of Arthur L. McIntyre, as before stated, that on the 12th day of February, 1844, the plaintiff filed a drawing, sworn to by himself as a correct delineation of his invention, which drawing had been on file since the 5th day of May, 1841, when it was there deposited by the plaintiff, unattested; that said drawing became a part of the record of plaintiff's patent, and that as against these defendants, who, by legal presumption, were notified of the nature and character of the invention of said first drawing, he is now estopped from asserting that the same is not a true delineation of his invention, either by the testimony of witnesses, or by the introduction of a second and different drawing.

"7. That the rule of law which declares the drawings for patentee to be part of his patent, and that they may be referred to for the purpose of helping out the specification, should be limited to those cases in which the drawings are either annexed to or referred to in the specification; and that even in such case the drawings cannot be

## Statement of the case.

resorted to for the purpose of adding to, or in any manner enlarging, the claim as set forth in the specification.

"8. That if the second drawing, which has been exhibited in evidence, is to be regarded as a part of the plaintiff's patent, and to be referred to to help out the specification, there must be a conformity between them. If they are substantially at variance, and incongruous, and inconsistent with each other, it is a fatal defect in the patent, which alone is sufficient to prevent the recovery of the plaintiff.

"9. That if, from the testimony, the jury believe that the placing of the paddles obliquely upon the rim of the wheel, sworn to by John S. Trott as having been done by him in 1818, was substantially the same in principle as placing them spirally upon said rim, the defendants are entitled to a verdict.

"10. That the plaintiff must satisfy the jury, to sustain the only judicial construction of which the patent admits, that he is the first and original inventor of the spiral form of the propelling float; and if, from the evidence in relation to the patent and wheel of Benjamin M. Smith, in 1829,—of Ebenezer Beard, in and of the spiral float used by John Stevens, in 1805,—they believe that this spiral form was not new in the plaintiff, but was known and used before his patent, that upon this ground the defendants are entitled to a verdict.

"11. That if the jury believe, from the specification of the plaintiff, and the testimony, that he designed to express his improvement to consist in the trough form given to the propelling plates by bending them along the center, so that the sides of the plates shall be at right angles, or nearly so, to each other, and that this trough form, thus produced previous to giving the plate the spiral curve longitudinally, is to be considered as of the essence of plaintiff's invention, then the defendants have not infringed upon his rights, and are entitled to a verdict.

"12. That if the jury believe, from the specification and the testimony, that neither a cylindrical band nor the twisted spokes were described by the plaintiff as constituting a part of the paddle-wheel by him patented, the same cannot be added as a component part of his invention, by their insertion in a drawing filed ten years after the issuing of his letters patent.

"13. That from the silence in the specification, both as to the hoop or cylindrical band and twisted spoke, notwithstanding their delineation in the drawing, the jury must infer one of two things: either that the plaintiff did not invent, and therefore did not describe them, or that they were (as his witness Allaire in substance testified) not the



## Statement of the case.

subject-matter of invention at the time at all, being old and well-known parts of the machine described.

"14. That unless the jury believe, from the testimony, that the plaintiff, before the issuing of his letters patent, actually reduced his alleged invention to practice, the patent is void, and the defendants are entitled to a verdict.

"15. That if, from the testimony, the jury believe that Captain Ericsson actually reduced the propelling-wheels to practice, such as were constructed by the defendants, before the same were reduced to practice by the plaintiff, the defendants are entitled to a verdict.

"16. That the exclusive rights of a patentee are to make as well as to use, and vend to others to be used; and that the rule of damages, as against the manufacturer who has invaded the exclusive right to make, are the profits which he has derived, or which the plaintiff might have derived, from such making, because it is the sum which, by his invasion, he has prevented the patentee from obtaining.

"17. That if, from the evidence, the jury are satisfied that no propelling-wheels were made by the defendants between the 27th of March, 1844, (the date of the alleged completion of the record of the plaintiff's patent, under the act of March 3, 1827,) and the commencement of this suit, in April following, upon this ground the defendants are entitled to a verdict.

"18. That the invention of the plaintiff, as described in his specification, as illustrated by his drawing, cannot be regarded as a combination of the several parts of the wheel. As a combination, the invention is not brought out in the specification or drawings, and such a view of the case is entirely inadmissible."

But the court refused to instruct the jury according to the prayers of the defendants, and charged them as follows:

(That part of the charge which was brought up by the record in 6 Howard is there printed; but the *certiorari* having brought up the residue, it is now printed entire.)

"The court, in charging the jury, submitted to them, as a question of fact, whether the drawings made by Dr. Jones, in 1844, of the paddle-wheel of the plaintiff, were substantially in conformity with the drawing filed and model deposited in the Patent Office in 1834; that if this fact was found in the affirmative, it was not seriously disputed but that the wheel of Ericsson was similar to one constructed from the specification and drawing of the plaintiff, when taken together.

"The court further charged, that if the jury found the above question in the negative, then it would become necessary for them to

## Statement of the case.

inquire whether the specification, without the aid of the drawing, was sufficient to enable a mechanic of ordinary skill to construct the plaintiff's wheel,—such a one as could be constructed with the aid of it.

“The court further charged, that the claim of the plaintiff was for an improvement upon the spiral paddle-wheel or propeller; that by a new arrangement of the parts of the wheel, he had been enabled to effect a new and improved application and use of the same in the propulsion of vessels; that the ground upon which the claim is founded was this: it is the getting rid of nearly all the resisting surface of the wheels of Stevens, Smith, and others, by placing the spiral paddles or propelling surfaces on the ends of arms, instead of carrying the paddles themselves in a continued surface to the hub or shaft. It is claimed that a great portion of the old blade not only did not aid in the propulsion, but actually impaired its efficiency, and also that the improved wheel is made stronger.

“It was made a question on the former trial whether the plaintiff did not claim, or intend to claim, the entire wheel; but we understand it to be for an improvement upon the spiral paddle-wheel, claimed to be new and useful in the arrangement of its parts, and more effective by fixing the spiral paddles upon the extremity of the arms at a distance from the shaft.

“The court further, in charging the jury, submitted to them the question, whether the plaintiff was the first and original inventor of the improvement, referring them to the evidence upon this branch of the case.

“The court further instructed the jury, that the description of the invention was sufficient, and that the objection that the patent embraced several distinct discoveries was untenable.

“That the filing of imperfect drawings of his wheel in 1841 did not preclude the plaintiff from filing a corrected one in 1844, and that the drawing could be referred to in aid of the specification, though not annexed to the patent, or referred to in the specification; if it was filed with the application in the Patent Office at the time of the taking out of the patent, it is then a part of the record.

“That if the drawing and specification were so contradictory that a mechanic of ordinary skill could not construct the wheel, the patent was void. But if the latter was ambiguous, obscure, or doubtful, the drawing might be referred to to remove the difficulty.

“That the omission or neglect of the patentee to bring his improvement into public use did not forfeit his right to the invention, and that the fact of Ericsson's propeller having been brought into public use

## Statement of the case.

first did not give his patent priority, if the plaintiff was the first and original inventor.

"We do not understand that the original inventor and patentee, in order to enable him to maintain an action for an infringement, must prove that he put his patent in use by actually building a boat, and running her with a propeller; it is sufficient if he shows, by his experiments, model, and descriptions, that his improvement is useful.

"On the question of damages, the court instructed the jury, that the settled rule was to give the actual damages that the plaintiff had sustained. And it was apprehended, as applied to the case before them, that that would be the sum the patentee was entitled to for the right to make his propeller, to be used in the several vessels built by the defendants, and in which Ericsson's propeller had been placed by them.

"That the damages were not necessarily confined to the making of the wheels between March, 1844, when the drawings were restored to the Patent Office, and the bringing of the suit. Such a limitation assumes that there can be no infringement of the patent after the destruction of the records, in 1836, until they are restored to the Patent Office, and that during the intermediate time the rights of the patentee might be violated with impunity. We do not assent to this view.

"In the first place, the act of Congress providing for the restoration was not passed until the 3d of March, 1837; and in the second place, in addition to this, a considerable period of time must necessarily elapse before the act would be generally known; and then a still further period before copies of the drawings and models could be procured. Patentees were not responsible for the fire, nor did it work a forfeiture of their rights.

"The ground for the restriction claimed is, that the community have no means of ascertaining, but by a resort to the records of the Patent Office, whether the construction of a particular machine or instrument would be a violation of the rights of others, and the infringement might be innocently committed.

"But if the embarrassment happened without the fault of the patentee, he is not responsible for it; nor is the reason applicable to the case of a patent that has been published, and the invention known to the public. The specification in this case had been published. It is true, if it did not sufficiently describe the improvement without the aid of the drawing, this fact would not help the plaintiff.

"If there were unreasonable delay and neglect in restoring the records, and in the meantime a defendant had innocently made the

## Argument for the plaintiffs in error.

patented article, a fair ground would be laid for a mitigation of the rule of damages, if not for withholding them altogether; and the court left the question of fact, as to reasonable diligence of the patentee or not, in this respect, and also all questions of fact involved in the points of the case for the defendants, to the jury."

The counsel for the defendants having taken an exception to all that part of the charge which was inconsistent with their prayers, brought the case up to this court.

It was argued by *Mr. John O. Sargent*, from a brief filed by himself and *Mr. Johnson*, for the plaintiffs in error, and by *Mr. Gillet*, for the defendant in error.

The counsel for the plaintiffs in error stated the case as follows:

On the 8th of March, 1834, John B. Emerson obtained letters patent of the United States for certain improvements in the steam-engine. In December, 1836, the copy of the letters in the Patent Office, with the drawing and the model, was destroyed by fire. In 1837, Congress passed an act calling upon inventors whose models and drawings and letters had been destroyed, to replace them. 5 Stat. at Large, 191. In 1841, Emerson recorded his letters anew, and filed an unattested drawing. In 1844, February 12, he completed his record by swearing to said drawing, and filing it in the Patent Office. In March, 1844, he visited Washington, and, on consultation with Dr. Jones, prepared a new drawing, and swore to it, and filed it. In the month of May, he commenced a suit against Hogg and Delamater for making the Ericsson propeller.

In the year 1835, the instrument known as the Ericsson propeller was in operation in London. In 1838, it was patented in the United States. From 1839 to 1844, it was made by manufacturers in New York and elsewhere, without hinderance or molestation, till the suit was commenced against Hogg and Delamater. This instrument is a cylindrical band, supporting a series of spiral planes, and sustained on the shaft by two or more twisted spokes. The spokes and the band constitute its peculiar and patentable features.

John B. Emerson's specification contains no allusion to a cylindrical band or a twisted spoke. His drawing filed in March, 1844, adopts and adds these features. The only evidence tending to show that they were contemplated by him at any time, is a model said to have been made in 1837, two years after Ericsson's propeller was in operation in London. This model contains three hoops, and nine or more spiral arms. From this model of 1837, and information of the patentee, Dr. Jones made the drawing of 1844.

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Hogg and Delamater were iron-founders in the city of New York. They made no propellers to use, and used none; they merely manufactured them to order. They had no interest whatever in the patent-right of Captain Ericsson. No evidence appears in the case, tending to show any such interest.

It is not pretended that J. B. Emerson ever, at any time, reduced his wheel to practice, until the year 1843, when he made an experiment with it in the harbor of New Orleans. All that we know of it, therefore, prior to the year 1837, is derived from the drawing made from the model of 1837, or the statement of the patentee himself, and the formal oath that this drawing was a correct delineation of his invention.

The attempt, therefore, to incorporate the spiral spoke, and the cylindrical band or hoop, into Mr. J. B. Emerson's patent, rests exclusively upon his own allegation, which is unsupported entirely by the specification. Emerson's own witnesses admit that there is no mention of these features in the specification, and Dr. Jones, Keller, Birkbeck, Dunham, Belknap, Bartol, Cunningham, Mapes, Cox, and Kemp swear distinctly that the specification, in this respect, contradicts the drawing. It is not denied that the absence of these would destroy every point of resemblance between Emerson's wheel and Ericsson's propeller.

It was distinctly proved, by John S. Trott and Nathan Rice, that the entire wheel of Ericsson, except the spiral twist of the propelling blade and the spiral twist of the arm, was in use in 1818, and then patented by Trott. Evidence was also offered tending to show that Trott's wheel, with the oblique float, operated on the same principle with Ericsson's wheel, with the spiral float.

It was distinctly proved, that spiral wheels, with arms, employed at the stern, and submerged, were successfully in use long before J. B. Emerson obtained a patent.

The trough form, which is so distinctly dwelt upon in Emerson's specifications, and which, in fact, constitutes the only feature described and relied upon, does not exist in the Ericsson propeller. The latter instrument employs only spiral planes, which had been in use half a century.

In 1847, a verdict was rendered in the cause against the defendants below, and judgment taken thereon, on which a writ of error was allowed under the seventeenth section of the Patent Act, restricted to certain questions made at the trial, and upon certain conditions; among which were those of submitting the case on written arguments, within a limited time, and of paying the amount of the judg-

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ment into court. The cause was argued according to those conditions, and the court gave an opinion in the case, in which they decided, substantially, that the plaintiffs here were entitled to stand before this court like all other suitors, and that the writ, if granted, must be on the whole case.

Judgment was therefore suspended, on plaintiffs' suggestion of a diminution of the record, and a *certiorari* issued, by which the case is now brought before the court.

*Points.*

I. The defendant in error has no patent for an improved spiral paddle-wheel.

American authorities.—Phillips on Patents, 224, and cases; Curtis, 127, 208; *Sullivan v. Redfield*, Paine C. C., 442; *Shaw v. Cooper*, 7 Pet., 292, 315; *Evans v. Chambers*, 2 Wash. C. C., 125; *Barrett v. Hall*, 1 Mason, 476; *Whittemore v. Cutter*, 1 Gallis., 437; *Evans v. Eaton*, Peters' C. C., 340, 341; *Kneass v. Schuylkill Bank*, 4 Wash. C. C., 9; *Cutting et al. v. Myers*, 4 Wash. C. C., 220; 1 Stat. at Large, 319, secs. 1, 3.

English authorities.—Godson on Patents, 108, 113, and cases; *Neilson v. Harford*, Webst., 312, and arg.; *Rex v. Wheeler*, 2 Barn. & Ald., 350; S. C., 3 Merivale, 629; Glegg's Patent, Webst., 117; *Russell v. Cowley*, Webst., 470; *Househill v. Neilson*, Webst., 679; Webster on Patents, p. 65; Hindmarch, 41, 42, 509–511; Godson, 170.

II. If the defendant's patent is for the combination of instruments described in the specification, there is no pretense that the combination has been infringed; if for several improved machines, it cannot be supported in law. *Evans v. Eaton*, 3 Wheat., 454; *Barrett v. Hall*, 1 Mason, 447; *Moody v. Fiske*, 2 Mason, 112; *Wyeth v. Stone*, 1 Story, 290.

III. The claim of the specification is too broad, and the patent therefore void; and the patent does not distinguish the improvement from other inventions.

English authorities.—*McFarlane v. Price*, 1 Starkie, 199; *In re Nickels*, Hindmarch on Patents, 186; *Hill v. Thompson*, 3 Merivale, 622; S. C., 8 Taunton, 325; *Williams v. Brodie*, Davis' Pat. Cases, 96, 97; *Manton v. Manton*, Davis' Pat. Cases, 349; *Minter v. Wells*, 1 Webst., 130.

American authorities.—*Dixon v. Moyer*, 4 Wash. C. C., 69; *Evans v. Hettich*, 3 Wash. C. C., 425; *Lowell v. Lewis*, 1 Mason C. C., 189; *Ames v. Howard*, 1 Summer, 482; *Evans v. Eaton*, 3 Wheat., 454;

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*Woodcock v. Parker*, 1 Gallis., 438; *Whittemore v. Cutter*, 1 Gallis., 478; *Odiorne v. Winkley*, 2 Gallis., 51; *Barrett v. Hall*, 1 Mason, 447; *Sullivan v. Redfield*, Paine C. C., 441; *Evans v. Eaton*, 7 Wheat., 408; *Isaacs v. Cooper*, 4 Wash. C. C., 261; *Cross v. Huntly*, 13 Wend., 385; *Head v. Stevens*, 19 Wend., 411; *Kneass v. Schuylkill Bank*, 4 Wash. C. C., 9; *Morris v. Jenkins et al.*, 3 McLean, 250; *Peterson v. Woodler*, Ib., 248.

IV. The drawing filed March 27, 1844, was not legal evidence of the defendant's patented invention, because there was a drawing filed by the patentee on the 12th of February previous, which was, by the second section of the act of 1837, with his letters patent, the only legal evidence of his invention, as patented, that could be offered in any judicial court of the United States.

V. The patentee, after an alleged correction of his letters patent by filing the second drawing, could not, in law, avail himself of that correction to cover causes of action that had previously accrued; and, in the absence of proof of any subsequent infringements, the plaintiffs here were entitled to a verdict below. *In re Nickels*, Turner & Phillips, 44; S. C., 1 Webst., 659; Hindmarch on Patents, (Eng. ed.) 216, *et seq.*; *Wyeth v. Stone*, 1 Story, 290; *Woodworth v. Hall*, 1 Wood. & Min., 248, 389.

VI. The defendants below, having sought to establish, by the testimony of Jones, Keller, Birkbeck, Dunham, Belknap, Bartol, Stillman, Cunningham, Mapes, Cox, and Kemp, the non-conformity of Emerson's specification of 1834 to the drawing filed in 1844, and having disputed, at every step, that Ericsson's propeller, or anything like it, could be made by taking the two together, were entitled to the instructions sought by their eighth prayer; and the various instructions of the court on the subject of the drawing amounted distinctly to a denial of that prayer.

VII. The original letters patent were produced in evidence. There was no drawing annexed, referred to in them, or accompanying them. No case has gone so far as to say that any other drawing shall be permitted to enlarge or add to the specification. Curtis on Patents, 123, 125, 173, 174, and cases there cited; *Brooks v. Bicknell*, 3 McLean, 250, 261.

VIII. The wheel patented by John S. Trott, in 1818, having been proved to be identical with that made by Ericsson, with the single exception of the spiral curvature to the arms and the paddles, the ninth prayer of the defendants below should have been allowed.

IX. The court erred in rejecting a portion of C. M. Keller's deposition.

X. The court erred in admitting testimony as to the patent fee paid to Captain Ericsson as a measure of damages against the manufacturers.

XI. The court erred in refusing the sixteenth prayer, on the subject of damages; and in instructing the jury, as matter of law, that the actual damages sustained by Mr. Emerson, by the manufacture of the Ericsson propeller, was the sum the patentee was entitled to for the right to make his propeller, to be used in the several vessels built by the defendants, and in which the Ericsson propeller had been placed by them. The defendants were the manufacturers, built no vessels, used no propellers, sold no propellers, but were merely employed to make. The actual damage, by the invasion of the right to make, was the maker's profit, and not the patentee's fee. Curtis on Patents, 292-295, and cases there cited; *Bryce v. Dorr*, 3 McLean, 582; *Whittemore v. Cutter*, 1 Gallis., 429; *Earle v. Sawyer*, 4 Mason, 1, 12.

XII. Whether or not there was reason for withholding damages altogether, was a question for the court, and should not have been left to the jury, where there was no dispute about the facts, as in the case presented by the record. *Bend v. Hoyt*, 13 Peters, 263; *Ellis v. Paige*, 1 Pick., 43; S. C., 2 Ib., 71; *Livingston & Gilchrist v. Maryland Ins. Co.*, 7 Cranch, 506; *Gilbert v. Moody*, 17 Wend., 354; *Oliver v. Maryland Ins. Co.*, 7 Cranch, 495; *Reynolds v. Ocean Ins. Co.*, 22 Pick., 191.

XIV. Whoever first perfects a machine is entitled to the patent, and is the real inventor, although others may previously have had the idea, and made some experiments towards putting it in practice. He is the inventor, and is entitled to the patent, who first brings a machine to perfection, and renders it capable of useful operation. *Washburn v. Gould*, 3 Story, 133.

Of *Mr. Gillet's* argument for the defendant in error, the reporter has no notes.

Mr. Justice WOODBURY delivered the opinion of the court.

This is the same case which has been before us on a former occasion, as reported in 6 Howard, 437.

The decision there announced, on the points presented by that record, was accompanied by a ruling that, in writs of error in patent cases, all the questions of law which arose at the trial might be brought up, and not, as there, only such as the court below should deem reasonable. Thereupon the counsel for the plaintiffs in error



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moved for a *certiorari* to transfer here such other questions as had not been before brought up and decided.

This *certiorari* and a subsequent one having been allowed, the same counsel proceeded to argue the questions appearing on the whole record, as well those on which an opinion had already been pronounced, as the new questions arising on the additional parts of the record.

This was objected to by the defendants in error, but permitted by the court, on the ground that a division among them existed before, and that two, if not three, members of the court were now present, who were not when the former opinion was agreed to. On this state of things, having heard the whole case fully reargued, the first inquiry is, if any of the points before settled appear to have been ruled erroneously, either on the record as it then stood, or on it including the new matter since brought up.

It is very manifest that this matter does not relate to any of the former points, and consequently does not impair, or in any way affect them, or our decision before given upon them.

In the next place, has the new argument, or the further consideration of the case, presented anything which justifies a change of views on what was then settled? We think not.

Without repeating the whole reasoning and precedents stated in 6 Howard, in support of the former views of the court, we shall only submit a few further explanations concerning some of them.

On the leading question, whether the invention is sufficiently described in the letters patent, it may be sufficient to add, that this depends on what must be considered as a part of those letters.

The letters in this case were taken out in 1834, under the act of 1793, and the law did not then require the patentee or the Commissioner to make the specification a part of the letters patent, as it does by the act of 1836. But the inventor still had a right, if he pleased, for greater fullness and clearness, not only to file a specification, as such, and as the law directed, but to advise the Patent Office also to incorporate it into the letters as a part of them by express terms of reference. This it would be peculiarly proper for the officers of the government to do, as the language of the specification is the language of the inventor, and describes the invention in his own way, and, it is to be presumed, in the best way; whereas the language of the letters is that of the Commissioner of Patents or the President, who signs them, and if standing alone might, by mistake or accident, not fully describe the invention. Here, then, in order to avoid any such untoward result, they did expressly incorporate the whole specification

into the patent as "a part" of it, besides referring to it for "a description" of the improvement.

This the officers had a right to do, as grantors in deeds have a right to refer to other deeds or papers, and annex or incorporate them as a part of the instrument of conveyance. See cases cited in 6 Howard.

A similar course is often pursued in policies of insurance by the makers of them, and in other contracts, as well as in declarations on accounts annexed. That such a course, too, is prudent, and to be encouraged in the case of patents, is shown by Congress in the act of 1836, imperatively requiring it to be done thereafter.

The specification being, therefore, in this case, voluntarily annexed, and made, in express terms, a part of the patent, though before the law required it to be done, it still became a portion of the patent by general principles, as clearly as it does since by the words of the law. It follows, also, that, being thus adopted and recognized as "a part" of the patent itself, if the improvement is there described with due fullness and certainty, it is so described in the patent itself.

But it is manifest that it is thus described there. In the very first lines, it is set out not only as "an improvement in the steam-engine," but "in the mode of propelling therewith either vessels on the water or carriages on the land." These together constitute a full and satisfactory description of the whole. It is an "improvement in the steam-engine," not in generating steam, but in applying it; and after describing minutely the application of it for propelling carriages on land, it proceeds to point out, "when used for steamboats," how it is to be connected with "an improved spiral paddle-wheel."

After all this, no one, it is believed, could justly contend that the patent itself was defective, or likely to mislead in describing the improvement which the patentee claims to have invented.

Referring to the former opinion in this case for other reasons and decisions in support of this view, we proceed to the next objection. It is, that the improvement thus described is for more than one invention, and that one set of letters patents for more than one invention is not tolerated by law.

But grant that such is the result when two or more inventions are entirely separate and independent, (though this is doubtful on principle,) yet it is well settled, in the cases formerly cited, that a patent for more than one invention is not void, if they are connected in their design and operation. This last is clearly the case here. They all here relate to the propelling of carriages and vessels by steam, and only differ, as they must, on water, from what they are on land;

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a paddle-wheel being necessary on the former, and not on the latter, and one being used on the former which is likewise claimed to be an improved one. All are a part of one combination when used on the water, and differing only, as the parts must, when used to propel in a different element.

In *Wyeth et al. v. Stone et al.*, 1 Story, 288, in order to render different letters patent necessary, it is said, the inventions must be "wholly independent of each other, and distinct inventions for unconnected objects,"—as one to spin cotton, and "another to make paper."

Again, if one set of letters patent is permissible for one combination consisting of many parts, as is the daily practice, surely one will amply suffice for two or three portions of that combination.

The next point before decided was, that the description was sufficiently clear and certain. Under the instructions of the court, the jury found that it was clear enough to be understood by ordinary mechanics, and that machines and wheels could readily be made from it, considering the specification as a whole, and advertg to the drawings on file. This is all which the law requires in respect to clearness, and it does not appear necessary to add anything to what is cited and stated in the former opinion in support of the instructions given below on this point.

The court did right, too, in holding to the propriety of looking to the whole specification, and also to the drawings, for explanation of anything obscure. The drawings, then, being proper to be referred to in illustration of the specification, they could be restored when burnt, and if appearing in some respects erroneous, they could be corrected. That this last was done, and done well, was distinctly shown by Dr. Jones, a skillful draughtsman and expert. It would be unreasonable to prevent or refuse the correction of such errors, so as not to mislead nor cause contradictions; because, after all, it is the specification which governs, and the drawings merely illustrate. It is true, that it would not be proper to leave the drawings so long, not restored nor corrected, as to evince neglect, or a design to mislead the public; and the jury were allowed to decide what was a reasonable time for this purpose, under the circumstances of the case, and the duties imposed by law on the patentee. This being a point in part of law and in part of fact, it was properly submitted to the jury, and their finding must stand, unless it is shown, as has not been done, that illegal instructions were given to them concerning it, or that proper legal directions were omitted. See analogous cases,

Chitty on Bills, 336; 379; 9 East, 347; 1 Camp., 246; *Johnson v. Sutton*, 1 D. & E., 514; 2 Barn. & Adol., 857, 858.

In respect to another objection, of the claim being too broad, that was fully answered in the former opinion; and so was the objection that damages could not be recovered after the fire, and before the restoration of the specification and drawings.

Certain new points are also presented on the new matter brought here by the *certiorari*. Among them, no one seems specially relied on, which is not involved in those already considered, except the instructions on the rule for settling the whole damages. It is true, that the verdict appears large in amount. But if too large, and the jury were properly instructed on the subject, the fault is theirs rather than the court's, and cannot be corrected here.

It is not, however, clear that it is too large, as it does not appear to have exceeded, and, indeed, it rather falls short of, the price paid for a license to make an improvement like this, to be used in so many vessels. It is the making and selling to be used, and not the selling or buying or making alone, for which full damages are usually given. 10 Wheaton, 350; Curtis on Pat., 256, note 3; 3 McLean, 427. The court, therefore, being called on to lay down some general rule, very properly informed the jury, that such price might be a suitable guide, and it is the customary one followed for making and selling patent stoves, lasts, spokes, &c., and seems once to have been treated by law as the chief guide in all patent cases,—as the act of 1791, sec. 5, (1 Stat. at Large, 322,) gave three times its amount when one either made for sale or used a patented machine.

But that law being repealed, and the damages now left open for each case, the judge correctly added, that a fair ground existed for a mitigation below that amount, if the maker of the machine appeared in truth to be ignorant of the existence of the patent-right, and did not intend any infringement. That would not, however, furnish a reason, as was insisted by the plaintiffs in error, for allowing no damages when making the machine *to be used*, and not, as in some cases, merely for a model, or for fancy, or philosophical illustration. *Whittemore v. Cutter*, 1 Gallis., 429; *Jones v. Pearce*, Webster's P. C., 125; 3 McLean, 583. The intent not to injure, also, never exonerates, as is contended, in these cases, from all damages for the actual injury or encroachment, though it may mitigate them. *Bryce v. Dorr*, 3 McLean, 583. The further general suggestion by the judge, to give only the actual damages, was well calculated to prevent anything vindictive or in excess, and justified the jury to go still lower than they did, if appearing just to them, and as has sometimes been done

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in this class of cases. See *Lowell v. Lewis*, 1 Mason C. C., 182; 1 Gall. C. C., 420.

That, however, was a matter of discretion for the jury, under all the circumstances, and not a question of law for the court.

Nor will the consequence of damages so large as the present seem harsh, if thereby any further recovery should be prevented for using or selling as well as making the machine, but which point is not decided by us now, because not raised on the record. It may be added, however, in this connection, that the defendants are certainly relieved now from one consequence by way of damages or penalty which once existed, and which was to forfeit the materials of the machine to the patentee. See section 4 in act of April 10, 1790, 1 Stat. at Large, 111. It must be a very extreme case, too, where a judgment below should be reversed on account of damages like these in actions *ex delicto*, and when the instructions suggested to the jury the true general rule and the leading ground for mitigation, as well as against excess, and when, if appearing to be clearly excessive under all circumstances, a new trial could have been moved and had on that account in the Circuit Court.

Judgment below affirmed.

Mr. Chief Justice TANEY, Mr. Justice CATRON, Mr. Justice DANIEL, and Mr. Justice GRIER dissented.

Mr. Justice CATRON.

To the opinion just delivered, I dissent. I think the letters patent are for a single improvement on the steam-engine, and that the schedule has added two distinct inventions in addition: the one on the paddle to a wheel propelling machinery or a vessel of any kind in the water; and the second in applying the power of the shaft to turning a capstan by means of a cog-wheel. These two claims are entirely independent of the improvement claimed in the letters patent actually granted; this is for inventing a piston and shaft which turn a wheel without employing a crank. And as this controversy depends on a supposed infringement of the improved paddle, (which, in my judgment, is not covered by the letters,) I therefore think that the suit cannot be maintained on the face of the letters.

Secondly, if these three distinct improvements had been claimed and granted in the letters, and described in the schedule, then the patent would be void, as I think, because no more than one invention, distinct and disconnected from others, can be granted in the same letters. Such is the construction that has been given to the

legislation of Congress at the Patent Office, and is supposed by me to be the correct one. If three independent inventions can be patented and monopolized together, so any number may be. By this means, the grant may cover many fictitious claims, with some valid ones, which latter will stand protected, so that little or no risk will be run by obtaining a grant for that which is not new; and by this mode of proceeding at the Patent Office, fictitious claims may cover and assume to monopolize the ordinary implements now in use on the farm and in the workshop, and, yet more than is now the case, harass the public with fictitious and ill-founded claims to make and sell exclusively things in daily and extensive use. Although the claim may be fictitious, still this does not protect the public from harassment, as usually men using cheap implements cannot afford to litigate in the United States courts. It would be far better to allow the claim, unjust as it is, and pay the patentee his fraudulent demand, than incur the expense of a suit, which the patentee or his assignee may well afford to prosecute.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs, and damages at the rate of six per centum per annum.

AFFIRMED.

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THOMAS OTIS LE ROY AND DAVID SMITH, PLAINTIFFS IN ERROR, v. BENJAMIN TATHAM, JUNIOR, GEORGE N. TATHAM, AND HENRY B. TATHAM.

(14 Howard, 156.)

1. In a patent for improvements upon the machinery used for making pipes and tubes from lead or tin, when in a set or solid state, by forcing it under great pressure from out of a receiver through apertures, dies, and cores, the claim of the patentees was thus stated: "What we claim as our invention, and desire to secure by letters patent, is the combination of the following parts above described, to wit, the core and bridge, or guide-piece, the chamber, and the die, when used to form pipes of metal, under heat and pressure, in the manner set forth, or in any other manner substantially the same."
2. The Circuit Court charged the jury, "that the originality did not consist in the novelty of the machinery, but in bringing a newly-discovered principle into

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practical application, by which an useful article of manufacture is produced, and wrought pipe made as distinguished from cast pipe.”

3. This instruction was erroneous.

4. Under the claim of the patent, the combination of the machinery must be novel. The newly-discovered principle—to wit, that lead could be forced by extreme pressure, when in a set or solid state, to cohere and form a pipe—was not in the patent; and the question whether it was or was not the subject of a patent, was not in the case.

[Mr. Justice Curtis, having been of counsel for the defendants in error, upon the letters patent drawn in question in this case, did not sit at the hearing.]

THIS case was brought up by writ of error from the Circuit Court of the United States for the Southern District of New York.

The declaration was filed by the defendants in error on the 8th of May, 1847, to recover damages in a plea of trespass upon the case, from the plaintiffs in error and Robert W. Lowber, for the alleged infringement of their patent for new and useful improvements in machinery or apparatus for making pipes and tubes from metallic substances.

The declaration alleged that John and Charles Hanson, of Huddersfield, England, were the inventors of the alleged improvements, on or before the 31st of August, 1837.

That on the 10th of January, 1840, the Hansons assigned, in writing, to H. B. & B. Tatham, two of the defendants in error, the full and exclusive right to the said improvements.

That on the 29th of March, 1841, letters patent of the United States were granted to H. B. & B. Tatham, as assignees of the Hansons, for the said improvements.

That on the 12th of October, 1841, H. B. & B. Tatham assigned to G. N. Tatham, the remaining defendant in error, one undivided third part of the said letters patent.

That on the 14th of March, 1846, the said letters patent having been surrendered, on account of the defective specifications of the said improvements, new letters patent were issued therefor on an amended specification, whereby there was granted to the plaintiffs below, their heirs, &c., for the term of fourteen years from the 31st of August, 1837, the full and exclusive right of making, vending, &c., the said improvements, a description whereof was annexed to and made a part of such patent.

That the letters patent were of the value of \$50,000; and that the defendants below had wrongfully and unlawfully made, used, and

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vended the said improvements, and made lead pipe to the amount of 2,000 tons, thereby to the injury of the plaintiffs \$20,000.

To this declaration, the defendants Le Roy and Smith pleaded not guilty, the defendant Lowber making no defense, and permitting a default to be taken against him.

The cause was tried at the April Term, 1849, and a verdict rendered by the jury in favor of the plaintiffs for \$11,394, and costs, and a bill of exceptions was tendered by the defendants below.

On the trial of the cause below, the plaintiffs produced—

1. Their patent of 1846, and the specification referred to therein and making a part of the same.

2. They read in evidence certain agreements between the defendant Lowber and the defendants Le Roy and Smith.

3. They gave evidence tending to prove that J. & C. Hanson were the original and first inventors of the improvement; that the invention was a valuable one, &c.

4. That lead, recently become set, under heat and pressure, in a close vessel, would reunite perfectly after a separation of its parts; that in the process described in the said patent pipe was so made; that the Hansons were the first and original discoverers thereof; and that such discovery, and its reduction to a practical result in the mode described in the patent, was useful and important.

5. That the defendants Smith and Leroy had been jointly engaged with Lowber in making lead pipe upon the plan described in the letters patent, and selling the same, and had thus made and sold large quantities of pipe; that the agreement between them, relative to the manufacture of pipe, was colorable only, and was made as a cover to protect Le Roy and Smith, and throw the responsibility on the defendant Lowber, who was insolvent.

6. That the improvement described in the said letters patent was the same invention for which letters patent had been granted to the Hansons, in England, and to H. B. & B. Tatham here, as their assignees.

7. That the plaintiffs had been ready, and had offered to sell the said invention, and had sold the same for a large portion of the United States, within the last eighteen months.

The defendants below then read in evidence—

1. The description of the English patent to the Hansons.

2. The patent to H. B. & B. Tatham, of 1841, and the specification thereof.

3. The specification of an English patent granted to Thomas Burr, of 11th April, 1820.



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4. The patent and specification of Burroughs Titus, granted in 1831.

5. The patent granted to George W. Potter, in 1833.

6. The evidence of George Fox, tending to show the invention and use by him of a similar machine, in 1830.

7. The specification of a patent to John Hague, in 1822.

8. The specification of a patent granted to Busk & Harvey, in 1817.

9. The specification of a patent granted to Ellis & Burr, in 1836.

10. The specification of a patent granted to Joseph Bramah, in 1797.

11. The defendants then gave evidence tending to prove that J. & C. Hanson were not the original and first inventors of the combination of machinery described in the letters patent.

12. That the invention was not useful, nor the lead pipe, made upon the plan described, good.

13. That the combination of machinery described in public works as having been invented by Titus, Potter, Fox, Hague, Bramah, and Busk & Harvey, were substantially the same as that described in the plaintiffs' patent.

14. That lead, when recently become set, under heat and extreme pressure, in a close vessel, would not reunite perfectly after a separation of its parts; and that in the process as described in the plaintiffs' patent it was not in a set, but in a fluid state when it passed the bridge.

15. That the defendants Le Roy and Smith were not concerned in the manufacture of the pipe, or in making or using the machinery; that it was made for them by the defendant Lowber, at a certain price per hundred pounds; and that they had not infringed upon the patent of the plaintiffs.

16. That the improvement described in the plaintiffs' patent of 1846, was not the same invention as that for which letters patent had previously been granted to the Hansons, and to H. B. & B. Tatham.

17. That for the space of eighteen months, from the date of the patent of 1841, the plaintiffs had neglected to put and continue on sale to the public, on reasonable trust, the invention or discovery for which the said patent issued.

The evidence being closed, the case was argued before the jury, after the court had given the charge, which will be presently stated. The jury found a verdict for the plaintiffs, which, when increased by the court, amounted to \$11,748.60. The following bill of excep-

tions brought up the rulings of the court upon the several points made:

The evidence being closed, the judge charged the jury—

That the first question which it was material to determine, was what was the invention or discovery of John and Charles Hanson, for which their patent had issued, as the precise character of that invention had been the subject of controversy on the trial.

The patentees state, in their specification, that the invention consists in certain improvements upon, and additions to, machinery for making pipes of metal, capable of being pressed, as described in Burr's patent, dated April 11, 1820. They then described Burr's apparatus, and the process by which the pipe was made by it, and state the defects of that plan, in consequence of which, they say, it failed to go into general use.

These defects they claim to have overcome and remedied; and state that they had found that lead, and some of its alloys, when just set, or short of fluidity, and under heat and great pressure, in a close vessel, would reunite, after a separation of its parts, as completely as if it had not been separated; or, in other words, that under these circumstances it could be welded.

That on this discovery, and in reference to and in connection with it, they made a change in the machinery of Burr, by which they succeeded in making perfect pipes, and were enabled to use a bridge at the end of the cylinder and short core, and thus surmount the difficulty of the Burr machine.

They also state that they do not claim any of the parts—the cylinder, core, die, or bridge; but that they claim the combination when used to form pipes of metal, under heat and pressure, in the way they have described.

There can be no doubt that if this combination is new, and produces a new and useful result, it is the proper subject of a patent. The result is a new manufacture.

And even if the mere combination of machinery in the abstract is not new, still, if used and applied in connection with the practical development of a principle newly discovered, producing a new and useful result, the subject is patentable. To which last opinion and decision, the counsel for the defendants did then and there except.

In this view, the improvement of the plaintiffs is the application of a combination of machinery to a new end,—to the development and application of a new principle, resulting in a new and useful manufacture.

That the discovery of a new principle is not patentable; but it

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must be embodied and brought into operation by machinery, so as to produce a new and useful result.

Upon this view of the patent, it is an important question, for the jury to determine, from the evidence, whether the fact is established on which the alleged improvement is founded, that lead, in a set or semi-solid state, can thus be reunited or welded after separation.

The judge here commented briefly upon the testimony, referring to the experiments which were testified to, and the results of which were exhibited to the jury, on the part of the plaintiffs and defendants, and in continuation stated :

That there was one experiment, which was testified to by Mr. Keller, and the result of which was shown to the jury, which was made under circumstances that seem not to be subject to any misapprehension, and which, if he is not mistaken, and his testimony is correct, would seem to settle the question. But this was a question of fact, to be decided by the jury on the evidence. Hereupon the counsel for the defendants excepted to this part of the charge of the judge. That it had been objected that the improvement described in the patent of March 14, 1846, was different from that of March 29, 1841. The act only authorized a reissue for the same invention, the first specification being defective. That he had compared the descriptions contained in the two patents; and, though the language was in some parts different, it would be found that the improvement was substantially the same, and that he therefore apprehended they would have no great difficulty in this branch of the case,—to which the defendants' counsel excepted. That it was also objected that the plaintiffs' patent was invalid, for want of originality; that the invention had been before described in public works, and Bramah, Hague, Titus, Fox, and Potter were relied on by the defendants. That in the view taken by the court in the construction of the patent, it was not material whether the mere combinations of machinery referred to were similar to the combination used by the Hansons, because the originality did not consist in the novelty of the machinery, but in bringing a newly-discovered principle into practical application, by which a useful article of manufacture is produced, and wrought pipe made as distinguished from cast pipe. Hereupon the defendants' counsel excepted.

That in the patents referred to, from the year 1797 to 1832, the combination which was claimed to be identical was confessedly used for making pipe, by casting with fluid lead in a mould, and after it was set by the application of water, forcing it out.

And the question is, whether any of these inventions are substan-

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tially the same as the plaintiffs',—whether, even if by these modes, pipe had been successfully made for common use, it would have been made in the same manner as the Hansons',—to which opinion the counsel for the defendants excepted.

That it was further objected that the patentees have forfeited their rights, on account of having omitted to put and continue the invention on sale within eighteen months after the patent was granted, upon reasonable terms. The judge here commented upon the testimony on this part of the case, and in continuation said:

That it was not essential, under the section of the statute referred to, that the patentees should take active means for the purpose of putting their invention in market, and forcing a sale, but that they should at all times be ready to sell at a fair price, when a reasonable offer was made.

That it was for the jury to say whether it was put and continued on sale, under this view of the law,—to which opinion, the counsel for the defendants excepted.

That the defendants Le Roy and Smith contend that they have not infringed the plaintiffs' patent; that they were but the purchasers of the pipe, and that Lowber was the manufacturer, under the agreement which has been read.

The judge here referred to the evidence on this branch of the case, and said:

That if the contract made by the defendants with Lowber was *bonâ fide*, and they had no connection with the manufacture of the articles, except to furnish lead and pay him a given price, deducting the expenses, and if the contract was in fact carried out and acted upon in that manner, then the defendants would not be liable. But if the agreement was only colorable, and was entered into for the purpose of deriving the benefit and profits of the business, without assuming the responsibility for the use of the invention, and for the purpose of throwing the responsibility on Lowber, who was insolvent, then they were as responsible as he was.

That aiding and assisting a person in carrying on the business and in operating the machinery, would implicate the parties so engaged. If, therefore, these defendants participated actively in conducting the machine, directing and supervising its operations,—if the evidence establishes that position, then, as aiding and assisting, they are as responsible as Lowber,—to which last opinion and decision, the defendants' counsel excepted.

Prior to the giving of the preceding charge to the jury, the defendants' counsel requested the court to instruct them according to the

## Statement of the case.

following written proposition submitted; and his honor, after he delivered the said charge, took up the said propositions in their order, and gave the instructions to the jury which are respectively subjoined thereto.

Proposition I. If the jury believe that the agreements executed on the 13th of April and 13th of May, 1846, by which Lowber, as manufacturer, was to make the pipe for Le Roy & Co. on his machine, at 55 cents the 100 pounds, was real and *bonâ fide*, on an actual dissolution of the partnership of Lowber and Le Roy, and not colorable, to throw the responsibility of working the machine on Lowber alone, then the plaintiffs cannot recover.

Upon which his honor said that he had already given all the instructions he deemed necessary on that point; the proposition was correct, and it was for the jury to decide that fact.

Proposition II. That even if the Tathams first introduced the pipe in question in this country as an article of commerce, that does not give them any right to recover, unless the patents under which they claim were good and valid, for an invention not before known, used, or described in a public work.

Upon which his honor instructed the jury as requested by the defendants' counsel.

Proposition III. That if the jury believe that the combination patented by the plaintiffs was before patented by Burroughs Titus, or any one else in this country, or patented and described in a well-known public work abroad, the plaintiffs cannot recover, although such machines thus patented were not actually put in operation, so as to make pipe for the public.

Upon which his honor instructed the jury, that he had already stated to them that the plaintiffs' invention did not consist in the mere combination of machinery, and, therefore, if those patents were for casting lead pipe, the point was not material; that it was not necessary that they would have made pipe for public use to defeat a subsequent patent,—to which instruction, and refusal to instruct the jury as requested, the defendants' counsel excepted.

Proposition IV. That the Tatham patent is void on its face, the Burr machine having the entire combination, including heat and pressure, and the lead in a set state. The patent is void for claiming too much; should only have been for the improvement, viz., substituting the bridge and short core for the long core, and not for the whole combination.

His honor declined to give this instruction, to which the defendants' counsel excepted.

Proposition V. That the bridge and short core having been before patented in this country by Burroughs Titus, and also before used in other machines, no claim could be made for introducing into Burr's combination such bridge.

Upon which his honor instructed the jury as follows: Undoubtedly that is so, but that is not the plaintiffs' claim.

Proposition VI. That the state of the lead, when used as described in the plaintiffs' specification, being a principle of nature, is not the subject of a patent, either alone or in combination with the machine mentioned in that specification.

To which his honor stated the first part of the proposition was correct, and the latter part not; and the defendants' counsel excepted.

Proposition VII. That the using of a metal in a certain state, or at a certain temperature, alone, or in combination with a machine, was not the subject of a patent.

To which his honor stated: I have already instructed the jury that the invention, as described by the Hansons, is a patentable subject,—to which the defendants' counsel excepted.

Proposition VIII. That if the jury believe that the combination of cylinder, piston, bridge, short core, die, and chamber, under heat and pressure, was before patented in this country by Burroughs Titus, then the plaintiffs cannot recover.

Whereupon his honor instructed the jury, that novelty in the mere combination of the machinery was not essential to the plaintiffs' right to recover, except as connected with the development and application of the principle before mentioned,—to which the defendants' counsel excepted.

Proposition IX. That if the jury believe that the same combination of cylinder, piston, bridge, short core, die, and chamber, under heat and pressure, had before been patented in England by Bramah, and published in a well-known work, then the plaintiffs cannot recover.

His honor instructed the jury, that Bramah's patent and the Tathams' were not identical, and declined to instruct them as requested,—to all which the defendants' counsel excepted.

Proposition X. That if the jury believed that the Burr, Bramah, Titus, and Hague machines, or either of them, were published to the world in well-known public works, and had the same combination, in whole or in part, as the Hanson machine, up to a certain point, the Tathams' patent is void for claiming too much, viz., the whole combination.

His honor instructed the jury, that he had explained to them his views on that part of the case, and declined to instruct them, as re-

## Statement of the case.

quested, in the form of which the proposition was stated,—and to which the defendants' counsel excepted.

Proposition XI. That the reissue of the patent of 1846, on which alone the plaintiffs can claim, was not warranted by the patent of 1841, it being for a different and not the same invention, misdescribed by inadvertence, accident, or mistake; and, in fact, was a new patent, under color of a reissue.

That if the jury believe that the reissue of 1846 was for a different invention from the patent of 1841, and not for the same invention, misdescribed by inadvertence, accident, or mistake, then the plaintiffs cannot recover.

His honor declined to instruct the jury according to the first branch of this proposition,—to which the defendants' counsel excepted; but did instruct them in the affirmative, upon the last branch thereof.

Proposition XII. That if the jury believe that the combination patented was before described in some well-known public work, either in this country or in England, the plaintiffs cannot recover, although such machine, or the pipe made by it, was never introduced in this country.

Upon which his honor instructed the jury in the affirmative.

Proposition XIII. If the jury believe that the combination claimed was before known or used, to make lead pipe, by other than the Hansons or the Tathams, the plaintiffs are not entitled to recover, no matter how limited such knowledge or use was, if the invention was not kept secret.

Upon which his honor instructed the jury in the affirmative.

Proposition XIV. That if the macaroni machine, or the Busk & Harvey clay-pipe machine, contained the same combination as the plaintiffs' machine, that the plaintiffs cannot recover, by reason of applying the same combination to a new use.

Which instruction his honor declined to give, and stated that he had explained to them his views on that subject; and the defendants' counsel excepted.

Proposition XV. That if the jury believe that Mr. Lowber's machine was used by his men when the lead was in a fluid, and not in a set or solid state, then there was no infringement, and the plaintiffs cannot recover, if the plaintiffs' patent were valid.

Upon which his honor instructed the jury in the affirmative.

Proposition XVI. That the jury are the sole and exclusive judges, as questions of fact, whether the combination and process were the same in plaintiffs' machine as in Bramah's, or in any other of the machines proved on the trial.

Upon which his honor charged the jury, that this was so, undoubtedly; subject, however, to the principles of law as laid down in his preceding charge and instructions,—to which the defendants' counsel excepted.

Proposition XVII. That if the jury believe that the lead, when it may be successfully used to make pipe with plaintiffs' machine, must not be in a set or solid state, as described in their specification, and that it can only be thus used in a fluid or pasty state, then that the patent is void, and the jury should find for the defendants, on the ground that the specification does not fairly and fully describe the nature of the invention claimed, nor the condition in which the lead should be used, so as to enable the public to ascertain the true nature of the invention, the manner of using the machine, and the condition in which the lead ought to be used.

Which instruction his honor answered in the affirmative.

The jury then retired to consider their verdict, under the said charge and instructions; and subsequently, on the 25th day of May, 1849, returned into court with a verdict for the said plaintiffs for \$11,394 damages, and six cents costs.

And inasmuch as the said several matters aforesaid do not appear by the record of the said verdict, the said defendants' counsel did then and there request his honor, the said judge, to put his seal to this bill of exceptions, containing the said several matters aforesaid; and his honor, the said judge, did, in pursuance of the said request and of the statute in such case made and provided, put his seal to this bill of exceptions, containing the said several matters aforesaid, at the city of New York aforesaid, the same 25th day of May, 1849.

S. NELSON.

The case was argued by *Mr. Gillett* and *Mr. Noyes*, with whom was *Mr. Barbour*, for the plaintiffs in error, and by *Mr. Cutting* and *Mr. Staples*, for the defendants in error.

The points made by the counsel for the plaintiffs in error were the following:

1. In construing a patent, and deciding what are the inventions patented thereby, the summing up is conclusive. Nothing is patented but what is expressly claimed. *Moody v. Fiske*, 2 Mason, 112, 118; *Rex v. Cutler*, 1 Starkie, 354; *Davies on Patents*, 398, 404; *Bovill v. Moore*, 2 Marsh, 211; *Wyeth v. Stone*, 1 Story, 285; *Hovey v. Stevens*, 3 W. & M., 17.

2. What is described in a patent, and not claimed, whether invented



## Argument for the plaintiffs in error.

by the patentee or not, is dedicated to the public, and cannot be afterwards claimed as a part of his patent, in a reissue, or otherwise. *Bat-tin v. Taggart*, Judges Kane and Grier, September 10, 1851; sixth section of act of 1836; *Mellus v. Silsbee*, 4 Mason, 111; *Grant v. Raymond*, 6 Pet., 218; *Shaw v. Cooper*, 7 Pet., 292, 322, 323; *Pennock v. Dialogue*, 2 Pet., 1, 16.

3. A patent void in part is void in whole, except when otherwise provided by statute. *Wyeth v. Stone*, 1 Story, 285, 273-294; *Moody v. Fiske*, 2 Mason, 118, 119; *Woodcock v. Parker*, 1 Gall., 438; *Evans v. Eaton*, 7 Wheat., 356; 5 Cond. R., 302, 314; *Bovill v. Moore*, Davies' Patents, 398; Id., 2 Marshall, 211; *Hill v. Thompson*, 3 B. Moore, 244; *Bevinton v. Hawks*, 4 B. & Ald., 541; *Saunders v. Aston*, 3 B. & Ald., 881; *Kay v. Marshall*, 5 Bing. N. C., 492; *Gibson v. Brand*, 4 M. & Gr., 178; *McFarlane v. Price*, 1 Starkie, 199; *Minton v. Moore*, 1 Nev. & P., 595; *Rex v. Cutler*, 1 Starkie, 359.

4. The judge was bound to present to the consideration of the jury, as a question of fact, in the words of the statute, whether the patentee, being an alien, "had failed and neglected, for the space of eighteen months from the date of the patent, to put and continue on sale to the public, on reasonable terms, the invention for which the patent issued." *Tatham et al. v. Loring*, decision by Judge Story on this patent, cited on brief.

5. It was error in the judge to instruct the jury that he had examined the surrendered and reissued patent, and found the improvement the same. He should have submitted the question, as one of fact, to the jury, for them to determine upon the evidence, of the weight of which they were the exclusive judges. It was also error to instruct them that Bramah's and Tatham's patent were not identical. That was a question for the jury. Curtis, sec. 381; *Carver v. Braintree*, 2 Story, 432; *Stimpson v. West Chester Railroad Co.*, 4 Howard, 381.

6. The question, whether the combination had been previously patented, or described in a printed publication, was one of fact, which should have been submitted to the jury.

7. Applying an old machine to a new use, or to produce a new result, is not the subject of a lawful patent. *Boulton v. Bull*, 2 H. Bl., 487; *Losh v. Hague*, Web. Pat., 207; *Crane v. Price*, 4 Mann. & Grang., 580; *Huddart v. Grainshaw*, Web. Pat., 8; *Howe v. Abbott*, 2 Story, 190, 193; *Bean v. Smallwood*, 2 Story, 408, 410; *Hovey v. Stevens*, 1 Wood. & M. R., 290, 297, 298; *Kay v. Marshall*, 5 Bing. N. C., 492; (35 Com. L. R., 194, 197, 198;) *Gibson v. Brand*, 4 Mann. & Grang., 179; (43 Com. L. R., 100, 110;) *Hotchkiss v. Greenwood*, 11 Howard, 248, 266; Curtis, secs. 26, 27.

8. Making an addition to an old combination does not authorize a patent for the whole combination. Such a patent would be broader than the invention, and void.

Act of 1836, sec. 6; Hindmarch on Pat., 184, 190, and cases cited; *Basil v. Gibbs*, Davies' Pat., 398, 413; *Whittemore v. Cutter*, 1 Gall., 478; *Barrett v. Hall*, 1 Mason, 447, 474; *Moody v. Fiske*, 2 Mason, 117; *Prouty v. Draper*, 1 Story, 568; *Howe v. Abbott*, 2 Story, 190; *Brooks v. Jenkins*, 3 McLean, 433; *Evans v. Eaton*, 1 Pet., 322; Curtis, secs. 8-11; *Brooks v. Bicknell*, 4 McLean, 64, 73; *Root v. Ball*, 4 McLean, 177, 180; *Parker v. Haworth*, 4 McLean, 370, 373; *Prouty v. Ruggles*, 16 Pet., 336, 341; *Evans v. Eaton*, 7 Wheat., 356; 5 Cond. R., 302, 314.

9. The plaintiffs, Henry B. and Benjamin Tatham, not being inventors, were not authorized to surrender the patent granted to them as assignees, and receive a reissued patent thereon. Patent Act of 1837, sec. 6.

10. The reissued patent is void, because issued to a party who was neither an original inventor nor his assignee. Act of 1837, sec. 6.

11. Neither a principle nor an affect can be patented, but a patent must be for a mode of embodying the former to produce the latter, invented by the patentee. Kemper's case, by Chief Justice Cranch, in Curtis on Pat., 500; *Wyeth v. Stone*, 1 Story, 285; *Hill v. Thompson*, 8 Taunton, 375; S. C., 4 Com. L. R., 151; *Brunton v. Hawks*, 4 Barn. & Ald., 541; S. C., 6 Com. L. R., 509; *Moody v. Fiske*, 2 Mason, 118; *Whittemore v. Cutter*, 1 Gall., 478, 480; *Stone v. Sprague*, 1 Story, 270, 272; *Blanchard v. Sprague*, 3 Sumner, 535, 540; S. C., 2 Story, 164, 194; *Howe v. Abbott*, 2 Story, 194; *Smith v. Downing*, decided in 1850 by Judge Woodbury; *Detmould v. Reeves*, Grier and Kane, Judges, 1851; *Boulton v. Watt*, 2 H. Bl., 453; S. C., Davies on Pat., 162, 192.

The counsel for the defendants in error made the following points:

No exception was taken to the admission or exclusion of testimony, but solely to the judge's charge.

The invention for which the patent was granted consisted in the discovery, that, under certain conditions, and by the use and application of certain methods, lead and some of its alloys, while in a set state, could, after being separated into parts, be reunited and welded, and thus formed into pipe; and also of the mode of doing this; producing thereby a new article of manufacture, wrought lead pipe—avoiding the objections which had always prevented success in casting pipe; and by this discovery overcoming the defects of Burr's method, on which this was an improvement.

The patentees, in describing the invention, say that they "have found, from experience, that lead and some of its alloys, when recently become set, or in a condition just short of fluidity, being still under heat and extreme pressure, in a close vessel, will unite perfectly after a separation of its parts," and that, therefore, they construct their machinery as follows,—and then proceed to describe the machinery or apparatus, as adapted by them to this discovery, and by which they produce the practical result above stated.

After describing the apparatus and the modes of using it, the patentees repeat, "that the remarkable feature of their invention is that soft metals, when in a set state, being yet under heat, can be made, by extreme pressure, to reunite perfectly, around a core, after a separation, and thus be formed into strong pipes or tubes."

And "that the essential difference in the character of this pipe, distinguishing it from all others before made, was that it was wrought under heat by pressure and constriction from set metal; and that it is not a casting formed in a mould."

And they close by claiming as their invention "the combination described by them, when used to form pipes of metal, under heat and pressure, in the manner set forth."

The judge, in his charge, in commenting on the patent, states the invention to be substantially as above stated; and to this construction and view of the patent no exception was taken by the defendants.

The court then proceed further to instruct the jury, and in answer to certain propositions submitted by the plaintiffs in error for the consideration of the court.

I. The first proposition laid down by the court, is that the mere combination of machinery not new, in the abstract, when combined with and applied to the practical development of a new principle, to produce a new and useful result, may be the subject of a valid patent. This principle is repeated several times, in different connections, in the course of the charge to the jury; and as often excepted to by the counsel for the defendants.

The counsel for the defendants in error insist that the above position is correct, and supported by principle, by precedent, and by practice.

1. The position is supported by principle, founded on the statutes giving patents to inventors. He who discovers a new principle, and points out the means of applying it, to produce a new and useful result, comes within the settled construction of the English act, giving a patent for the sole working of any manner of new manufac-

tures. See sixth section of the act 21 James I, 1623. By our Patent Law, any person having invented or discovered any new manufacture, &c., is entitled to a patent. See sixth section of the act 4th July, 1836. The term new manufacture, includes not only the thing produced, but the means of producing it.

2. This principle is supported by authority. Curtis on Pat., secs. 9, 71-91; also ch. 2, pp. 57-94, and cases there cited. Earl Dudley's patent for the use of pea or pit coal, in the manufacture of iron. 1 Carpmael, 15; Webster's Patent Cases, 14, S. C.—Neilson's patent for the hot-air blast, in connection with common bituminous pit coal, in the manufacture of iron. 8 Mees. & Welsb., 806-825; A. D. 1841; *Neilson v. Hartford, &c.*, Web. Pat. Cas., 295, 328-373; A. D. 1841; S. C., 374—Crane's patent for the hot-air blast, in connection with anthracite coal. Crane's patent, Web. Pat. Cas., 375; date 1836. *Crane v. Price, &c.*; Web. Pat. Cas., 377, 393; A. D. 1842, S. C., 4 Mann. & Grang., 380; S. C., 43 Eng. Com. L. R., 301; S. C., 2d vol. Frank. J. for year 1851, p. 388; *French, &c., v. Rogers, &c.*, 394-397, and cases there cited by the court. 6 Eng. Law and Equity Rep., 536, overruling 2 Carrington & Kirwan, cited *v. Leon.*, 43, 47, 52; Curtis, 81 a.; Webster, 229, note.

II. The second exception by the defendants' counsel is to the charge of the court in relation to Mr. Keller's evidence.

It is difficult to see upon what ground this exception of the defendants to the charge of the court is founded. After remarking upon the character and weight of the fact testified to, the whole is submitted to the jury for their decision.

III. The third exception taken to the charge of the court is found in the next two paragraphs on the same page, and relates to the reissued patent. The same is repeated in the call of the defendants, in their eleventh proposition, upon which they ask the court to instruct the jury.

The substance of the charge, as given in both instances, is that the language in one patent was in some parts different from that in the other, but the meaning was substantially the same in both; that the reissued patent must be for the same invention as the first; and the matter of fact was left to the jury.

IV. The next exception is to the charge of the court as found at the top of the 42d page of the case, and is as follows:

"That in the patents referred to, from the year 1797 to 1832, the combination which was claimed to be identical was confessedly used for making pipe, by casting with fluid lead in a mould, and after it was set by the application of water, forcing it out.

“And the question is, whether any of these inventions are substantially the same as the plaintiffs’,—whether, even if by these modes pipe had been successfully made for common use, it would have been made in the same manner as the Hansons’,—to which opinion the counsel for the defendants excepted.”

Whether the modes referred to by the court, of manufacturing pipe, were the same or different, was a question of fact left to the jury; and the court did not, by the manner of stating the point, withhold it from the consideration of the jury.

V. The fifth exception relates to the charge of the court as to the duty of the plaintiffs to put and keep the invention on sale on reasonable terms, and they say that it was not essential that the patentees should take active means for the purpose of putting their invention in market, and forcing a sale; but that they should, at all times, be ready to sell at a fair price, when a reasonable offer was made.

That it was for the jury to say whether it was put and continued on sale, under this view of the law,—to which the counsel for the defendants excepted.

We insist that the court took a correct view of the statute, and properly submitted the question of fact to the jury; and that the exception is not well taken.

VI. The next exception, in the order in which the defendants in error have noticed them, relates to the instructions of the court, in relation to the liability of Le Roy and Smith jointly, with the other defendant, Lowber.

It seems, to the counsel for the defendants in error, that the question was properly submitted to the jury, as a question of fact, how far Le Roy and Smith had made themselves liable with Lowber. The defendants in error insist that the exception to this part of the charge is not well taken.

VII. In answer to the fourth proposition, on which the court was requested to instruct the jury, that Tatham’s patent was void on its face, &c., we say that the charge of the court was correct. The patentees in Tatham’s patent have pointed out clearly what they claim, and what they do not claim.

VIII. In their ninth proposition, the defendants requested the court to instruct the jury—

“That if they believed the same combination of cylinder, piston, bridge, short core, die, and chamber, under heat and pressure, had before been patented in England by Bramah, and published in a well-known work, then the plaintiffs cannot recover.”

Upon this proposition the court instructed the jury, that Bramah’s

## Opinion of the court.

patent and the Tathams' were not identical; and declined to instruct the jury as requested,—to which the counsel for the defendants excepted. This request by the defendants for the above instruction was based on the assumption of a fact not proved and not true, and was correctly refused.

IX. The defendants requested the court to instruct the jury according to their tenth proposition, which is as follows: "That if the jury believe that the Burr, Bramah, Titus, and Hague machines, or either of them, were published to the world in well-known public works, and had the same combination, in whole or in part, as the Hanson machine, up to a certain point, the Tathams' patent is void for claiming too much, viz., the whole combination; and the court thereupon instructed the jury, that they had explained their views on that part of the case, and declined to instruct them as requested in the form in which the proposition was stated." To which the counsel for the defendants excepted, and the defendants in error insist that this exception is not well taken.

X. The sixteenth proposition, on which the court was requested to instruct the jury, is in the following words, namely:

"That the jury are the sole and exclusive judges as to the questions of fact, whether the combination and process were the same in the plaintiffs' machine as was Bramah's, or in any other of the machines proved on the trial. And thereupon the court instructed the jury, that this was so, undoubtedly; subject, however, to the principles of law as laid down in the preceding charge and instructions." To which the counsel for the defendants excepted.

The defendants in error insist that none of the exceptions aforesaid are well taken; and that said judgment should be affirmed with costs and damages.

Mr. Justice McLEAN delivered the opinion of the court.

This is a case on error from the Circuit Court of the Southern District of New York.

The action was brought in the Circuit Court, to recover damages for an alleged infringement of a patent for new and useful improvements in machinery for making pipes and tubes from metallic substances.

The declaration alleged that John and Charles Hanson, of England, were the inventors of the improvements specified, on or prior to the 31st of August, 1837; that on the 10th of January, 1840, the Hansons assigned to H. B. & B. Tatham, two of the defendants in error, the full and exclusive right to said improvements; that on the 29th of

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March, 1841, letters patent were granted for the improvements to the Tathams, as the assignees of the Hansons; that afterwards, H. B. & B. Tatham assigned to G. N. Tatham, the remaining defendant in error, an undivided third part of the patent.

On the 14th of March, 1846, the said letters patent were surrendered, on the ground that the specifications of the improvements claimed were defective, and a new patent was issued, which granted to the patentees, their heirs, &c., for the term of fourteen years from the 31st of August, 1837, the exclusive right to make and vend the improvements secured. The declaration states the patent was of the value of fifty thousand dollars; and that the defendants below had made and vended lead pipe to the amount of two thousand tons, in violation of the patent, and to the injury of the plaintiffs twenty thousand dollars.

The defendants pleaded not guilty; the defendant Lowber did not join in the plea, but permitted judgment to be entered against him by default. On the trial, certain bills of exceptions were taken to the instructions of the court to the jury, on which errors are assigned.

The schedule, which is annexed to the patent, and forms a part of it, states that the invention consists "in certain improvements upon, and additions to, the machinery used for manufacturing pipes and tubes from lead or tin, or an alloy of soft metals capable of being forced, by great pressure, from out of a receiver, through or between apertures, dies, and cores, when in a set or solid state, set forth in the specification of a patent granted to Thomas Burr, of Shrewsbury, in Shropshire, England, dated the 11th of April, 1820." After describing Burr's machine, its defects, and the improvements made on it as claimed, the patentees say: "Pipes thus made are found to possess great solidity and unusual strength, and a fine uniformity of thickness and accuracy of bore is arrived at, such as, it is believed, has never before been attained by any other machinery."

"The essential difference in the character of this pipe, which distinguishes it, as well as that contemplated by Thomas Burr, from all other heretofore known or attempted, is that it is wrought under heat, by pressure and constriction, from set metal; and that it is not a casting formed in a mould."

And they declare: "We do not claim as our invention and improvement any of the parts of the above-described machinery, independently of its arrangement and combination above set forth. What we do claim as our invention, and desire to secure, is the combination of the following parts above described, to wit, the core and bridge, or guide-piece, with the cylinder, the piston, the chamber,

and the die, when used to form pipes of metal, under heat and pressure, in the manner set forth, or in any other manner substantially the same."

"The plaintiffs gave in evidence certain agreements between the defendants, showing the manufacture of lead pipe by the defendant Lowber, for the defendants Le Roy and Smith. And also evidence tending to prove that the said John Hanson and Charles Hanson were the original and first inventors of the improvement described in the said letters patent; that the invention and discovery therein described was new and useful; that the lead pipe manufactured thereby was superior in quality and strength, capable of resisting much greater pressure, and more free from defects than any pipe before made; that in all the modes of making lead pipe, previously known and in use, it could be made only in short pieces, but that by this improved mode it could be made of any required length, and also of any required size; and that the introduction of lead pipe, made in the mode described, had superseded the use of that made by any of the modes before in use, and that it was also furnished at a less price."

"And the plaintiffs also gave evidence tending to prove that lead, when recently become set, and while under heat and extreme pressure in a close vessel, would reunite perfectly, after a separation of its parts; and that in the process described in the said patent, lead pipe was manufactured by being thus separated and reunited; and that the said John and Charles Hanson were the first and original discoverers thereof; and that such discovery, and its reduction to a practical result in the mode described in said letters patent, was useful and important."

"And the plaintiffs also gave evidence conducing to prove that the improvement described in the letters patent was the same invention and discovery which had been made by the said John and Charles Hanson, and for which letters patent had been granted to them in England, and subsequently in this country to the Tathams, as recited in the letters patent."

"And the plaintiffs also gave evidence conducing to prove that they had been ready and willing, and had offered, to sell the said invention, within eighteen months succeeding the issuing of said letters patent to them, and also since; and had, within the said eighteen months, sold the same for a large portion of the United States."

The defendants' counsel then read in evidence, from the "Repertory of Arts," vol. 16, page 344, the description of the patent to the Hansons, dated August 31, 1837. They also read in evidence the patent issued upon the application of the plaintiffs to the Patent



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Office, containing another specification, which was annexed to the patent surrendered. And they also read the specification of Thomas Burr's patent, of April 11, 1820; also a patent granted to George W. Potter, described in the twelfth "Franklin Journal of Arts," published in 1833; they also read the specification of a patent granted, in England, to Busk & Harvey, on December 5, 1817; and also the specification of a patent granted, in England, to Joseph Bramah, October 31, 1797.

Evidence was also given to show that the combination of machinery for making lead pipe, described in public works as having been invented by Burroughs Titus, by George W. Potter, by Jesse Fox, by John Hague, and by Joseph Bramah, were substantially the same as that used by the plaintiffs; that the combination of machinery patented, as hereinbefore stated, by Busk & Harvey, for making pipes of clay, and that used for making macaroni, were substantially the same as that described in the plaintiffs' patent.

In their charge to the jury, the court said: "They, the plaintiffs, also state that they do not claim any of the parts of the machinery, the cylinder, core, die, or bridge, but that they claimed the combination when used to form pipes of metal, under heat and pressure, in the way they have described. There can be no doubt that if this combination is new, and produces a new and useful result, it is the proper subject of a patent." "The result is a new manufacture. And even if the mere combination of machinery in the abstract is not new, still, if used and applied in connection with the practical development of a principle newly discovered, producing a new and useful result, the subject is patentable. In this view, the improvement of the plaintiffs is the application of a combination of machinery to a new end,—to the development and application of a new principle, resulting in a new and useful manufacture. That the discovery of a new principle is not patentable, but it must be embodied and brought into operation by machinery, so as to produce a new and an useful result. Upon this view of the patent, it is an important question for the jury to determine, from the evidence, whether the fact is established, on which the alleged improvement is founded, that lead in a set or semi-solid state can thus be reunited or welded, after separation." To this instruction the defendants excepted.

It was also objected, that the plaintiffs' patent was invalid for want of originality; that the invention had been before described in public works; and Bramah, Hague, Titus, Fox, and Potter were relied on by the defendants.

To this it was replied, by the court: "That in the view taken by the

court in the construction of the patent, it was not material whether the mere combinations of machinery referred to were similar to the combination used by the Hansons, because the originality did not consist in the novelty of the machinery, but in bringing a newly discovered principle into practical application, by which a useful article of manufacture is produced, and wrought pipe made as distinguished from cast pipe." To this charge there was also an exception.

The word *principle* is used by elementary writers on patent subjects, and sometimes in adjudications of courts, with such a want of precision in its application as to mislead. It is admitted, that a principle is not patentable. A principle, in the abstract, is a fundamental truth; an original cause; a motive. These cannot be patented, as no one can claim in either of them an exclusive right. Nor can an exclusive right exist to a new power, should one be discovered in addition to those already known. Through the agency of machinery, a new steam-power may be said to have been generated. But no one can appropriate this power exclusively to himself, under the Patent Laws. The same may be said of electricity, and of any other power in nature, which is alike open to all, and may be applied to useful purposes by the use of machinery.

In all such cases, the processes used to extract, modify, and concentrate natural agencies, constitute the invention. The elements of the power exist; the invention is not in discovering them, but in applying them to useful objects. Whether the machinery used be novel, or consist of a new combination of parts known, the right of the inventor is secured against all who use the same mechanical power, or one that shall be substantially the same.

A patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever. This, by creating monopolies, would discourage arts and manufactures, against the avowed policy of the Patent Laws.

A new property discovered in matter, when practically applied in the construction of a useful article of commerce or manufacture, is patentable; but the process through which the new property is developed and applied, must be stated with such precision as to enable an ordinary mechanic to construct and apply the necessary process. This is required by the Patent Laws of England and of the United States, in order that when the patent shall run out the public may know how to profit by the invention. It is said, in the case of the *Househill Company v. Neilson*, Webster's Patent Cases, 683: "A patent will be good, though the subject of the patent consists in the

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discovery of a great, general, and most comprehensive principle in science or law of nature, if that principle is by the specification applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained." In that case, Mr. Justice CLERK, in his charge to the jury, said: "The specification does not claim anything as to the form, nature, shape, materials, numbers, or mathematical character of the vessel or vessels in which the air is to be heated, or as to the mode of heating such vessels," &c. The patent was for "the improved application of air to produce heat in fires, forges, and furnaces, where bellows or other blowing apparatus are required."

In that case, although the machinery was not claimed as a part of the invention, the jury were instructed to inquire "whether the specification was not such as to enable workmen of ordinary skill to make machinery or apparatus capable of producing the effect set forth in said letters patent and specification;" and that, in order to ascertain whether the defendants had infringed the patent, the jury should inquire whether they "did, by themselves or others, and in contravention of the privileges conferred by the said letters patent, use machinery or apparatus substantially the same with the machinery or apparatus described in the plaintiffs' specification, and to the effect set forth in said letters patent and specification." So it would seem that where a patent is obtained, without a claim to the invention of the machinery, through which a valuable result is produced, a precise specification is required; and the test of infringement is whether the defendants have used substantially the same process to produce the same result.

In the case before us, the court instructed the jury, that the invention did not consist "in the novelty of the machinery, but in bringing a newly-discovered principle into practical application, by which a useful article of manufacture is produced, and wrought pipe made as distinguished from cast pipe."

A patent for leaden pipes would not be good, as it would be for an effect, and would, consequently, prohibit all other persons from using the same article, however manufactured. Leaden pipes are the same, the metal being in no respect different. Any difference in form and strength must arise from the mode of manufacturing the pipes. The new property in the metal claimed to have been discovered by the patentees, belongs to the process of manufacture, and not to the thing made.

But we must look to the claim of the invention stated in their application by the patentees. They say: "We do not claim as our

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invention and improvement any of the parts of the above-described machinery, independently of their arrangement and combination above set forth." "What we claim as our invention, and desire to secure by letters patent, is the combination of the following parts above described, to wit, the core and bridge, or guide-piece, the chamber, and the die, when used to form pipes of metal, under heat and pressure, in the manner set forth, or in any other manner substantially the same."

The patentees have founded their claim on this specification, and they can neither modify nor abandon it, in whole or in part. The combination of the machinery is claimed, through which the new property of lead was developed, as a part of the process in the structure of the pipes. But the jury were instructed, "that the originality of the invention did not consist in the novelty of the machinery, but in bringing a newly-discovered principle into practical application." The patentees claimed the combination of the machinery as their invention in part, and no such claim can be sustained without establishing its novelty—not as to the parts of which it is composed, but as to the combination. The question whether the newly-developed property of lead, used in the formation of pipes, might have been patented, if claimed as developed, without the invention of machinery, was not in the case.

In the case of *Bean v. Smallwood*, 2 Story, 408, Mr. Justice STORY said: "He (the patentee) says that the same apparatus stated in this last claim has been long in use, and applied, if not to chairs, at least in other machines to purposes of a similar nature. If this be so, then the invention is not new, but at most is an old invention, or apparatus, or machinery applied to a new purpose. Now, I take it to be clear, that a machine, or apparatus, or other mechanical contrivance, in order to give the party a claim to a patent therefor, must in itself be substantially new. If it is old and well known, and applied only to a new purpose, that does not make it patentable."

We think there was error in the above instruction, that the novelty of the combination of the machinery, specifically claimed by the patentees as their invention, was not a material fact for the jury, and that on that ground the judgment must be reversed. The other rulings of the court excepted to, we shall not examine, as they are substantially correct.

Mr. Justice NELSON, Mr. Justice WAYNE, and Mr. Justice GRIER dissented.

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Mr. Justice NELSON, dissenting.

The patent in this case, according to the general description given by the patentees, is for improvements upon, and additions to, the machinery or apparatus of Thomas Burr, for manufacturing pipes and tubes from metallic substances. They declare that the nature of their invention, and the manner in which the same is to operate, are particularly described and set forth in their specification. In that, they refer to the patent of Burr of the 11th of April, 1820, for making lead pipe out of set or solid lead, by means of great pressure, the product being wrought pipe, as contradistinguished from cast, or pipe made according to the draw-bench system. The apparatus, as described by Burr, consisted of a strong iron cylinder, bored sufficiently true for a piston to traverse easily within it. This cylinder was closed at one end by the piston, and also closed at the other, except a small aperture for the die, which formed the external diameter of the pipe. The core or mandril, which determined the inner diameter, was a long cylindrical rod of steel, one end of which was attached to the face of the piston, extending through the center of the cylinder, and passing also through the center of the die at the opposite end, leaving a space around the core, and between it and the die, for the formation of the pipe. The metal to form the pipe was admitted into the cylinder in a fluid state, and when it became set or solid, the power of a hydraulic press was applied to the head of the piston, which, moving against the body of solid lead in the cylinder, drove it through the die, the long core advancing with the piston and with the body of lead through the die, and thus forming the pipe. The cylinder usually holds from three to four hundred pounds of lead, and continuous pipe is made till the whole charge is driven out.

This plan, though one of deserved merit, and of great originality, failed, when reduced to practice, except for the purpose of making very large pipe, larger than that usually in demand, and consequently passed out of general use. The long core attached to the face of the piston, advancing with it in the solid lead under the great pressure required, was liable to warp and twist out of a straight line, and out of center in the die, which had the effect to destroy the uniformity of the thickness and centrality of the bore of the pipe.

The old mode, therefore, of making pipe, by the draw-bench system, continued down to 1837, when the patentees in this case discovered, by experiment, that lead, when recently set and solid, but still under heat and extreme pressure, in a close vessel, would reunite after a separation of its parts, and "heal" (in the language of the patentees)

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"as it were by the first intention," as completely as though it had not been divided.

Upon the discovery of this property of lead, which had never before been known, but, on the contrary, had been supposed and believed, by all men of science skilled in metals, to be impossible, the patentees made an alteration in the apparatus of Burr; founded upon this new property discovered in the metal, and succeeded completely in making wrought pipe out of solid lead by means of the hydraulic pressure. The product was so much superior in quality to that made according to the old mode, that it immediately wholly superseded it in the market. The pipe was also made much cheaper.

The patentees, by their discovery, were enabled to dispense with the long core of Burr, and to fix firmly a bridge or cross-bars at the end of the cylinder near the die, to which bridge they fastened a short core, extending into and through the die. By this arrangement they obtained a firm, immovable core, that always preserved its centrality with the die, and secured the manufacture of pipe, of uniformity of thickness of wall and accuracy of bore, of any dimension. The lead, after being admitted into the cylinder in a fluid state, was allowed to remain till it became solid, and was then driven by the piston through the apertures in the bridge into the chamber between it and the die, where the parts reunited after the separation as completely as before, and, passing out at the die around the fixed short core, formed perfect pipe.

The patentees state that they do not intend to confine themselves to the arrangement of the apparatus thus particularly specified, and point out several other modes by which the same result may be produced, all of which variations would readily suggest themselves, as they observe, to any practical engineer, without departing from the substantial originality of the invention, the remarkable feature of which, they say, is that lead, when in a set state, being yet under heat, can be made, by extreme pressure, to reunite perfectly around a core after separation, and thus be formed into strong pipes or tubes. Pipes thus made are found to possess great solidity and unusual strength, and a fine uniformity, such as had never before been attained by any other mode. The essential difference in its character, and which distinguishes it from all other theretofore known, they add, is that it is wrought under heat, by pressure and constriction, from set or solid metal.

They do not claim as their invention or improvement any of the parts of the machinery, independently of the arrangement and combination set forth.

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“What we claim as our invention,” they say, “is the combination of the following parts above described, to wit, the core and bridge, or guide-piece, with the cylinder, the piston, the chamber, and die, when used to form pipes of metal, under heat and pressure, in the manner set forth, or in any other manner substantially the same.”

It is supposed that the patentees claim, as the novelty of their invention, the arrangement and combination of the machinery which they have described, disconnected from the employment of the new property of lead, which they have discovered, and by the practical application and use of which they have succeeded in producing the new manufacture. And the general title or description of their invention, given in the body of their letters patent, is referred to as evidence of such claim. But every patent, whatever may be the general heading or title by which the invention is designated, refers to the specification annexed for a more particular description; and hence this court has heretofore determined, that the specification constitutes a part of the patent, and that they must be construed together when seeking to ascertain the discovery claimed. *Hogg v. Emerson*, 6 How., 437.

The same rule of construction was applied by the Court of Exchequer, in England, in the case of Neilson's patent for the hot-air blast. Webster's P. C., 373.

Now, on looking into the specification, we see that the leading feature of the invention consists in the discovery of a new property in the article of lead, and in the employment and adaptation of it, by means of the machinery described, to the production of a new article, wrought pipe, never before successfully made. Without the discovery of this new property in the metal, the machinery or apparatus would be useless, and not the subject of a patent. It is in connection with this property, and the embodiment and adaptation of it to practical use, that the machinery is described, and the arrangement claimed. The discovery of this new element or property led naturally to the apparatus by which a new and most useful result is produced. The apparatus was but incidental, and subsidiary to the new and leading idea of the invention. And hence the patentees set forth, as the leading feature of it, the discovery that lead in a solid state, but under heat and extreme pressure, in a close vessel, will reunite, after separation of its parts, as completely as though it had never been separated. It required very little ingenuity, after the experiments in a close vessel by which this new property of the metal was first developed, to construct the necessary machinery for the formation of the pipe. The apparatus essential to develop this property

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would at once suggest the material parts, especially in the state of the art at the time. Any skillful mechanic, with Burr's machine before him, would readily construct the requisite machinery.

The patentees, therefore, after describing their discovery of this property of lead, and the apparatus by means of which they apply the metal to the manufacture of pipe, claim the combination of the machinery, only when used to form pipes under heat and pressure, in the manner set forth, or in any other manner substantially the same. They do not claim it as new separately, or when used for any other purpose, or in any other way,—but claim it, only when applied for the purpose and in the way pointed out in the specification. The combination, as machinery, may be old; may have been long used; of itself, what no one could claim as his invention, and may not be the subject of a patent. What is claimed, is that it never had been before applied or used, in the way and for the purpose they have used and applied it, namely, in the embodiment and adaptation of a newly-discovered property in lead, by means of which they are enabled to produce a new manufacture, wrought pipe, out of a mass of solid lead. Burr had attempted it, but failed. These patentees, after the lapse of seventeen years, having discovered this new property in the metal, succeeded, by the use and employment of it; and since then, none other than wrought lead pipe, made out of solid lead, has been found in the market, having superseded, on account of its superior quality and cheapness, all other modes of manufacture.

Now, the construction which I understand a majority of my brethren are inclined to give to this patent, namely, that the patentees claim, as the originality of their invention, simply the combination of the machinery employed, with great deference, seems to me contrary to the fair and reasonable import of the language of the specification, and also of the summary of the claim. The tendency of modern decisions is to construe specifications benignly, and to look through mere forms of expression, often inartificially used, to the substance, and to maintain the right of the patentee to the thing really invented, if ascertainable upon a liberal consideration of the language of the specification, when taken together. For this purpose, phrases standing alone are not to be singled out, but the whole are to be taken in connection. 1 Sumn., 482-485.

Baron Parke observed, in delivering the opinion of the court in Neilson's patent: "That, half a century ago, or even less, within fifteen or twenty years, there seems to have been very much a practice with both judges and juries to destroy the patent-right, even of beneficial patents, by exercising great astuteness in taking objections,



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either as to the title of the patent, but more particularly as to the specifications, and many valuable patent-rights have been destroyed in consequence of the objections so taken. Within the last ten years, or more, the courts have not been so strict in taking objections to the specifications, and they have endeavored to hold a fair hand between the patentee and the public, willing to give the patentee the reward of his patent."

Construing the patent before us in this spirit, I cannot but think that the thing really discovered, and intended to be described and claimed by these patentees, cannot well be mistaken. That they did not suppose the novelty of their invention consisted simply in the arrangement of the machinery described, is manifest. They state distinctly that the leading feature of their discovery consisted of this new property of lead, and some of its alloys,—this, they say, is the remarkable feature of their invention,—and the apparatus described is regarded by them as subordinate, and as important only as enabling them to give practical effect to this newly-discovered property, by means of which they produce the new manufacture. If they have failed to describe and claim this as belonging to their invention, it is manifest, upon the face of their specification, that they have failed to employ the proper words to describe and claim what they intended; and that the very case is presented in which, if the court, in the language of Baron Parke, will endeavor to hold a fair hand between the patentee and the public, it will look through the forms of expression used, and discover, if it can, the thing really invented. Apply to the specification this rule of construction, and all difficulty at once disappears. The thing invented, and intended to be claimed, is too apparent to be mistaken.

The patentees have certainly been unfortunate in the language of the specification, if, upon a fair and liberal interpretation, they have claimed only the simple apparatus employed; when they have not only set forth the discovery of this property in the metal as the great feature in their invention, but, as is manifest, without it the apparatus would have been useless. Strike out this new property from their description and from their claim, and nothing valuable is left. All the rest would be worthless. This lies at the foundation upon which the great merit of the invention rests, and without a knowledge of which the new manufacture could not have been produced; and, for aught we know, the world would have been deprived of it down to this day.

If the patentees had claimed the combination of the core and bridge, or guide-piece, with the cylinder, the chambers, and the die, and stop-

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ped there, I admit the construction now adopted by a majority of my brethren could not be denied; although even then it would be obvious, from an examination of the specification as a whole, that the draughtsman had mistaken the thing really invented, and substituted in its place matters simply incidental, and of comparative insignificance. But the language of the claim does not stop here. The combination of these parts is claimed only when used to form pipes of lead, under heat and pressure, in the manner set forth,—that is, when used for the embodiment and adaptation of this new property in the metal for making wrought pipe out of a solid mass of lead. This guarded limitation of the use excludes the idea of a claim to the combination for any other, and ties it down to the instance when the use incorporates within it the new idea or element which gives to it its value, and by means of which the new manufacture is produced. How, then, can it be consistently held that here is a simple claim to the machinery, and nothing more, when a reasonable interpretation of the words not only necessarily excludes any such claim, but in express terms sets forth a different one,—one not only different in the conception of the invention, but different in the practical working of the apparatus, to accomplish the purpose intended?

I conclude, therefore, that the claim, in this case, is not simply for the apparatus employed by the patentees, but for the embodiment or employment of the newly-discovered property in the metal, and the practical adaptation of it, by these means, to the production of a new result, namely, the manufacture of wrought pipe out of solid lead.

Then, is this the proper subject-matter of a patent?

This question was first largely discussed by counsel and court in the celebrated case of *Boulton v. Bull*, (2 Hen., 31, 463,) involving the validity of Watt's patent, which was for "a new invented method for lessening the consumption of fuel and steam in fire-engines." This was effected by inclosing the steam-vessel or cylinder with wood, or other material, which preserved the heat in the steam-vessel; and by condensing the steam in separate vessels. It was admitted, on the argument, that there was no new mechanical construction invented by Watt, and the validity of the patent was placed on the ground that it was for well-known principles, practically applied, producing a new and useful result. On the other hand, it was conceded that the application of the principles in the manner described was new, and produced the result claimed; but it was denied that this constituted the subject-matter of a patent. Justices Heath and Buller agreed with the counsel for the defendant. But Lord Chief Justice Eyre laid down the true doctrine, and which, I think, will be seen

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to be the admitted doctrine of the courts of England at this day "Undoubtedly," he observed, "there can be no patent for a mere principle; but for a principle so far embodied and connected with coporeal substances as to be in a condition to act, and to produce effects in any art, trade, mystery, or manual occupation, I think there may be a patent. Now, this," he continues, "is, in my judgment, the thing for which the patent stated in the case was granted; and this is what the specification describes, though it miscalls it a principle. It is not that the patentee conceived an abstract notion that the consumption of steam in fire-engines may be lessened, but he has discovered a practical manner of doing it; and for that practical manner of doing it he has taken this patent. Surely," he observes, "this is a very different thing from taking a patent for a principle. The apparatus, as we have said, was not new. There is no new mechanical construction, said the counsel for the patentee, invented by Watt, capable of being the subject of a distinct specification; but his discovery was of a principle, the method of applying which is clearly set forth." Chief Justice Eyre admitted that the means used were not new, and that if the patent had been taken out for the mechanism used, it must fail.

He observed: "When the effect produced is some new substance or composition of things, it should seem that the privilege of the sole working or making ought to be for such new substances or composition, without regard to the mechanism or process by which it has been produced, which, though perhaps also new, will be only useful as producing the new substance." Again: "When the effect produced is no new substance or composition of things, the patent can only be for the mechanism, if new mechanism is used; or for the process, if it be a new method of operating, with or without old mechanism, by which the effect is produced." And again he observes: "If we wanted an illustration of the possible merit of a new method of operating with old machinery, we might look to the identical case before the court." Pages 493, 495, 496.

This doctrine, in expounding the law of patents, was announced in 1795, and the subsequent adoption of it by the English courts shows that Chief Justice Eyre was considerably in advance of his associates upon this branch of the law. He had got rid, at an early day, of the prejudice against patents so feelingly referred to by Baron Parke in *Neilson v. Harford*, and comprehended the great advantages to his country if properly encouraged. He observed, in another part of his opinion, that "the advantages to the public from improvements of this kind are beyond all calculation important to a commercial coun-

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try; and the ingenuity of artists who turn their thoughts towards such improvements is, in itself, deserving of encouragement."

This doctrine was recognized by the Court of King's Bench in *The King v. Wheeler*, 2 B. & Ald., 340, 350.

It is there observed, that the word "manufactures," in the Patent Act, may be extended to a mere process to be carried on by known implements or elements acting upon known substances, and ultimately producing some other known substance, but producing it in a cheaper or more expeditious manner, or of a better or more useful kind.

Now, if this process to be carried on by known implements acting upon known substances, and ultimately producing some other known substance of a better kind, is patentable, *a fortiori* will it be patentable, if it ultimately produces not some other known substance, but an entirely new and useful substance.

In Forsyth's patent, which consists of the application and use of detonating powder as priming for the discharge of fire-arms, it was held, that whatever might be the construction of the lock or contrivance by which the powder was to be discharged, the use of the detonating mixture as priming, which article of itself was not new, was an infringement. Webster's P. C., 94, 97, note; Curtis on Pat., 230.

This case is founded upon a doctrine which has been recognized in several subsequent cases in England, namely, that where a person discovers a principle or property of nature, or where he conceives of a new application of a well-known principle or property of nature, and also of some mode of carrying it out into practice, so as to produce or attain a new and useful effect or result, he is entitled to protection against all other modes of carrying the same principle or property into practice for obtaining the same effect or result.

The novelty of the conception consists in the discovery and application in the one case, and of the application in the other, by which a new product in the arts or manufactures is the effect; and the question, in case of an infringement, is as to the substantial identity of the principle or property, and of the application of the same, and consequently the means or machinery made use of, material only so far as they affect the identity of the application.

In the case of Jupe's patent for "an improved expanding table," Baron Alderson observed, speaking of this doctrine: "You cannot take out a patent for a principle; you may take out a patent for a principle coupled with the mode of carrying the principle into effect. But then you must start with having invented some mode of carrying the principle into effect. If you have done that, then you are

## Dissenting opinion.

entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as piracy of your original invention." Webster's P. C., 147. The same doctrine was maintained also in the case of Neilson's patent for the hot-air blast, in the King's Bench and Exchequer, in England. Webster's P. C., 810, 342, 371; Curtis on Pat., secs. 74, 148, 232.

This patent came also before the Court of Sessions in Scotland; and in submitting the case to the jury, the lord justice remarked: "That the main merit, the most important part of the invention, may consist in the conception of the original idea—in the discovery of the principle in science, or of the law of nature, stated in the patent; and little or no pains may have been taken in working out the best mode of the application of the principle to the purpose set forth in the patent. But still, if the principle is stated to be applicable to any special purpose, so as to produce any result previously unknown, in the way and for the objects described, the patent is good. It is no longer an abstract principle. It becomes to be a principle turned to account, to a practical object, and applied to a special result. It becomes, then, not an abstract principle, which means a principle considered apart from any special purpose or practical operation, but the discovery and statement of a principle for a special purpose, that is, a practical invention, a mode of carrying a principle into effect. That such is the law," he observes, "if a well-known principle is applied for the first time to produce a practical result for a special purpose, has never been disputed; and it would be very strange and unjust to refuse the same legal effect, when the inventor has the additional merit of discovering the principle, as well as its application to a practical object."

Then he observes again: "Is it an objection to the patent, that in its application of a new principle to a certain specified result, it includes every variety of mode of applying the principle, according to the general statement of the object and benefit to be attained? This," he observes, "is a question of law; and I must tell you distinctly that this generality of claim, that is, for all modes of applying the principle to the purpose specified, according to or within a general statement of the object to be attained, and of the use to be made of the agent to be so applied, is no objection to the patent. The application or use of the agent for the purpose specified may be carried out in a great variety of ways, and only shows the beauty, and simplicity, and comprehensiveness of the invention."

This case was carried up to the House of Lords on exceptions to the charge, and among others to this part of it, which was the sixth exception, and is as follows: "In so far as he (the judge) did not

## Dissenting opinion.

direct the jury, that, on the construction of the patent and specification, the patentee cannot claim or maintain that his patent is one which applies to all the varieties in the apparatus which may be employed in heating air while under blast, but was limited to the particular described in the specification." And although the judgment of the court was reversed in the House of Lords on the eleventh exception, it was expressly affirmed as respects this one. Lord Campbell at first doubted, but after the decision of the courts in England on this patent, he admitted the instruction was right. Webster's P. C., 683, 684, 698, 717.

I shall not pursue a reference to the authorities on this subject any further. The settled doctrine to be deduced from them, I think, is that a person having discovered the application for the first time of a well-known law of nature, or well-known property of matter, by means of which a new result in the arts or in manufactures is produced, and has pointed out a mode by which it is produced, is entitled to a patent; and, if he has not tied himself down in the specification to the particular mode described, he is entitled to be protected against all modes by which the same result is produced, by an application of the same law of nature or property of matter. And *a fortiori*, if he has discovered the law of nature or property of matter, and applied it, is he entitled to the patent and aforesaid protection.

And why should not this be the law? The original conception, the novel idea, in the one case, is the new application of the principle or property of matter, and the new product in the arts or manufactures; in the other, in the discovery of the principle or property, and application, with like result. The mode or means are but incidental, and flowing naturally from the original conception; and hence of inconsiderable merit. But, it is said, this is patenting a principle, or element of nature. The authorities to which I have referred answer the objection. It was answered by Chief Justice Eyre, in the case of Watt's patent, in 1795, fifty-seven years ago; and more recently in still more explicit and authoritative terms. And what if the principle is incorporated in the invention, and the inventor protected in the enjoyment for the fourteen years. He is protected only in the enjoyment of the application for the special purpose and object to which it has been newly applied by his genius and skill. For every other purpose and end, the principle is free for all mankind to use. And where it has been discovered as well as applied to this one purpose, and opened to the world as to every other, the ground of complaint is certainly not very obvious. Undoubtedly, within the range of the purpose and object for which the principle has been for

## Dissenting opinion.

the first time applied, piracies are interfered with during the fourteen years; but anybody may take it up and give to it any other application, to the enlargement of the arts and of manufactures, without restriction. He is only debarred from the use of the new application for the limited time, which the genius of others has already invented and put into successful practice. The protection does not go beyond the thing which, for the first time, has been discovered and brought into practical use; and is no broader than that extended to every other discoverer or inventor of a new art or manufacture.

I own, I am incapable of comprehending the detriment to the improvements in the country that may flow from this sort of protection to inventors.

To hold, in the case of inventions of this character, that the novelty must consist of the mode or means of the new application producing the new result, would be holding against the facts of the case, as no one can but see that the original conception reaches far beyond these. It would be mistaking the skill of the mechanic for the genius of the inventor.

Upon this doctrine, some of the most brilliant and useful inventions of the day, by men justly regarded as public benefactors, and whose names reflect honor upon their country,—the successful application of steam-power to the propulsion of vessels and railroad cars; the application of the electric current for the instant communication of intelligence from one extremity of the country to the other; and the more recent but equally brilliant conception, the propulsion of vessels by the application of the expansibility of heated air, the air supplied from the atmosphere that surrounds them,—it would be found, on consulting the system of laws established for their encouragement and protection, that the world had altogether mistaken the merit of their discovery; that, instead of the originality and brilliancy of the conception that had been unwittingly attributed to them, the whole of it consisted of some simple mechanical contrivances which a mechanician of ordinary skill could readily have devised. Even Franklin, if he had turned the lightning to account, in order to protect himself from piracies, must have patented the kite, and the thread, and the key, as his great original conception, which gave him a name throughout Europe, as well as at home, for bringing down this element from the heavens, and subjecting it to the service of man. And if these simple contrivances, taken together, and disconnected from the control and use of the element by which the new application and new and useful result may have been produced, happen to be old and well known, his patent would be void; or if some

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Syllabus.

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follower in the track of genius, with just intellect enough to make a different mechanical device or contrivance for the same control and application of the element, and produce the same result, he would, under this view of the Patent Law, entitle himself to the full enjoyment of the fruits of Franklin's discovery.

If I rightly comprehend the ground upon which a majority of my brethren have placed the decision, they do not intend to controvert so much the doctrine which I have endeavored to maintain, and which, I think, rests upon settled authority, as the application of it to the particular case. They suppose that the patentees have claimed only the combination of the different parts of the machinery described in their specification, and therefore are tied down to the maintenance of that as the novelty of their invention. I have endeavored to show that this is a mistaken interpretation; and that they claim the combination, only when used to embody and give a practical application to the newly-discovered property in the lead, by means of which a new manufacture is produced, namely, wrought pipe, out of a solid mass of lead; which, it is conceded, was never before successfully accomplished.

For these reasons, I am constrained to differ with the judgment they have arrived at, and am in favor of affirming that of the court below.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs, and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

REVERSED WITH COSTS.

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THE TROY IRON AND NAIL FACTORY, APPELLANT, v. ERASTUS CORNING,  
JOHN F. WINSLOW, AND JAMES HORNER.

(14 Howard, 193.)

1. In 1834, Burden obtained a patent for a new and useful improvement in the machinery for manufacturing wrought nails and spikes, which he assigned to the Troy Iron and Nail Factory, and also covenanted that he would convey to that company any improvement which he might thereafter make.



## Statement of the case.

2. In 1840, he made such an improvement for making hook and brad headed spikes, with a bending lever, which he assigned to the Troy Iron and Nail Factory in 1848.
3. Before this last assignment, however, viz., in 1845, Burden made an agreement with Corning, Horner, and Winslow, in which, amongst other things, it was agreed that both parties might thereafter manufacture and vend spikes of such kind and character as they saw fit, notwithstanding their conflicting claims.
4. Owing to the peculiar attitude of the parties to each other at the time of making this agreement, and the language used in it, it cannot be construed into a permission to Corning, Horner, and Winslow to use the improved machinery patented by Burden in 1840; and the right to use it having passed to the Troy Iron and Nail Factory, a perpetual injunction upon Corning, Horner, and Winslow will be decreed.

THIS was an appeal from the Circuit Court of the United States for the Northern District of New York.

The facts are all stated in the opinion of the court.

The bill was filed in the Circuit Court by the Troy Iron and Nail Factory against Corning, Winslow, and Horner, to restrain them from violating a patent issued to Henry Burden on the 8th of September, 1840, for new and useful improvements in the machinery for making hook or brad headed spikes, which patent had been assigned to them; and also to account for the profits.

After the proceeding mentioned in the opinion of the court, the Circuit Court passed the following decree:

"This cause having heretofore been brought to a hearing upon the pleadings and proofs, and counsel for the respective parties having been heard, and due deliberation thereupon had, and it appearing to the said court that the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued to the said Henry Burden, bearing date the 2d of September, 1840, as in said bill of complaint set forth, and that the said complainants have a full and perfect title to the said patents for said improvements, by assignment from the said Henry Burden, as is stated and set forth in the said bill of complaint:

"But it also further appearing to the court, on the pleadings and proofs, that the instrument in writing, bearing date the 14th of October, 1845, stated and set forth in the said bill of complaint, and also in the answer of the said defendants thereto, entered into upon a settlement and compromise of certain conflicting claims between the said parties, and among others of mutual conflicting claims to the improvements in the spike-machine in said bill mentioned, and when said instrument was executed by the said Henry Burden of the one

## Argument for the appellants.

part, and the said defendants of the other, the said Henry Burden at the time being the patentee and legal owner of the said improvements, and fully authorized to settle and adjust the said conflicting claims, did, in legal effect, and by just construction, impart, and authorize, and convey a right to the defendants to use the said improvements in the manufacture of the hook-headed spike, without limitation as to the number of machines so by them to be used, or as to the place or district in which to be used:

"Therefore, it is ordered, adjudged, and decreed that the said bill of complaint be, and the same is hereby, dismissed with costs, to be taxed, and that the defendants have execution therefor."

From this decree, the complainants appealed to this court.

It was argued by *Mr. Johnson* and *Mr. Stevens*, for the appellants, and by *Mr. Seward* and *Mr. Seymour*, for the appellees.

As the case turned mainly upon the construction of the agreement of October 14, 1845, (which is inserted in the opinion of the court,) only such of the arguments of counsel will be given as relate to that construction.

The counsel for the appellants contended—

*Third.* It is respectfully submitted, that the instrument of the 14th of October, 1845, does not convey to the defendants any right or title to said invention, or give them any authority to use it in manufacturing hook-headed spikes. Such was not the object or intention of the parties.

This instrument was executed under the following circumstances:

At the June Term of the Circuit Court, 1843, Mr. Burden recovered a judgment for \$700 against the defendants for violating this patent.

On the 2d of October, 1843, Mr. Burden filed his bill in equity in said Circuit Court, to restrain the defendants from further infringing the patent, and for an account.

After this bill was filed, the defendants ceased using the invention for a short time; and then commenced using it again, as Mr. Burden was informed. Mr. Burden, therefore, on the 13th of November, 1844, made a new affidavit, to obtain an injunction upon his bill previously filed; and on the 20th of November, obtained an order for an injunction, by default.

On the 25th of November, 1844, the defendant Winslow, and two men by the name of Osgood and Blanchard, made affidavits in said

## Argument for the appellants.,

cause, for the purpose of moving the court to open the order granting an injunction; in which affidavit they all swear that defendants did not use Mr. Burden's invention in making hook-headed spikes, but made them with machinery entirely different in principle and mode of operation.

The machinery by which defendants claimed to make the hook-headed spike, after the bill was filed, is described in two patents granted to the defendants, or some of them.

Prior to these legal proceedings, in November, 1844, the parties had been endeavoring to settle, but did not succeed; subsequently, negotiations for a settlement of the suit were renewed. Mr. Burden claimed that he had the exclusive right to manufacture the hook-headed spikes by machinery, and insisted that defendants should cease making such spikes by machinery. Defendants insisted they had a right to make such spikes by their own machinery, which they insisted in their affidavits, made November 25, 1844, was entirely different in principle and mode of operation from that patented to Mr. Burden.

Mr. Burden claimed that defendants had violated his patent for machinery for making horseshoes, and told defendants, if they did not immediately desist from using his horseshoe-machine, he would prosecute them; and they did desist and stop, six months before the settlement was made.

It is necessary and proper to take these facts and circumstances into consideration, in giving a construction to the agreement of the 14th of October, 1845.

"It is well settled, that, in the construction of all contracts, the situation of the parties and the subject-matter of their transactions may be taken into consideration in determining the meaning of any particular sentence or provision. Extraneous evidence is admissible, so far as to ascertain the circumstances under which the writing was made, and the subject-matter to be regulated by it." *Sumner v. Williams*, 8 Mass., 214; *Fowle v. Bigelow*, 10 Mass., 384; *Wilson v. Troup*, in the Court for the Correction of Errors of N. Y., 2 Cow., 228-9; *Nesmith v. Calvert*, 1 Wood. & Min., 40.

I. This agreement does not, by its terms, convey, or purport to convey, or in any manner to give or invest the defendants with any interest in, or right or authority to use, the machinery patented in September, 1840, to make hook-headed spike.

1. It was contended, by the defendants, (and, as we understand the decree, so decided,) that the second clause in the agreement, in legal effect, did impart, authorize, and convey to the defendants a

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Argument for the appellants.

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right to use the said improvements, without limitation as to the number of machines used by them, or as to the place or territory where they might be used.

The second clause of the agreement is in these words: "And it is further agreed, that the said parties may each hereafter manufacture and vend spike of such kind and character as they see fit, notwithstanding their conflicting claims to this time."

After the judgment at law, in 1843, there was no conflict as to the right of defendants to use Mr. Burden's improvement in manufacturing hook-headed spike. That had been fully settled against the defendants, by the suit at law, and conceded by them.

The defendants did not claim the right to use Burden's invention, but only the right to make said spike by machinery which they claimed was different from Mr. Burden's, both in principle and operation.

Mr. Burden denied this right claimed by the defendants, and claimed that he had the exclusive right to make such spike by machinery. This was the only conflicting claim, as to the right to make spike at the time of the settlement. By this clause in the agreement, Mr. Burden relinquished his pretensions to the exclusive right to make hook-headed spike by machinery; but he gave no right to the defendants to use his improvement in manufacturing such spike.

Whether Mr. Burden was right or wrong in his pretension to the exclusive right to make such spike by machinery, can in no manner affect the construction of the agreement.

The intention of the parties as expressed in the agreement, taken in connection with the state of facts and circumstances under which it was executed, and the subject-matter intended to be regulated by it, must control the construction of this clause. Mr. Burden supposed he had such exclusive right, and simply relinquished it, without the most remote idea that he was conveying to the defendants any right to use his improvement, much less that he was conveying an interest in his patent equal to one-half of it.

The settlement of the equity suit; the relinquishment by Mr. Burden of his pretension to exclude the defendants from making hook-headed spike by machinery; and the settlement, by defendants, of Mr. Burden's claim against them, for infringing his horseshoe patent, for which he had threatened them with a suit, fully satisfies every clause in the agreement; and it cannot be stretched to the enormous extent claimed by defendants, without interpolating other important provisions, which cannot at law be accomplished by parol evidence. An assignment, or any other conveyance of any part of a patent, or of any interest in or under it, must be in writing. Contracts which

## Argument for the appellants.

by law are required to be in writing, cannot rest partly in writing and partly in parol. Is it not most extraordinary that the defendants did not have this agreement recorded in the Patent Office until the 21st of August, 1848, if they had had the least idea that it conveyed to them such an important right as they now claim? Patent Act of 1836, sec. 11; Curtis on Patents, 478.

This instrument has neither the form nor substance of a license or assignment, or any other conveyance of an interest in a patent heretofore in use or known.

If the parties had intended this instrument as a conveyance of any interest in Mr. Burden's improvement, it would have been very easy to have said so. *Nesmith v. Calvert*, 1 Wood. & Min., 40; *Iggulden v. May*, 7 East, 242.

The court below fell into the mistake, that the cause depended upon the question, whether the agreement authorized the defendants to make hook-headed spike.

The opinion of the court, after stating the second clause in the agreement, proceeds:

"Why stipulate that the defendants may thereafter manufacture and vend spikes of any character and description, without regard to previous claims to the contrary, if it was not intended to admit or concede the right to manufacture hook-headed spikes? And how can we say that this particular spike is not embraced in the stipulation?"

"What is meant by the agreement that the defendants may manufacture spikes of such a kind and character as they see fit, notwithstanding their (the parties') conflicting claims to this time, if it was intended to exclude hook-headed spikes? The argument is quite as strong and well founded, to exclude spikes of any other description. Indeed, stronger, if it were possible, as this particular spike was the principal item in controversy at the time of the compromise or settlement, and a suit was pending in respect to it.

"The language of the instrument is certainly most remarkable, if it was intended by the parties to exclude the defendants from the right to make this particular spike, as there are not only no words of exclusion or prohibition, but an express admission of the right, in terms so full and specific that no argument can make it clearer. We are asked to interpret a stipulation to make any kind of spike the parties see fit, to mean any kind except hook-headed; and spikes, too, in the case of a compromise of a disputed right to manufacture spikes of this character and description, among other matters, this being regarded as the principal one. We think it impossible to

come to any such conclusion, without a disregard to the clear import of the agreement."

The counsel for the appellant in the court below must have been exceedingly unfortunate, if his language presented any such idea. The bill does not claim it, and the written points handed to the court do not pretend it. On the contrary, it was conceded that Mr. Burden relinquished his pretensions to the exclusive right to make those spike by machinery, but insisted that he had given no right to defendants to use his improvements for that purpose.

2. The decree assumes that among the conflicting claims settled by the agreement of 14th October, 1845, were the mutual conflicting claims to the improvements in the spike-machine patented by Mr. Burden.

This is mere assumption, founded wholly in mistake. No such conflicting claim is stated in the instrument, and none such was proved to exist at the time of the settlement. The very reverse was sworn to the year before, by the defendant Winslow himself, and by two other witnesses, by his procurement. The correspondence which took place before the settlement shows that no such claim was set up or pretended by the defendants. The judgment at law had fully and definitely settled and determined that the defendants had no such right.

But if such conflicting right to Mr. Burden's improvement had existed at the time of the settlement, the terms of the agreement would not confer any right upon the defendants to use it.

The agreement concedes the defendants' right to make any kind of spike they see fit, which, of course, embraces hook-headed spike; but it does not, directly or indirectly, give or concede the right to defendants to use Mr. Burden's improvement for that purpose. "The said parties may each hereafter make and vend spike of such kind and character as they see fit." But how manufacture? The agreement does not specify how; but the plain construction is, that it should be done as it had been done from the recovery of the judgment at law up to the time of the settlement—that Mr. Burden should manufacture the spike with his machine, and the defendants with their machine, which they claimed and swore was totally different from Mr. Burden's in principle and mode of operation. Can it be pretended that the defendants gave Mr. Burden any right to use their machine? Had Mr. Burden ever claimed any such right? Had it been shown that hook-headed spike could not be made without the use of Mr. Burden's improvement, it might have furnished some

## Argument for the appellants.

ground for an argument that, by implication, such right was given by the agreement.

But such was not the fact. Hook-headed spike could be made, and were made, by hand, prior to Mr. Burden's invention; and the defendants show that as early as the fall of 1844 they had machinery by which they made hook-headed spike, which was wholly different, both in principle and mechanical operation, from Mr. Burden's improvement; and the only right they claimed, after the judgment at law up to and at the item of the settlement, was to make such spike by that machinery, and disclaimed all right or desire to use Mr. Burden's improvement.

3. Mr. Burden could not have intended to convey such an interest to the defendants.

It would have been a violation of his duty to, and his contract with, the appellant; and would have deprived him of the benefit of a contract from which he received more than \$10,000 annually.

4. There was no adequate consideration for the conveyance of such an extensive interest in this patent.

The defendants allege, in their answer, that the purchase by them of the appellant of half of a dock was a part of the same transaction, and a part of the consideration for this agreement.

This pretense is fully disproved. The evidence clearly shows that the agreement to purchase the dock, although made at the same time with the other agreement, had no connection with it, and that the one-half of said dock was worth more than the \$1,500 which defendants paid for it.

The defendants also set up, in their answer, that their agreement not to make horseshoes was a part of the consideration of the agreement on the part of Mr. Burden.

The evidence shows the facts to be, that, prior to this settlement, the defendants had been infringing Mr. Burden's patent for a machine to make horseshoes; were threatened with a suit if they did not desist; and they did desist six months before the settlement. The defendants had a patent for machinery to make horseshoes, but it was worthless.

Mr. Burden did not claim that the defendants should not make horseshoes with the machinery they had patented, but that they should not use the machinery he had patented for that purpose. If horseshoes could have been made by the machinery patented by defendants, the agreement gives neither Mr. Burden nor the appellant any right to use that machinery, nor does it restrict the defendants from selling to others the right to make horseshoes with the machinery

patented by them. There is nothing in the agreement which would prohibit the defendants, or their assignees, from maintaining a suit against the appellant or any other person for infringing defendants' patent, should the appellant or any other person use the invention thereby patented.

The defendants also allege, in their answer, that they had used the improvement in question to make hook-headed spike since said settlement, and appellant never requested them to cease using the same, or to account for any profits for such use.

The fact thus alleged, the defendants insisted, in the court below, was a circumstance to show that the appellant and Mr. Burden understood and considered the said agreement as conveying to the defendants the right to use said improvement.

The answer to this is—

1. The answer does not allege that the appellant, or any of its officers or agents, knew that said defendants were using said improvement.

2. It is proved that neither Mr. Burden nor any other of the officers or agents of the appellant knew that defendants were using said improvement until August, 1847.

Defendants also insist that Mr. Burden, by his letters, bearing date between the 9th of March, 1846, and the 29th of December, 1846, both inclusive, requesting defendant Winslow to agree upon the price for which they would sell hook-headed and other spike, recognizes the defendants' right to use said improvement.

The answer to this position is, that just such an arrangement as requested in those letters had existed between the appellant and defendants for nine years before the settlement of 14th of October, 1845, and at the time Mr. Burden wrote those letters he did not know that defendants were using his improvement to manufacture hook-headed spike.

The letters were, also, written by Mr. Burden before he knew defendants were using his improvement in making hook-headed spike.

Indeed, none of the letters in any manner intimate that the defendants were using, or had any right to use, the improvement.

The counsel for the defendants in error contended that the decree of the Circuit Court should be affirmed, because—

- I. The agreement of October 14, 1845, was a valid agreement, binding upon the parties.

1. It was made by parties fully competent to contract in reference to the subject-matter of the contract.



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Argument for the defendants in error.

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Burden was patentee, and as such could contract for himself as the owner of the patent. He was also at the time a large stockholder in the complainants' corporation, and their agent, and as such could contract for them.

The allegation made by the complainants, in their bill of complaint, that Henry Burden "had no power or authority to give such license, your orator having been the legal and equitable owner of the said last-mentioned patent, and the rights and privileges granted and secured thereby, from the time said patent was granted," is not sustained by the proof.

The only proof tending to show that on the 14th of October, 1845, the complainants were the owners of this improvement of the bending lever, and that therefore Burden had no authority to grant a license, or make a contract as to the use of the same, is to be found in the agreement between Burden and complainants as to the patents for the spike-machine and the horseshoe, and dated 2d of December, 1836.

In reference to this agreement, the defendants insist as follows:

1. The agreement between the plaintiffs and Henry Burden, of December 2, 1836, did not even purport to convey to the plaintiffs any interest or right to the patent of 1840, or to the bending lever, the thing patented. It first gives the right to use the machines for manufacturing wrought nails or spikes, then on the premises of the company; and secondly, the exclusive right to construct other machines for the manufacturing wrought nails or spikes, after the method invented by Burden, with all the improvements which he had made, or should make in the same, in any other part of the United States; and thirdly, a covenant that he, Burden, would obtain a patent for any improvements which he should afterward make in his nail and spike machine; and then provides that "the license hereby granted to the party of the second part shall be deemed to extend to all such improvements." It only contemplates the granting of a license; and the statement in the assignment of June 19, 1848, that Burden had agreed to transfer and assign the improvement, is not true.

The bending lever, patented by the patent of 1840, was not then in existence. It was a mere contingent possibility, and therefore was not susceptible of being conveyed. There was nothing to convey. Phillips on Patents, 354; Curtis on Patents, sec. 189.

The privilege of assigning, given by the eleventh section of the Patent Act of July 4, 1836, implies that the thing assigned shall be then in existence; and the subsequent requirement in the same section, as to recording the assignment, supports the same idea.

2. Even if this agreement did purport to grant and assign a future improvement thereof, such grant could not apply to the bending lever, for the reason that the bending lever is not an improvement upon either of the patented machines mentioned in the agreement of December 2, 1836, but is a distinct and independent article or invention, equally applicable to any spike-machine, and, in fact, used upon various other machines.

The plaintiffs consider the agreement of December 2, 1836, as merely a covenant to convey the improvement alleged to have been patented on the 2d of September, 1840, and have accordingly resorted to a special assignment of it, which was made on the 19th of June, 1848, and which in terms refers to the agreement of December, 1836, as merely a covenant to convey subsequent improvements, and purports to have been given in performance of such covenant.

The right of the plaintiffs to this improvement of the bending lever is based in their bill upon the assignment of the 19th of June, 1848. This right is therefore subject to any rights that were acquired by the defendants by the agreement of October 14, 1845.

But if the complainants had, previous to the 14th of October, 1845, become the owners of the improvement called the bending lever, and the patent therefor, still, as general agent of the corporation, Burden had a right to enter into the agreement of October 14, 1845, and it binds his principals.

3. The agreement of October 14, 1845, was founded upon a good and valuable consideration as between the parties,—first, the settlement of the suit then pending between them; and second, the relinquishment by the defendant Winslow, in behalf of himself and his co-partners, of the right to manufacture the patent horseshoe, an advantage worth to the other contracting party \$10,000 per annum.

4. The agreement, too, was carried out by the parties,—first, by the conveyance of the dock property by the plaintiffs, and its occupation by the defendants; second, by the payment of the consideration of the dock property by the defendants; thirdly, by the relinquishment by the defendants of the horseshoe business, from that time to the present, and the enjoyment of it as a monopoly ever since by the plaintiffs; fourth, by the continued use by the defendants of the bending lever in making hook-headed spikes, from the 14th of October, 1845, to the 8th of July, 1848, two years and about nine months, without objection, they having made during that period hook-headed spikes to the value of over \$137,000.

III. The agreement of October 14, 1845, was a contract for the settlement of conflicting claims to two patented machines,—one for

the bending lever, and the other for the horseshoe-machine; and it not only gives rights to make the spikes and the horseshoes, but to use the respective patented machines in making them.

The agreement of October 14, 1845, does not, in terms, give the right to the defendants to use the machines patented by Burden, by his patent of 1840, but it does give it by the strongest implication. It releases all claims for violation of patent-rights up to that date, and gives the right to both parties thereafter to manufacture and vend spike of such kind and character as they see fit, notwithstanding their conflicting claims to that time.

Defendants' exhibits show that those conflicting claims related only to the use of the patented machinery. This is also shown by Burden's letters. The subject-matter of this general settlement was, therefore, their conflicting claims to the use of the patented machinery. The agreement gives the right to make the spike, which could be made for sale in market only by the use of the bending lever, or of some analogous device. *Rutger v. Kanows*, 1 Wash. C. C., 168; Phillips on Patents, 346.

A construction of the agreement of October 14, 1845, which would allow the defendants only the privilege of making the hook-headed spikes, and would deny them the use of the bending lever in making them, would render the instrument senseless, absurd, and inoperative.

For if it is held that the defendants obtained under the agreement only the privilege of making hook-headed spikes, either by hand or by the use of any machinery which they might choose, other than that which should infringe upon Burden's patent, then it results that the defendants relinquish the patent horseshoe business, worth, as is proved by the testimony of Mr. Davidson, \$10,000 per annum, for the privilege of doing just what they had a right to do before, and what everybody else had the right of doing, that is, making those spikes by hand, or with any machinery not infringing on Burden's patent. Such a construction would be contrary to the well-settled rule in the interpretation of contracts, that when a clause is capable of two significations, it should be understood in that in which it will have some operation, rather than in that which it will have none, "*ut res magis valeat quam pereat*." Pothier, cited in 2 Comyn on Contracts, 533; *Parkhurst v. Smith*, Willes' Reports, 332; *Archibald v. Thomas*, 3 Cowen, 290. An agreement, or contract, must have a reasonable construction, according to the intent of the parties,—as if a man agree with B for twenty barrels of ale, he shall not have the barrels after the ale is spent. Comyn's Digest, title Agreement, C. So if

a man promise payment without saying to whom, it shall be intended to him from whom the consideration comes. Cro. Eliz., 149. And upon a promise of payment, according to the rate of forty shillings per ton, it shall be intended that payment will be made for the odd pounds, according to the same rate. Yelverton, 134.

The practical construction of both parties has been in conformity to the interpretation on which the defendants insist,—“*Contemporanea expositio est fortissima lex.*”

If the construction were a doubtful one, it should, under the circumstances, be held to be against that set up by the plaintiffs, whose grantor, Henry Burden, is the contractor. In a case of doubt, the words of a promise or covenant are to be taken most strongly against the promisor or contractor. Coke Litt., 183a. This rule should be applied in this case especially, for two very apparent reasons: First, because it was well understood by both parties with what machinery alone these hook-headed spikes could be successfully made for sale in market, and that the defendants were then using that machinery in their works; and, secondly, because Burden had a strong pecuniary motive to deal in generalities, and not to grant specifically and clearly a license to use the bending lever. He feared he might jeopard the thirty per cent. secured to him by the agreement of December 2, 1836, and which was afterwards in controversy, and was claimed by the plaintiffs to have been forfeited by him, and yet he desired to obtain the monopoly of the horseshoe business.

The contemporaneous exposition of the agreement by Burden is in accordance with the position of the defendants. See his letter of December 15, 1845, and his letter of December 11, 1846. In this latter letter, Burden speaks of his intention to share the spike business with defendants. He very well knew that could not be done except by uniform prices, and that we could have no uniform price with him unless we used the bending lever.

But there was an actual sharing between appellant and respondents of contracts for spikes. Burden declared that it was his intention to share with respondents the spike business, and this was done, as is shown by his letters. Such was the practical contemporaneous construction of the agreement; and it appears by Burden's letter of February 10, 1848, that not only was there to be a uniform price for hook-headed spikes, but that the whole field was to be occupied by the parties in common, and to the exclusion of all others. The whole object of this letter was to tell respondents what he had been doing to protect their common rights. Can there be anything more needed to show that it was the understanding of both parties, that by the

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agreement of October 14, 1845, respondents had the right to use the bending lever?

Winslow's letters, written in January, 1845, show that respondents were using the bending lever at that time, and that Burden then knew it. In Burden's letter of January 10, 1845, and in Winslow's reply to it of January 13, 1845, they both refer to "the machinery in question," which can only mean the bending lever.

IV. But whatever might have been the construction which a court would, under other circumstances, have put upon this agreement, a court of equity will not now grant an injunction, as is prayed for in the complainants' bill, after an acquiescence in the use of the patented machinery, under this agreement of October 14, 1845, for near three years before the commencement of this suit. *Wyeth v. Stone*, 1 Story, 273; *Rundle v. Murray*, Jacob's R., 311; *Williams v. The Earl of Jersey*, 1 Craig. & Phil., 91; *Warwick v. Hooper*, 3 Eng. Law and Eq. R., 233, cited; U. S. Dig., Appendix, vol. 5, 1851, title Patent.

Mr. Justice WAYNE delivered the opinion of the court.

This is an appeal from the Circuit Court of the United States for the Northern District of New York.

The appellants are a manufacturing company incorporated by the laws of the State of New York. They aver that Henry Burden was the inventor of a new and useful improvement in the machinery for manufacturing wrought nails and spikes, for which letters patent were granted to him on the 2d of December, 1834. They allege that it was assigned to them for a valuable consideration, and also that Burden covenanted with them, if he should thereafter make any improvement upon his invention, that he would convey the same to them. Burden afterwards did make a new and useful improvement in machinery for making hook or brad headed spikes, for which a patent was granted to him on the 2d of September, 1840. He assigned it to the complainants, in virtue of his covenant, whereby they became the exclusive owners of the patent. They then complain that the defendants had infringed the same, by having erected and put in use in their iron and nail works, in the city of Troy, four or five machines for the manufacture of hook or brad headed spikes, containing the improvements in their assigned patent, and had used them for manufacturing hook or brad headed spikes since the 15th of October, 1845.

It is also stated that Burden brought an action at law against the defendants, for an infringement secured by the patent of September 2, 1840. The defendants resisted a recovery, upon the ground that

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Burden was not the first inventor of the improvements for which that patent had been obtained. A trial of this case upon the merits resulted in a verdict for Burden for seven hundred dollars, which was carried into a final judgment against the defendants, after a motion which they made for a new trial had been overruled.

The defendants are then charged with again using the improvements in the patent of 1840, under the pretense that they have a license from Burden to do so. This is denied by the complainants; and they say if such license had been given by Burden, that it was in contravention of his assignment to them of his patent, by which they became the legal and equitable owners from the time it was granted, on September 2, 1840.

The bill is then concluded with a prayer that the court would enjoin the defendants, Corning, Horner, and Winslow, their attorneys, and agents, and workmen, to desist from making, using, or vending any machine containing the improvements for which letters patent were granted to Burden on the 2d of September, 1840, and from selling or using any spikes which they then had on hand, which had been manufactured by their machines containing the improvements of that patent. An account of the profits which they had derived from the use of such patented improvements is also called for.

The letters patent granted to Burden on the 2d of September, 1834, and that of the 2d of September, 1840, describing an improvement called a bending lever, in the machinery for making hook or brad headed spikes, are made exhibits to the bill.

This bill was answered by the defendants.

It admits that the complainants were an incorporated body, under the style of the Troy Iron and Nail Factory Company; also, that Henry Burden was the inventor of the improvements in the machinery for making nails and spikes, for which letters patent were granted to him in December, 1834, and that he assigned the same to the complainants two years thereafter. But they deny that there was any covenant in the assignment, or in any other agreement then recorded in the Patent Office, or any agreement between Burden and the complainants, obliging him to convey to them any improvement which he might make upon his invention. And they insist, if such an agreement was made, that, as it was only a covenant to convey a contingent possibility, which would be inoperative and void, it could not affect them. The defendants also admit that Burden obtained the patent of the 2d of September, 1840; but they deny its validity. They declare that the bending lever described in the specification of it, or one similar to it in form and principle of construc-

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tion and operation, had been invented and had been used by several persons, in making spikes, for several years before the patent had been obtained by Burden for his improvement of the bending lever. They state that it was invented by Thomas and William Osgood, and used by them in the years 1835-'36-'37-'38, upon one of their spike-machines, to make hook or brad headed spikes, which they sold during those years in Philadelphia. It is also stated by the defendants that the bending lever patented by Burden was the invention of one Ebenezer Hunt, whilst he was in the employment of the former. It is then admitted that Burden assigned to the complainants his patent for the bending lever in June, 1848; but it is said to have been fraudulently done, and that the appellants have no right, legal or equitable, to that improvement, under that assignment, or by that of the agreement between the complainants of Burden, of December, 1836. And, it is added, should they have any right or interest in the patent for Burden's bending lever, that the defendants have also the right to use the same under an agreement with Burden of the 14th October, 1845, which was made for himself, and in behalf of the appellants, as their agent, before he had assigned it to them in 1848.

The defendants then aver that this agreement of the 14th of October was made with the understanding, of both parties, that it would finally settle all differences between themselves, and Burden, and the complainants which had arisen out of counter-claims by both parties to a patent for making horseshoes, and also to a patent-right for making hook or brad headed spikes, each party claiming the right to manufacture and vend such horseshoes and such spikes under their respective counter-claims and patents, without the permission of either to the other, and to use, in the manufacture of the brad-headed spike, Burden's bending lever.

The consideration of the agreement is said to have been a purchase by the defendants from the complainants of an undivided half part of a dock on the Hudson River for \$1,500, a grant by the defendants to them for the exclusive manufacture of patent horseshoes, and a mutual relinquishment of their counter-claim to the patents for making hook-headed spikes by a bending lever. It is averred that they had used Burden's bending lever in the manufacture of such spikes from the date of the agreement, with his knowledge, without objection by him or by the appellants, and that Burden had discontinued the suit against them. It is not necessary to state more of the pleadings. The abstract given discloses what had been the relations between these parties for several years before this suit was brought,

and their views and conduct respecting the patent for the bending lever.

We will now turn to the evidence in the case. It shows, first, that every allegation in the bill has either been proved or admitted by the answer of the defendants, excepting such as they respectively make concerning the agreement of the 14th of October, 1845, which will hereafter have our attention.

The letters patent obtained by Burden in 1834, which describes a machine for making nails and spikes, is annexed as an exhibit to the bill, and so is that afterwards granted to them in 1840, for his improvement on the first, for making hook or brad headed spikes. The answer admits that he was the inventor of the first, and that he had a patent for it. It also admitted that he obtained a patent for the other; but it is denied that he was the inventor of it. This the defendants have failed to prove; and, in our opinion, the evidence given by them on that point rather serves to establish the originality of the invention than to impair it. We think so, because it is uncertain and conflicting, and, as our learned brother said concerning it in the court below, is irreconcilable. The appellants stand upon that patent as the first which was granted for the bending lever, and they may well do so, until other evidence than that in this record shall be given to disprove its originality. It is admitted that Burden assigned that patent also to the appellants; but it is said to have been fraudulently done, and that it was not made because Burden had covenanted, in his assignment to them of his first patent, to convey to the appellants any improvements he might thereafter make upon that machine during the time that the patent had to run. The assignment by Burden to the appellants of his patent for making wrought nails or spikes is dated in December, 1836, just two years after it was obtained. It contains, after the transferring clause, and in connection with it, these words: "With all the improvements which he hath made or shall make in the same, in any other part of the United States, as the said parties of the second part shall deem expedient, during the term for which the same are or may be patented by the said party of the first part." The assignment itself being admitted by the defendants, this, as a part of it, must also be included in the admission. It is, in our opinion, a covenant which bound Burden to convey to the appellants his improvement upon his machine of the bending lever. Though the assignment of it was not made until several years after it was patented, the appellants were equitably entitled to it before. Without something besides to sustain them than the delay in making the assignment, the defend-



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ants had no ground for stating that it was a fraudulent device to overreach and defeat the agreement between themselves and Burden of the 14th of October, 1845. The defendants also admit that they were sued by Burden in 1842 for an infringement of the rights secured to him by his patent for the bending lever; that though they had resisted it, upon the ground that Burden was not the inventor, the jury who tried the case upon its merits had returned a verdict against them for the infringement, with seven hundred dollars damages; and that it was carried into judgment. This was in the year 1843.

In November, 1844, Burden, believing that the defendants were again using his bending lever for making brad-head spikes, brought against them a bill to enjoin them from doing so, and asking for an account. They had notice of it, but, from some accidental cause, they did not appear to resist the application; and an injunction was granted until the further order of the court.

In a few days, with the view to be released from it, Mr. Winslow, in behalf of himself and his associates, filed an affidavit, with another made by Thomas Osgood and Israel Blanchard. In each of them, they swear that the defendants were not using Burden's invention in their manufacture of hook or brad headed spikes, but that they made them with machinery altogether different in principle and mode of operation from that which they were using when Mr. Burden sued them in 1842 for an infringement of his patent, and when he obtained a judgment against them. Mr. Winslow states that the machinery they were then using is entirely different in principle and operation from the machine used by Burden in making hook and brad headed spikes. Osgood and Blanchard, after stating that they had been in the employment of the defendants for several years, say that they were well acquainted with the process used by the defendants in making hook-headed spikes, and with that which they were using when the defendants were prosecuted for an infringement of Mr. Burden's patent, and that they were well acquainted with the improvement claimed to have been invented by Burden; that the machinery then used by the defendants not only differed from that which they used when they were prosecuted for an infringement of Burden's patent, but also that the process then in use by the defendants, by which the hook-head is formed, is entirely new, and different in principle and use from the bending lever described by Burden in his patent. They proceed to say that Burden's patent, in their opinion, is in no manner violated by the manufacture of hook-headed spikes, in the mode in which they are now made by the defend-

ants. The process mentioned by them, and by Mr. Winslow, is not stated in their affidavits. What it was, we do not know with certainty.

These affidavits show the attitude in which the defendants put themselves, on the 25th of November, 1844, in the suit then pending with Burden.

It was this: That, as a defense against that suit, they claimed the right to manufacture hook or brad headed spikes by machinery entirely differing in principle and operation from Burden's bending lever for the same manufacture.

So it continued until the agreement of the 14th of October, 1845, was made. Then, and the day after, all of the new processes mentioned in the affidavits of Winslow, Osgood, and Blanchard, for making brad-headed spikes, and such as are described in the patents obtained by the defendants, were set aside in their factory for Burden's more manageable and efficient bending lever.

This brings us to the consideration of the agreement. We give it *totidem verbis*:

"Agreement made this fourteenth day of October, 1845, between Henry Burden, of the one part, and Erastus Corning, James Horner, and John F. Winslow, of the other part. Whereas, a suit is now pending in the Circuit Court of the United States, in the Northern District of New York, in favor of the said Henry Burden, against the said Corning, Horner, and Winslow, arising out of the alleged violation and infringement of a patent-right claimed by said Burden for making of spike, both parties claiming the right to make said spike, it is now agreed, between the said parties, that the said suit shall be, and is hereby, discontinued, each party paying their own costs. And it is further agreed, that the said parties may each hereafter manufacture and vend spikes of such kind and character as they see fit, notwithstanding their conflicting claims to this time. And the said John F. Winslow, claiming, as patentee, to have the right, for the benefit of the said Corning, Horner, and himself, to manufacture the patent horseshoe, and the said Henry Burden also claiming such right exclusively, it is severally agreed, by said Corning, Horner, and Winslow, that said Burden may manufacture said patent horseshoes, and that said Corning, Horner, and Winslow will not manufacture them. And each party, in consideration of the premises, hereby releases to the other, or others, all claim, demand, and cause of action, by reason of any violation of the patent-rights claimed by them as aforesaid, to the date thereof.

"Dated October 14, 1845.

H. BURDEN."

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It contains, besides its premises, which will be seen are not unimportant for the construction of it, four substantive clauses.

First, the discontinuance of the suit then pending between the parties, each party to pay their own costs. Next, that each party might thereafter manufacture spike of such kind and character as they see fit, notwithstanding their conflicting claims to that time. Then the concession by the defendants to Burden, that he may manufacture the patent horseshoes, and that they will not do so, though they had claimed the right to make them, notwithstanding Burden's exclusive claim for that purpose. And this is followed by releases by each party to the other of all claim, demand, and causes of action, by reason of any violation of the patent-rights claimed by them as aforesaid, to the date hereof.

The defendants contend, that, in virtue of this agreement, they have a right to use the Burden bending lever upon their spike-machines; that it was made for the settlement and compromise of all differences and claims then existing between themselves and Burden, on account of their counter-claims for making patent horseshoes and brad-headed spike; and that the consideration of the agreement on their part, was that they had given to these appellants fifteen hundred dollars, for an undivided half part of a dock on the Hudson River; had conceded to them an exclusive privilege to make patent horseshoes; and that each party had relinquished to the other their patents for making hook-headed spikes by a bending lever, so that both might use that of the other. It is further stated by the defendants that they had fully performed their obligations of the agreement, and that they had, from the date of it, used Burden's bending lever in making spike, with the knowledge of Burden and the appellants, without any objection by either of them.

From the premises of the agreement, it appears that the suit to be discontinued was one which Burden had brought against Corning, Horner, and Winslow, for an alleged infringement of his patent for making spike, each party in the suit claiming the right to do so. What their counter-claims were, are not given in the agreement. They are, however, distinctly recited in the bill and in the answer of the defendants, as they say they existed at the date of the agreement. Each party, at that time, claimed a right to make brad-headed spikes by different machines. Burden's claim is put upon his patent for the bending lever. The defendants denied that they had infringed it by the machine which they had in use, and swear that it was different in principle and operation from Burden's patent bending lever. It is also said by them, in their answer, that there were

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differences between them as to a patent for making the horseshoe. The differences, however, on that account, were never litigated by the parties, and the subject is only before us because it is mentioned in the agreement, and in the answer of the defendants in this suit.

Having ascertained, from the agreement itself, and from the pleadings in this suit, what were the conflicting claims between the parties when the agreement was made, we are prepared to give our construction to that clause of it from which the defendants claim the right, or a license, to use Burden's bending lever for making brad-headed spikes.

It is in these words: "And it is further agreed, that the said parties may each hereafter manufacture and vend spike of such kind and character as they see fit, notwithstanding their conflicting claims to this time,"—that is, up to the date of the agreement.

The limitation as to time clearly indicates, as the existing litigation between them in the suit had been the rights claimed by both in it to manufacture brad-headed spike with a bending lever, operating differently in the machines which they were respectively using in their factories, that each thereafter could make and vend them, notwithstanding the claim made by Burden, in his bill, that he had by his patent the exclusive right to make them. The words are, "that the said parties may each hereafter manufacture and vend spike of such kind and character as they see fit." Burden had obtained at law one verdict against the defendants, for a violation of his patent, and the suit then pending was another, which he had brought in equity, to restrain the parties from continuing the infringement. They deny that the judgment against them in the suit at law had settled the validity of Burden's patent; that that question was still open in the second suit, as they say it is in this, the third suit; but in no one of them did they ever claim the right to use Burden's invention as such, or as they now claim to do, under the agreement, but they claimed, in all of them, only a right to make brad-headed spikes by machinery which was different in principle and operation from Burden's patent. When the parties were adjusting a compromise of the second suit, and up to the time when it was done, Burden had claimed an exclusive right from his patent to make brad-headed spike with a bending lever. The defendants claimed also that right, and it was because they exercised it that Burden sued them for an infringement of his patent. Both parties were making brad-headed spike: Burden, under an unquestioned right, growing out of his patent; the defendants, under a controvertible claim, which the suit was brought to settle judicially. They had already

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almost obtained a monopoly for the supply of such spike for the railroads of the country. It was with the hope of doing so entirely, and with the expectation of dividing the spike business of the United States between them, notwithstanding the threatening competition of other persons who claimed the right to make brad-headed spike, and were making them with a bending lever, that Mr. Burden and these defendants were induced to compromise their litigation. It was a mere matter of interest which actuated them, without any other sympathies between them than the disinclination of all persons to have the relations of social life and of business broken up by protracted litigation. But each party, business-like, alive to his own interest, did not mean to make any sacrifice to the other, except such as their common object might require; that was, to drive all others out of the brad-headed spike trade. Burden had obtained one verdict against the defendants for infringing his patent. He was suing them for doing so again, and had obtained no injunction *nisi*, to restrain them from continuing it. They continued to make spike with a machine, alleging it to be no infringement of their competitor's patent. That was the point of controversy. It was believed by both of them that their common interest required a relinquishment of it by Mr. Burden, and he made it, intending that each might thereafter make brad-headed spike himself, as he had a right to do from his patent, and the defendants, as they represented themselves to be doing, by the machine which they swear was different in principle and operation from his, and no infringement of it. Brad-headed spike could be made with either of them, and that being the case, it was agreed that each might thereafter manufacture and vend spike of such kind and character as they might "see fit" to do.

It was admitted, in the argument of this case, (and, had it not been, it is certain,) that the agreement of October 14, 1845, does not, in terms, give to the defendants the right to use the machines patented by Burden in 1840. But it is said it does give that right by implication; that such was the understanding and intention. And that is inferred from matters in the agreement, and from a circumstance out of it, which are said to determine its construction in favor of the claim made by the defendants to use Burden's patent. We proceed to examine it.

In the agreement, it is said: "Each party, in consideration of the premises, releases to the other all claim, demand, and cause of action, by reason of any violation of the patent-rights claimed by them as aforesaid, to the date hereof." Those are its words.

By the premises, of course, in its use here, is meant all of the deed

which precedes the releases, making every part or clause the consideration for which the releases are given. The release is a relinquishment by both parties of all claim, demand, and cause of action for the violation of patent-rights claimed by them to that date. It is imperfectly expressed as to the subject-matters in controversy, which were then to be compromised, as they appear in the suit. That such was the intention, appears from the language of the release, it being for any violation of the patent-rights claimed by them. The defendants never charged Burden with any violation of any patent of theirs in their pleadings. They make but two claims: the first, that they had as good a right to make brad-headed spikes as Burden had, notwithstanding his suit against them for infringing his patent; and as patentee that they had a right to manufacture the patent horseshoe, against the exclusive claim of Burden, under his patent, to make them. Now, though the release, as it is expressed, may imply that there had been between the parties other claims than such as we find in the suit and in the agreement, we think the words in the release, "claimed by them as aforesaid," fix its meaning to what is expressed. And if this was not so, we should say, without these words, "claimed by them as aforesaid," that the general words would be restrained by the particular occasion of using them; and that its meaning is, that Burden releases to the defendants, for the considerations of the agreement, all claim and causes of action up to that date, for any violation of his patent-rights for the horseshoe and bending lever, for which they asserted a claim as well as himself. *Ld. Raymond*, 399; 3 *Mod.*, 277; 1 *Lev.*, 235; 3 *Id.*, 273; 2 *Shower*, 47.

Besides, the releases being operative only up to that date, it is very difficult to admit that it was meant to provide prospectively for the defendants to use a particular machine, for any previous violation for which they were then to be released. It is a bar to any right of action for the past for the causes stated, and not a limitation upon the releases for anything of a like kind which may be done thereafter.

But it was also urged that the rights of the defendants, under the agreement to use Burden's bending lever, might be inferred from their relinquishment to the appellant of their right to make the horseshoe. The proofs in the case disclose that Burden had obtained in November, 1835, a patent for a new and useful improvement in the machine for making horseshoes, and that he also patented another improvement upon that in 1843. In May, 1844, Mr. Horner and Mr. Winslow bought from Elisha Tolles and Nathaniel B.

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Gaylord, for \$1,000, a patent for making or bending horseshoes, claimed by Tolles as his invention, of which Gaylord became the owner of an undivided half, by assignment from Tolles, before the latter obtained his patent, in 1834. In the agreement for the purchase, it is recited that the patent having been lost, a new patent was issued to Tolles in May, 1844. The view taken by Winslow and Horner of their purchase of that patent is shown by covenants in the agreement. It is, that in case it shall at any time appear, by the decision of any court having competent jurisdiction, that the patents conveyed to Winslow and Horner were not valid and effectual to secure to them the exclusive privileges thereby granted, whether for the reason that Tolles was not the original inventor of the machine, or otherwise, then, that the purchase-money was to be returned to Horner and Winslow, with interest from the time it was received, both Tolles and Gaylord being only responsible for the portions of the money that they might receive, Gaylord guaranteeing to the purchasers one hundred dollars of the three hundred and seventy-five dollars which, it appears, he did receive from Mr. Winslow, Gaylord having on the same day received from him six hundred and seventy-five dollars. Such was the claim of the defendants for a patent for bending horseshoes, and no more. The defendants had the right to buy such a patent, with an undertaking to pay the expenses of a lawsuit, if they pleased to do so. And they had a right to use the patent which they bought, if it had really been obtained, and was not an infringement of another patent. But having shown their own apprehension of its invalidity, and provided that they were to lose nothing by it, in case it should prove to be the right which they asserted under it in the agreement of 14th of October, 1845, can only be viewed by us as a relinquishment of a very doubtful claim to make the patent horseshoe, to the exclusive claim made by Burden, to make them under his patent, which formed an inducement with the latter to enter into the release contained in that agreement. As to the circumstance out of the agreement, upon which the defendants state formed in fact the consideration, it is only necessary to say, it sufficiently appears that the undivided half of the dock which they bought from the appellants was fully worth the sum paid for it when the purchase was made, and therefore the price given cannot be a consideration for anything else.

We have so far construed the agreement from what is expressed in it, in connection with the claims made by the parties in the suit which Burden agreed to discontinue. There are other reasons which would bring us to the same conclusion.

Though no form has been prescribed, either for assignments of patents or for licenses to use them, we have judicial decisions concerning both, which are to determine what language will make either, and how they are to be distinguished from each other. The clause of the agreement from which the defendants wish it to be inferred that they have a right to use Burden's bending lever, gives nothing definitely. The claim made by them in their answer is uncertain. It is difficult to distinguish whether they mean to claim by assignment or by a license; and when it was urged in the argument that they did so by license, it was equally uncertain whether they did so upon a claim which they might assign or use for others who might become owners in their factory, or which they could only personally use without being transmissible by them to others. The difference is well understood. A mere license to a party, without having his assigns, or equivalent words to them, showing that it was meant to be assignable, is only the grant of a personal power to the licensees, and is not transferable by him to another. Curtis on Patents, sec. 198; 2 Story, 525, 554. It is true, that in the argument the claim was for a license to use Burden's bending lever; but to what extent, or where or for what time, was not said; nor can it be collected from their answer. Such uncertainties we cannot affirm of an agreement which definitely states what they may do. Further, we cannot adopt the construction of the agreement contended for by the defendants, because they gave no such consideration for such an interest in Burden's patent. We do not say an inadequate one, but no consideration; we can find none in the agreement, nor any in what is said in their answer to have been a consideration. It has already been shown that the dock bought by them from the appellants could not have been any part of a consideration, because the proofs in the cause show that their use of it is a convenience in their business, and that the interest which they acquired in that property, was fully worth the price given by them for it. In addition to what has already been said concerning the relinquishment of the horseshoe manufacture, or that Burden might manufacture them, and that they would not, we cannot see how that, as a part of the agreement, can be made by any implication to mean more than this: that it was a surrender to the exclusive claim of Burden to make them of a very equivocal right upon their part to do so, for the discontinuance of the pending suit for the allowance to them to make brad-headed spike, which it was the purpose of the suit to prevent, and for the releases mutually given against any future claim for past violations of the patent-rights claimed by them in their pleadings. We think, from the agreement, that



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Opinion of the court.

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such was the intention of the parties to it, notwithstanding the declaration of the defendants that it was otherwise. We do so, because there is no proof of it in the case, and because it is not permitted to a party to control a written agreement by parol testimony of declarations or conversation, at the time it was completed or before, which would contradict, add to, or alter the written agreement, either in the case of a latent or patent ambiguity, though in either, collateral facts, and the circumstances in which the parties were placed when the agreement was made, may be given in evidence. In the first case, to ascertain something extrinsic, or matter out of the instrument, where there is no ambiguity from the language of it; and in the other, when from defective terms the intention of the parties may not be collected from them. In this agreement, we can see no such ambiguity of expression to make it doubtful, or anything extrinsic connected with it to make it uncertain.

The proofs in this case disclose that Burden's bending lever is a valuable invention; so much so, that the appellants gave to him for the assignment of it, with its improvements, and for the assignment of the horseshoe patent, thirty per cent. upon the net gains of the manufacture of both, with a like interest in the value of all the machinery of both which might be on hand when the contract shall be at an end, and with the same interest in all the real estate, the additions and improvements of it, which shall be bought and made out of the earnings of the assigned machinery; with this further stipulation, upon the part of the appellant, that his interest, as they have been stated, should commence six months before the date of his assignments. With such advantages, it cannot be supposed that it was understood by the parties to the agreement of 14th of October, 1845, that Burden meant to put a rival establishment in possession of an interest in his patent equal to that of the appellants, for making brad-headed spike, and that for nothing.

Before concluding, we will remark that there is no proof in the cause to maintain the averment in the answer of the defendants, that they used the bending lever of Burden with his knowledge and that of the appellants, from the date of the agreement until the suit was brought, without any objection or complaint from either of them.

In every point of view which we can take of this case, we think that the defendants have infringed the patent for making hook or brad-headed spike with Burden's bending lever. We shall direct the decree of the court below to be reversed, and shall order a perpetual injunction to enjoin the defendants from using the machine with Burden's bending lever in the manufacture of brad-headed spike,

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Syllabus.

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and shall remand the case to the court below, with directions for an account to be taken, as is prayed for by the appellants.

Mr. Chief Justice TANEY and Mr. Justice NELSON dissented.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of said Circuit Court in this cause be, and the same is hereby, reversed with costs, and that this cause be, and the same is hereby, remanded to the said Circuit Court, with instructions to enjoin the defendants perpetually from using the improved machinery with the bending lever for making hook and brad headed spikes, patented to Henry Burden the 2d of September, 1840, and assigned to the complainant as set forth in complainant's bill, and to enter a decree in favor of the complainants, for the use and profits thereof, upon an account to be stated by a master, under the direction of the said Circuit Court, as is prayed for by the complainants, and for such further proceedings to be had therein, in conformity to the opinion of this court, as to law and justice may appertain.

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HORACE C. SILSBY, WASHBURN RACE, ABLE DOWNS, HENRY HERRION,  
AND CHARLES D. THOMPSON v. ELISHA FOOTE.

(14 Howard, 218.)

1. Upon a trial in New York, a juror became ill, and was discharged before any evidence was given, and before the plaintiff's counsel had concluded his opening address. The court ordered another juror to be sworn, and proceeded with the trial. The defendant cannot object to this. It is the practice in New York, and the Circuit Court had a right to follow it.
2. The court having erroneously refused to allow the plaintiff to offer a paper in evidence as a disclaimer of part of a patent, afterwards refused to allow the defendants to offer the same paper in evidence for the purpose of prejudicing the plaintiff's rights. This last refusal was correct. The reason given was erroneous; but this is not a sufficient cause for reversing the judgment.
3. The courts of the United States have not the power to order a nonsuit against the wishes of the plaintiff.
4. Under a notice given by the defendant, that the invention claimed by the plaintiff was described in Ure's Dictionary of Arts, Manufactures, and Mines, and had been used by Andrew Ure, of London, it was not competent to give in evidence a very large book. The place in the book should have been specified.

## Opinion of the court.

5. Nor, under the notice, was the book competent evidence that Andrew Ure, of London, had a prior knowledge of the thing patented. The notice does not state the place where the same was used.
6. One of the specifications of the patent being for a combination of certain parts of mechanism necessary to produce the desired result, it was proper for the court to instruct the jury that the defendants had not infringed the patent, unless they had used all the parts embraced in the plaintiff's combination; and the jury were to find what those parts were, and whether the defendants had used them.
7. When a claim does not point out and designate the particular elements which compose a combination, but only declares, as it properly may, that the combination is made up of so much of the described machinery as effects a particular result, it is a question of fact which of the described parts are essential to produce that result, and to this extent, not the construction of the claim, strictly speaking, but the application of the claim, should be left to the jury.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Northern District of New York.

The facts are stated in the opinion of the court.

It was argued by *Mr. Seward*, for the plaintiffs in error, and by *Mr. Foote*, in proper person, for the defendant in error.

Mr. Justice CURTIS delivered the opinion of the court.

This is an action on the case for the violation of a patent-right granted to the defendant in error on the 26th day of May, 1842, for "a new and useful improvement in regulating the draft of stoves." On the trial in the Circuit Court for the Northern District of New York, the defendants took exceptions to the rulings of the district judge who presided at the trial, and have brought the case here by a writ of error.

The first exception shows the following facts: After the counsel for the plaintiff had begun his opening address to the jury, a juror became ill, applied to the court to be discharged, and was discharged from the panel on account of physical inability to sit on the residue of the trial. Thereupon the court ordered another juror to be drawn and sworn, and the panel being thus full, the trial proceeded, and the plaintiff's counsel concluded his address. The plaintiff assented to this proceeding; the defendant objected, and excepted to the order of the court.

We think it was not erroneous for the presiding judge to treat the physical inability of the juror as simply creating a vacancy on the panel, and proceeding to fill it in the usual way, by having a twelfth juror drawn and sworn. We understand it to have been the practice of the courts of the State of New York so to treat such a withdrawal

## Opinion of the court.

of a juror, when the presiding judge in his discretion has thought proper to do so, and under the act of July 20, 1840, (5 Stat. at Large, 394,) the Circuit Court might properly conform to that practice. Of course it must be confined to cases like the present, in which it is apparent the party objecting received no injury. The defendant cannot be supposed to have been prejudiced by the failure of the twelfth juror to hear a part of the opening argument for the plaintiff, no evidence having been given, and he did not make known to the court that he desired to attempt to exercise any right of challenge of the other eleven jurors, to which he might have been restored if any cause existed, and the panel had been treated as broken up. *Rex v. Edwards*, 4 Taunt., 309; *Green v. Norville*, 3 Hill, (S. C.) 262. In such a case, we think it rested in the discretion of the court whether the withdrawal of a juror should be treated simply as occasioning a vacancy on a still existing panel, or as breaking up the panel altogether; and it being a matter of discretion, no error could be assigned upon it, even if there were reason to believe, what in this case there is not, that the discretion was not wisely exercised.

The next exception was to the refusal of the judge to allow the defendant to put in evidence to the jury an indorsement on the original letters patent. The plaintiff had previously offered in evidence a duly certified copy of the following disclaimer:

“To the Commissioner of Patents: The petition of Elisha Foote, of Seneca Falls, in the county of Seneca, and State of New York, respectfully represents:

“That your petitioner obtained letters patent of the United States for an improvement in regulating the draft of stoves, which letters patent are dated on the 26th day of May, 1842. That he has reason to believe, that, through inadvertence and mistake, the claim made in the specification of said letters patent—in the following words, to wit: ‘What I claim as my invention; and desire to secure by letters patent, is the application of the expansive and contracting power of a metallic rod, by different degrees of heat, to open and close a damper which governs the admission of air into a stove, or other structure in which it may be used, by which a more perfect control over the heat is obtained than can be by a damper in the flue’—is too broad, including that of which your petitioner was not the first inventor.

“Your petitioner, therefore, hereby enters his disclaimer to so much of said claim as extends the application of the expansive and contracting power of a metallic rod, by different degrees of heat, to any other use or purpose than that of regulating the heat of a stove, in which such rod shall be acted upon directly by the heat of the stove

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Opinion of the court.

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or the fire which it contains; such disclaimer is to operate to the extent of the interest in said letters patent vested in your petitioner, who has paid ten dollars into the treasury of the United States, agreeably to the act of Congress in that case made and provided.

“ELISHA FOOTE.

“Witnesses: MORRIS NEWTON, EDWIN L. BALTINE.”

The defendants objected, upon the ground that the instrument did not state “the extent of his interest in such patent.” 5 Stat. at Large, 193, sec. 7. The court sustained the objection, and refused to permit the instrument to be read by the plaintiff as a disclaimer. At a subsequent stage of the trial, the defendant offered to read to the jury a copy of this instrument, indorsed on the original letters patent, not as a disclaimer under the act of Congress above referred to, but as a confession by the plaintiff that he was not the original and first inventor of a part of the thing patented. The plaintiff objected, because the indorsement on the letters patent was not in his handwriting, nor signed by him, and the defendants had already caused a duly certified copy of the same instrument to be rejected. The court sustained the objection.

We are of opinion the court erred in not allowing the plaintiff to put this instrument in evidence as a disclaimer, under the seventh section of the act of March 3, 1837. 5 Stat. at Large, 193. This section authorizes not only the patentee, but his executors, administrators, and assigns, whether of the whole or of a sectional interest in the patent, to make disclaimer, “stating therein the extent of his interest in such patent.” This instrument states that the plaintiff was himself the patentee, and having thus shown a grant to himself of the whole interest, it is silent respecting a transfer of any part of it. The fair implication is that he still owns the whole; and this implication is sufficient, without an express declaration that he had parted with no interest. It has been argued that the words, “such disclaimer is to operate to the extent of the interest vested in your petitioner,” imply that he had not the whole title. But the interest previously described as vested in him was the entire title as patentee, and this reference to that interest, accompanied by a declaration that the disclaimer was intended to operate upon it to its whole extent, strengthens rather than weakens the implication that he owned the whole patent. This being so, it follows, that when the defendants offered to put a copy of the instrument in evidence, not as a disclaimer, but as a confession of the defendant to prejudice his rights, it was properly rejected. It is true, the rejection of the evidence was placed on a different ground by the judge below. But if the defend-

## Opinion of the court.

ants were not deprived of any right by the rejection of the evidence, it is not cause for reversing the judgment that an erroneous reason was given for rejecting it; and they were not deprived of any right if the paper was not legal evidence upon the particular point for which alone it was offered, or if its reception, accompanied by proper instructions to the jury concerning its legal effect, must necessarily have assisted the opposite party.

The next exception is to the refusal of the judge to order a nonsuit. But as it has repeatedly decided that the courts of the United States have no power to order a peremptory nonsuit against the will of the plaintiff, it is not necessary to examine the grounds of the motion. *Doe v. Grymes*, 1 Pet., 469; *D'Wolf v. Rabaud*, 1 Pet., 476; *Crane v. Morris*, 6 Pet., 598.

In the course of the trial, the defendants offered to put in evidence two articles contained in Ure's Dictionary of Arts, Manufactures, and Mines, to prove that the patent declared on was not valid. The plaintiff objected, and the evidence was excluded. It is incumbent on the defendants to show their right to introduce this evidence. To do so, they rely on the fifteenth section of the act of July 4, 1836. 5 Stat. at Large, 123. This section enables the defendant, in any action on the case founded on letters patent, to give in evidence, under the general issue, any special matter of which notice in writing may have been given to the plaintiff or his attorney, thirty days before the trial, tending to prove, among other things, that the patentee was not the original and first inventor of the thing patented, or of some substantial and material part thereof, claimed as new, or that it had been described in some public work anterior to the supposed discovery thereof by the patentee; and whenever the defendant relies, in his defense, on the fact of a previous invention, knowledge, or use of the thing patented, he is required to state, in his notice of special matter, the names and places of residence of those whom he intends to prove possessed a prior knowledge of the thing, and where the same had been used. The notice given in this case was as follows:

"The patentee was not the original and first inventor or discoverer of a substantial and material part thereof, claimed as new; that it had been described in a public work, called Ure's Dictionary of Arts, Manufactures, and Mines, anterior to the supposed invention thereof by the patentee; and, also, had been in public use and known before that time, and used by Andrew Ure, of London, the late M. Bonnemair, of Paris, and George H. McClary, of Seneca Falls, New York."

## Opinion of the court.

Ure's Dictionary contains upwards of thirteen hundred pages, and the articles which the defendants offered to read were entitled "Thermotad" and "Heat Regulator." The first question, is whether this was a sufficient notice of the special matter, tending to prove that the thing patented, or some substantial part thereof, claimed as new, had been described in a printed publication. We are of opinion it was not. The act does not attempt to prescribe the particulars which such a notice shall contain. It simply requires notice. But the least effect which can be allowed to this requirement, is that the notice should be so full and particular as reasonably to answer the end in view. This end was not merely to put the patentee on inquiry, but to relieve him from the necessity of making useless inquiries and researches, and enable him to fix with precision upon what is relied on by the defendants, and to prepare himself to meet it at the trial. This highly salutary object should be kept in view, and a corresponding disclosure exacted from the defendant of all those particulars which he must be presumed to know, and which he may safely be required to state, without exposing him to any risk of losing his rights. Less than this would not be reasonable notice, and, therefore, would not be such a notice as the act must be presumed to have intended.

Now, we do not perceive that the defendants would be exposed to the risk of losing any right, by requiring them to indicate, in their notice, what particular things, described in the printed publication, they intended to aver were substantially the same as the thing patented. This they might have done, either by reference to pages or titles, and perhaps in other ways; for the particular manner in which the things referred to are to be identified must depend much upon the contents of the volume, and their arrangement. It has been urged that a defendant may not have access to the book in season for the notice. But it must be remembered that some considerable time before it is necessary to give such a notice the defendant has begun to use the thing patented, which, *prima facie*, he has no right to use, and it would seem to be no injustice or hardship to expect him, before he begins to infringe, to ascertain that the patentee's title is not valid, and if its invalidity depends on what is in a public work, that he should inform himself what that work contains, and consequently how to refer to it. We do not think it necessary so to construe this act, designed for the benefit of patentees, as to enable the defendant to do what we fear is too often done—to infringe first, and look for defenses afterwards.

Nor does a notice, that somewhere, in a volume of thirteen hundred

pages, there is something which tends to prove that the thing patented, or some substantial and material part thereof, claimed as new, had been described therein, relieve the patentee from the necessity of making fruitless researches, or enable him to fix with reasonable certainty on what he must encounter at the trial. Upon this ground, therefore, the exception cannot be supported.

But it is further urged that the book ought to have been admitted as evidence; that Andrew Ure, of London, had a prior knowledge of the thing patented. This view cannot be sustained; for although the name of Andrew Ure, of London, is contained in the notice of persons who are alleged to have had this prior knowledge, yet the defendants have not brought themselves within the act of Congress, because the notice does not state "where the same was used" by Andrew Ure. Besides, inasmuch as the same section of the statute provides that a prior invention in a foreign country shall not avoid a patent, otherwise valid, unless the foreign invention had been described in a printed publication, the defendants are thrown back upon that clause of the act which provides for that defense, arising from a printed publication, which has already been considered.

The next exception was to the charge of the presiding judge to the jury. The defendants requested the judge to charge the jury—

3. That it was erroneous to consider as constituent parts of the combination claimed by the plaintiff only those points which were requisite to the operation of opening and closing the damper, but that, on the contrary, the jury must consider as constituent parts of the combination all the parts of the machine, as described in the specification, by which the regulation of the heat of a stove, or the other structures, is effected.

4. That the index is a constituent part of the combination patented by the plaintiff.

5. That the detaching process of the lever is a constituent part of the combination patented by the plaintiff.

6. That the pendulum is a constituent part of the combination.

And, in this connection,—

7. That if the defendants do not use all the constituent parts of the combination patented by the plaintiff, a verdict must be rendered for the defendants.

As to the 2d, 3d, 4th, 5th, 6th, and 7th of the instructions prayed for by the defendants, the judge charged the jury, that it was true, as insisted by the defendants' counsel, that the third article of the summary of the plaintiff's specification, on which alone, if at all, he was entitled to recover, was for a combination; and unless it appeared



## Opinion of the court.

by the evidence that the defendants had used all the parts of the plaintiff's stove embraced in such combination, he was not entitled to recover. That the combination claimed in the article in question was of such parts of the mechanism described in the specification as are necessary to regulate the heat of the stove; and unless it appeared by the evidence that some parts of the mechanism not shown to have been used by the defendants were necessary to perform that office, or that, according to the just construction of the specification, such parts were intended to be claimed by the plaintiff as a part of such combination, they are not to be considered as embraced within it. That inasmuch as, by the fourth article of the plaintiff's summary, he made a distinct and separate claim to what had been called the detaching apparatus, there seemed to be good reason to infer that it was not his intention to claim this in the third article as a part of the combination therein mentioned. But the judge observed, that the question relative to the extent of the combination had been treated by the defendants' counsel as a question of fact, and he had no disposition to withdraw it from the consideration of the jury; and he therefore submitted it to the jury to decide, from the evidence, whether the parts of the mechanism described in the specification, which were not shown to have been used by the defendants, were necessary to regulate the heat of the stove, and instructed the jury that if they should so find, the defendants would be entitled to a verdict. And the judge refused to charge otherwise, in relation to such instructions, or any of them.

To this charge and refusal of the judge, as the 2d, 3d, 4th, 5th, 6th, and 7th of the instructions prayed by the defendants, the defendants' counsel then and there excepted.

The substance of the charge is, that the jury were instructed by the judge that the third claim in the specification was for a combination of such parts of the described mechanism as were necessary to regulate the heat of the stove; that the defendants had not infringed the patent, unless they had used all the parts embraced in the plaintiff's combination; and he left it to the jury to find what those parts were, and whether the defendants had used them.

We think this instruction was correct. The objection made to it is, that the court left to the jury what was matter of law. But an examination of this third claim, and one of the defendants' prayers for instruction, will show that the judge left nothing but matter of fact to the jury. The construction of the claim was undoubtedly for the court. The court rightly construed it to be a claim for a combination of such of the described parts as were combined and arranged

for the purpose of producing a particular effect, namely, to regulate the heat of a stove. This was in accordance with the defendants' third prayer. But the defendants also desired the judge to instruct the jury that the index, the detaching process, and the pendulum were constituent parts of this combination. How could the judge know this as matter of law? The claim is in these words: "I also claim the combination, above described, by which the regulation of the heat of the stove, or other structure in which it may be used, is effected." The writing which the judge was to construe calls for all such elements of the combination as are actually employed to effect the regulation of the heat, according to the plan of the patentee, described in the specification, and it therefore became a question for the jury, upon the evidence of experts, or an inspection by them of the machines, or upon both, what parts described did in point of fact enter into and constitute an essential part of this combination. When a claim does not point out and designate the particular elements which compose a combination, but only declares, as it properly may, that the combination is made up of so much of the described machinery as effects a particular result, it is a question of fact which of the described parts are essential to produce that result; and to this extent, not the construction of the claim, strictly speaking, but the application of the claim, should be left to the jury. The defendants themselves so treat this matter in their third prayer, and we are satisfied the judge did not err in so treating it.

The defendants' counsel exhibited to the court the models of the machines of the defendants and the plaintiff, for the purpose of satisfying the court the jury must have understood they were at liberty to construe the claim, and that they did in truth so construe it, as to exclude from the combination claimed by the plaintiff what is called the detaching process. But we can draw no such inference from an examination of those models. And while we do not think it proper to express any opinion on what is really a matter of fact, yet we think it pertinent to say that an examination of the models has satisfied us that a jury might fairly come to the conclusion that the defendants did use a detaching process, not substantially different from the plaintiff's, and occupying in their combination the same place, and answering substantially the same purpose, as the plaintiff's detaching process does in his combination; and therefore we can draw no inference such as is contended for.

We have examined all the exceptions, and no one being found tenable, the judgment is affirmed.

**AFFIRMED.**

Mr. Justice McLEAN dissented.

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Opinion of the court.

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ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs, and interest until the same is paid, at the same rate per annum that similar judgments bear in the courts of the State of New York.

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JAMES STEPHENS, APPELLANT, v. ISAAC H. CADY.

(14 Howard, 528.)

1. Where the copyright of a map was taken out under the act of Congress, and the copperplate engraving seized and sold under an execution, the purchaser did not acquire the right to strike off and sell copies of the map.
2. The court below decided that an injunction to prevent such striking off and selling, could not issue without a return of the purchase-money. This decision was erroneous.
3. A copyright is a "property in notion, and has no corporeal tangible substance," and is not the subject of seizure and sale by execution. It can be reached by a creditor's bill in chancery, but in such case the court would probably have to decree a transfer in the mode pointed out in the act of Congress.

THIS was an appeal from the Circuit Court of the United States for the District of Rhode Island, sitting as a court of equity.

The facts are stated in the opinion of the court.

It was submitted on printed argument by the appellant, in proper person. No counsel appeared for the appellee.

Mr. Justice NELSON delivered the opinion of the court.

This is an appeal from the Circuit Court of the United States for the District of Rhode Island.

The bill was filed by the appellant in the court below, to restrain the defendant from printing and publishing a map of the State of Rhode Island and Providence Plantations, in violation of the complainant's copyright.

The facts are briefly these: The complainant, on the 23d of April, 1831, took out the copyright of a map, the title of which is as follows: "A Topographical Map of the State of Rhode Island and Providence Plantations, surveyed trigonometrically and in detail, by James Stephens, topographer and civil engineer, Newport, R. I., 1831, the right whereof he claims as author, in conformity with the act of

## Opinion of the court.

Congress, entitled an act to amend the several acts respecting copyrights;” and since then has been engaged in printing, publishing, and vending the said map, by virtue of the copyright thus obtained. In March, 1846, a judgment was recovered against him, in the Common Pleas of Bristol county, Massachusetts, for \$194.23, upon which an execution was issued, and the copper-plate engraving of the map in question seized and sold, and bid off by the defendant for the sum of \$245, he being the highest bidder. Having thus become entitled to the property in the engraving, he claimed the right to print and publish the maps, and, in pursuance of this supposed right, he has been engaged in printing, publishing, and vending the same.

On the hearing upon the bill, answer, and proofs, the court below differed in opinion, as to the effect of the sale of the copper-plate engraving of the map; but agreed that no injunction could issue without a repayment of the purchase-money, which was refused by the complainant; whereupon the court dismissed the bill with costs.

The single question in the case, is whether or not the property acquired by the defendant in the copper-plate, at the sheriff’s sale, carried with it, as an incident, the right to print and publish the map engraved upon its face.

Upon this question the court below divided in opinion, but finally agreed in dismissing the bill.

The appellee has not followed the case into this court, and we have not, therefore, been favored with the grounds and reasons relied on for sustaining the decree; nor have we been furnished with the reasons of the court for the same. The ground upon which the decision was ultimately placed, namely, the refusal of the complainant to refund the purchase-money, is certainly not satisfactory; for if the copyright of the map, or any right to print or publish the same, passed with the purchase of the plate, as incidental, as there is nothing in the facts of the case to invalidate the sale, the title became complete in the purchaser, and could not be rightfully interfered with; but if otherwise, then there was no ground for imposing the repayment of the purchase-money, as a condition to the relief prayed for; the injunction should have been awarded, and the defendant directed to account.

But, from the consideration we have given to the case, we are satisfied that the property acquired by the sale in the engraved plate, and the copyright of the map secured to the author under the act of Congress, are altogether different and independent of each other, and have no necessary connection. The copyright is an exclusive right to the multiplication of the copies, for the benefit of the author or his

## Opinion of the court.

assigns, disconnected from the plate or any other physical existence. It is an incorporeal right to print and publish the map, or, as said by Lord Mansfield in *Miller v. Taylor*, 4 Burr., 2396, "a property in notion, and has no corporeal, tangible substance."

The engraved plate and the press are the mechanical instruments, or means by which the copies are multiplied, as the types and press are the instruments by which the copies of a book are produced. And to say that the right to print and publish the copies adheres to and passes with the means by which they are produced, would be saying, in effect, that the exclusive right to make any given work of art necessarily belonged to the person who happened to become the owner of the tools with which it was made; and that if the defendant in this case had purchased the stereotyped plates of a book, instead of the engraved plate, he would have been entitled to the copyright of the work, or at least to the right to print, publish, and vend it; and yet we suppose that the statement of any such pretension is so extravagant as to require no argument to refute it. Even the transfer of the manuscript of a book will not, at common law, carry with it a right to print and publish the work, without the express consent of the author, as the property in the manuscript, and the right to multiply the copies, are two separate and distinct interests. 4 Burr., 2330, 2396; 2 Eden, 329; 2 Atkyns, 342; 2 Story, 100.

Lord Mansfield observed, in *Miller v. Taylor*, that "no disposition, no transfer of paper upon which the composition is written, marked, or impressed, (though it gives the power to print and publish,) can be construed a conveyance of the copy [by which he means copyright, as appears from a previous part of his opinion,] without the author's express consent 'to print and publish,' much less against his will."

Now, it seems to us that the transfer of the manuscript of a book by the author would, of itself, furnish a much stronger argument for the inference of a conveyance of the right to multiply copies, than exists in the case of a transfer of the plate in question, or of the stereotype plates, as the ideas and sentiments, or, in other words, the composition and substance of the work, are thereby transferred. But the property in the copyright is regarded as a different and distinct right, wholly detached from the manuscript, or any other physical existence, and will not pass with the manuscript unless included, by express words, in the transfer.

The copper-plate engraving, like any other tangible personal property, is the subject of seizure and sale on execution, and the title passes to the purchaser, the same as if made at a private sale. But

## Order.

the incorporeal right, secured by the statute to the author, to multiply copies of the map, by the use of the plate, being intangible, and resting altogether in grant, is not the subject of seizure or sale by means of this process,—certainly not at common law. No doubt the property may be reached by a creditor's bill, and be applied to the payment of the debts of the author, the same as stock of the debtor is reached and applied, the court compelling a transfer and sale of the stock for the benefit of the creditors. 20 J. R., 554; 5 J. Ch., 280; S. C., 4 Id., 687; 1 Paige, 637. But, in case of such remedy, we suppose it would be necessary for the court to compel a transfer to the purchaser, in conformity with the requirements of the copyright act, in order to invest him with a complete title to the property. The first section of that act provides that the author of any map, chart, &c., his executors, administrators, or legal assigns, shall have the sole right of printing, publishing, and vending the same, during the period for which the copyright has been secured; and the seventh section forbids any person from printing, publishing, or selling the map or chart, under heavy penalties, without the consent of the proprietor of the copyright, first obtained in writing, signed in the presence of two credible witnesses. Act of Congress, February 3, 1831.

An assignment, therefore, that would vest the assignee with the property of the copyright, according to the act of Congress, must be in writing, and signed in the presence of two witnesses, and it may, I think, well be doubted whether a transfer even by a sale, under a decree of a court of chancery, would pass the title so as to protect the purchaser, unless by a conveyance in conformity with this requirement. 6 B. & Cr., 169; 1 Car. & P., 558; R. & M., 187; D. & K., 215.

It is unnecessary, however, to express an opinion upon the point. It is sufficient, for the purposes of this case, to say that the right in question is wholly independent of, and disconnected from, the engraved plate; and that there is no foundation for the defense set up, that it passed as appurtenant to the sale and transfer of the property in the engraved plate, from which the copies of the map were struck off.

For these reasons, we are of opinion that the decree below must be reversed with costs, and the proceedings remitted, with directions that a decree be entered for the complainant, in conformity with this opinion.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District

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Statement of the case.

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of Rhode Island, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of said Circuit Court in this cause be, and the same is hereby, reversed with costs, and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to enter a decree therein, in conformity to the opinion of this court.

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REVERSED WITH COSTS.

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ELISHA BLOOMER, APPELLANT, v. JOHN W. McQUEWAN, ALLEN R. McQUEWAN, AND SAMUEL DOUGLAS, PARTNERS UNDER THE NAME OF McQUEWAN & DOUGLASS.

(14 Howard, 539.)

1. The patent for Woodworth's planing-machine was extended from 1842 to 1843, by the Board of Commissioners.
2. Under that extension, this court decided, in *Wilson v. Rousseau*, 4 How., 688, that an assignee had a right to continue the use of the machine which he then had.
3. In 1845, Congress, by a special act, extended the time still further, from 1849 to 1856.
4. Under that extension, an assignee has still the same right.
5. By the cases of *Evans v. Eaton*, 3 Wheaton, 548, and *Wilson v. Rousseau*, 4 How., 688, these two propositions are settled, viz.: 1. That a special act of Congress in favor of a patentee, extending the time beyond that originally limited, must be considered as ingrafted on the general law. 2. That under the general law in force when this special act of Congress was passed, a party who had purchased the right to use a planing-machine during the period to which the patent was first limited, was entitled to continue to use it during the extension authorized by that law, unless there is something in the law itself to forbid it.
6. But there is nothing in the act of Congress passed in 1845 forbidding such use; and, therefore, the assignee has the right.

Mr. Justice CURTIS, having been of counsel, did not sit on the trial of this cause; and Mr. Justice WAYNE was absent.

THIS was an appeal from the Circuit Court of the United States for the Western District of Pennsylvania, sitting as a court of equity.

It was a bill filed by Bloomer, who claimed under Wilson, the assignee of Woodworth's planing-machine. The whole of Wilson's title is set forth in the report of the case of *Wilson v. Rousseau*, 4 Howard, 646, as is also the act of Congress passed on the 26th of February, 1845, (4 How., 662,) extending the patent for seven years from the 27th of December, 1849.

McQuewan claimed through two *mesne* assignments from Woodworth and Strong, by virtue of a license granted on the 8th of November, 1833.

The bill and answer covered a great deal of ground, which need not be noticed in this report.

Amongst other averments, was this: that the license conveyed no right to use the machine during the extension for seven years from 1849, under the act of Congress passed in 1845; and the decision of the court being in favor of the defendants below upon this point, it is unnecessary to state all the points and arguments upon other matters.

The court below were divided in opinion, and the bill was of course dismissed. Bloomer appealed to this court.

It was argued by *Mr. Keller* and *Mr. St. George T. Campbell*, for the appellant, and *Mr. Dunlop*, for the appellees.

The fourth point made by the counsel for the appellant was as follows:

IV. Whether the licensee of a right to use the patented machine for the original term of the patent is entitled to continue the use of the same during the extension by Congress.

The facts in this regard, appearing by the record, are—

1. That Collins and Smith, who were assignees for the first term of the district in question, granted to Barnet the right for the city of Pittsburg and Alleghany county, “to construct and use, during the residue of the said terms of fourteen years,” the patented machine; and by the same assignment covenanted “not themselves to construct and use,” nor to give license to any other person than Barnet “during the terms aforesaid”; and Barnet covenanted not to construct more than fifty machines “during the terms aforesaid.”

(The word “terms” is used in the plural, as it will be perceived by the assignment that the grantors were the owners also of the Emmons patent, and that the limitation of his right applied to the duration of both.)

2. Barnet assigns all his “right, title, interest, and claim of the within patent for Woodworth’s planing-machine to G. Warner and John W. McQuewan, their heirs and assigns,” except seven rights previously given.

3. It seems to have been granted, below, that Warner had assigned his license to McQuewan, and McQuewan to the two co-defendants, and that the machine was made during the first term of the



## Argument for the appellant.

patent; hence arises the question, have the appellees the right to continue its use during the congressional extension?

For the appellant, it is submitted—

1. That this question, and the principles upon which it must be decided, have been already passed upon by this court.

In *Wilson v. Rousseau*, 14 Howard, the question was of the right of the licensee to continue the use of the machine during the extension by the Commissioner. The court were divided in opinion. In that delivered as their judgment, the right of the licensee to the continued use was put exclusively upon the terms of the eighteenth section, which were, “the benefit of such renewal shall extend to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein.” Without that provision, it is conceded, by the learned judge, in delivering the opinion of the court, “that all the rights of assignees or grantees, whether in a share of the patent or to a specified portion of the territory held under it, terminate at the end of the fourteen years, and become reinvested in the patentee by the new grant.”

“From that date he is again possessed of ‘the full and exclusive right and liberty of making, using, and vending to others the invention,’ whatever it may be, not only portions of the monopoly held by assignees and grantees as subjects of trade and commerce, but the patented articles or machines throughout the country, purchased for practical use in the business affairs of life, are embraced within the operation of the extension. This latter class of assignees and grantees are reached by the new grant of the exclusive right to use the things patented. Purchasers of the machines, and who were in the use of them at the time, are disabled from further use immediately, as that right became vested exclusively in the patentee. Making and vending the invention are prohibited by the corresponding terms of his grant.”

And the learned judge, in expressing the opinion of the court, further declared that the provision in the eighteenth section, above referred to, was “intended to restore or save to them,” (those in use of the thing patented at the time of the renewal,) “that right which, without the clause, would have been vested again exclusively in the patentee.”

And the learned judges who dissented from the opinion of the court did so upon the ground that even this clause of the eighteenth section did not confer upon the licensees the right claimed in their behalf.

Thus, it is clear that the extension of a patent by lawful authority

## Argument for the appellant.

revests in the patentee every right originally possessed by him, and that unless the law, by virtue of which it is extended, contains a provision in favor of licensees or assignees, their right to use ends with the term of their license. (This, of course, does not apply to cases where the patentee has covenanted to grant any subsequently-acquired extensions. None such is pretended in this case.)

Applying, then, these principles to the act extending this patent, (February 26, 1845,) it will be seen that it contains no such provision as is to be found in the eighteenth section of the act of 1836; and that, therefore, in accordance with the opinion of all the judges, the entire right was reinvested in the patentee.

The general power to renew and extend a patent is conferred by the eighteenth section of the act of 1836, which, after providing for the proof of the prerequisites, declares that "it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension for the term of seven years from and after the expiration of the first term."

The act in question provides that the patent "be, and the same is hereby, extended for the term of seven years from and after the 27th of December, 1849, and the Commissioner of Patents is hereby directed to make a certificate of such extension, in the name of the administrator of William Woodworth, and append an authenticated copy thereof to the original letters patent," &c.; the words being substantially the same as these, judicially construed, and the intention being still further marked, as well by the omission of any provision for the licensees as by the express insertion of the name of the party in whose favor the extension was made, and to whose benefit it was intended to inure.

The principles upon which the judgment in *Wilson v. Rousseau* is founded, are, it is submitted, if possible, more conclusively applicable to the case of such an extension by Congress than to one made by the Commissioner.

Such, too, has been the application made of them by many of the learned judges in their circuits. By Mr. Justice Nelson, July 22, 1850, in *Gibson v. Gifford*, in a written opinion delivered by him; by the late Mr. Justice Woodbury, July, 1850, in *Mason v. Tallman*, also in a written opinion; and by Mr. Justice McLean, October 22, 1850, in *Bloomer v. Stately*.

The opinion of Mr. Justice Woodbury refers to similar decisions made by the late Justice McKinley, by Judge Ware, and by Judge Sprague.

It may be proper, with reference to the argument founded upon

## Argument for the appellant.

the supposed intention of Congress, (not declared in the words of the act, as already shown,) to permit a continued use during the congressional extension of machines licensed under the original term, to annex a list of the patents extended by special acts, and thus to refer to the provisions in each, expressly declaring, where such was intended, the existence of such right, and providing for its mode of exercise or enjoyment.

The absence of such provision in the act of 1845, must, it is submitted, conclusively negative any idea of such intention, even if the judicially decided effect of such an act did not render a reference to such a source for interpretation unnecessary.

I. January 21, 1808, to Oliver Evans, 6 Stat. at Large, 70,—with special provision for parties then using invention. Under this act, the cases of *Evans v. Jordan*, 9 Cranch, 199, and *Evans v. Eaton*, 3 Wheat., 454, were decided.

II. March 3, 1809, to Amos and William Whittemore, 6 Stat. at Large, 80,—without provision for licensees.

III. February 7, 1815, Oliver Evans, (steam-engine,) 6 Stat. at Large, 147,—with proviso that no greater sum should be charged for constructing and using than was during prior term, and subject to existing Patent Laws.

IV. March 3, 1821, Samuel Parker, 6 Stat. at Large, 262,—subject to provision of then existing Patent Laws.

V. March 2, 1831, John Adamson, 6 Stat. at Large, 458,—without proviso or reference to existing laws.

VI. March 3, 1831, Samuel Browning, 6 Stat. at Large, 467,—without proviso or reference to existing laws.

VII. May 19, 1832, Jethro Wood, 6 Stat. at Large, 486,—proviso in favor of licensees that the price shall not be advanced.

VIII. June 30, 1834, Thomas Blanchard, 6 Stat. at Large, 589,—with special proviso in favor of licensees. (It may not be improper to refer to the opinion of B. F. Butler, Attorney-General, May 25, 1837, that under this act the United States had no right to use, except on the conditions of the original grant.)

IX. March 3, 1835, Robert Eastman, 6 Stat. at Large, 613,—without proviso or reference to existing laws.

X. July 2, 1836, James Barron, 6 Stat. at Large, 678,—extending two patents, without proviso in reference to existing laws, and the other with provisos in reference to licensees.

XI. February 6, 1839, Thomas Blanchard, 6 Stat. at Large, 748,—with proviso in favor of licensees.

XII. March 3, 1845, William Gale, 6 Stat. at Large, 895,—au-

thorizing renewal of patent under eighteenth section of act of 1836, although it had expired, and subject to the restrictions of that act.

XIII. March 3, 1843, Samuel K. Jennings, 6 Stat. at Large, 899,—directing Commissioner to renew patent, subject to provisions of existing laws.

XIV. February 26, 1845, William Woodworth, 6 Stat. at Large, 936,—extending patent. Commissioner to certify to the extension in the name of the administrator. No proviso in favor of licensees, or reference to existing laws.

XV. February 15, 1847, Thomas Blanchard, 9 Stat. at Large, 683,—with proviso in favor of licensees, on terms to be agreed or adjusted by the Circuit Court, &c.

The point that, by an accidental error in the bill, the word “fourteen” was inserted, instead of “twenty-eight,” is not deemed a proper subject of objection in this court. No such ground appears to have been taken below; the patent itself forms part of the record, and an amendment would have been, it is submitted, instantly allowed by the court below, had the objection been there made. That the patent on its face was for twenty-eight years, forms one of the objections of the appellees to its validity, and the error complained of is set right by answer of the defendants themselves.

It is not deemed necessary by the appellants to present any authorities to meet the point argued by the appellees, that an act of Congress extending a patent for seven years is unconstitutional and void.

It is therefore submitted that the decree should be reversed, and that the appellant is entitled to a perpetual injunction, and an account.

The counsel for the appellees made several points, amongst which was the following:

1. That defendants are protected as assignees.

The bill (pages 14 to 20) asserts, and the answer admits, that the respondents claim to use the machine they are alleged to have infringed, as assignees, from 1833, the year of their purchase, under assignments from the original patentee. Being, then, assignees under the original patent, can they claim to continue unmolested in the use of the machine they purchased and paid for, and have erected and used for seventeen years?

Was it the design of the act of 1845 to bring disasters upon the respondents, to deprive them of the rights they had acquired in good faith, to depreciate their property, to render useless their establishments, in which they had invested large sums of money, to destroy

## Argument for the appellees.

their business, and disable them from the performance of their contracts? Such flagrant outrages are not to be imputed to a statute, unless the terms of it imperatively demand it.

The language of the act calls for no such harsh, unreasonable, and impolitic construction. It is a simple extension of the patent of 1828, and nothing more. Could any design in Congress to spread such disasters be predicated of the simple meaning of this statute?

Chief Justice Gibson, of Pennsylvania, has laid down a rule which must commend itself to the judgment of every one: that in the construction of statutes, the judges, when one of those cases of hardship occurs which continually arise, should do what their consciences irresistibly persuade them the legislature would have done if the occurrence had been foreseen. *Pennock v. Hart*, 8 S. & R., 369.

And can any one doubt that if the idea of the propriety of protecting the purchasers of rights, and the uses of the thing patented, had been suggested, but they would immediately have inserted such a clause?

This act of 1845 is a private act, made for the special benefit of a particular individual, and should not have such construction as will be detrimental to others. Chief Justice Parsons, in the case of *Coolidge v. Williams*, has laid down the rule to be that private statutes, made for the accommodation of particular citizens or corporations, ought not to be construed to affect the rights or privileges of others, unless such construction results from express words, or from necessary implication. 4 Mass., 145.

There are no express words in this statute, which demand the construction contended for by the plaintiff.

We may appeal, too, to the language of Mr. Justice Washington, in the case of *Evans v. Jordan*, that arguments founded upon hardship would be entitled to great weight, if the language of the act was not so peremptory as to forbid a construction at variance with the clear meaning of the legislature. 9 Cranch, 199.

There are no words in this act to justify such savage construction as urged by the plaintiff. It declares a simple extension of the patent, and manifestly intends an extension similar to that which may be conferred by the Patent Office, under which the rights of persons using the invented machine under license are protected in the enjoyment of it.

The same learned chief justice of Massachusetts has also declared, in the case of *Wales v. Stetson*, that in the consideration of the provisions of any statute, they ought to receive such a reasonable construction, if the words and subject-matter will admit of it, as that the

existing rights of the public or individuals be not injured. 2 Mass., 146.

If the legislature meant a simple extension of the patent for seven years, is it not a reasonable construction to suppose that it meant an extension as ordinarily understood,—as an extension of the nature of the extensions of the Patent Office, and with the restrictions and privileges of such extensions? Is it not reasonable to conclude that they had in their mind the general act of 1836, and the clause which gave to purchasers and users of the thing patented the right to continue that use? Is it not a reasonable construction that they meant that this special act should be construed in reference to the general law of the land? The language of the act is that the patent of 1828 “be extended for seven years.” Now, what benefit would that extension be, even to complainant, without an incorporation with the general law? How could he be assignee of the right?—how could he enjoy the use of the patent?—how could he pretend to recover damages, without an appeal for aid to the act of 1836? The plaintiff is obliged to invoke the aid of the general law to maintain this very action. The very plaintiff in this cause is an assignee, and undertakes to maintain this action in his own name, by calling into requisition the act of 1836.

The rule of law undoubtedly is, that laws on the same subject are to be construed together; that laws on the same subject are to be construed *pari passu*, and with reference to parallel legislation. This is clearly the rule as to general laws, which in relation to the same subject are to be construed as one act. They are to be construed, too, in reference to parallel legislation. *Penn v. Hamilton*, 2 Watts, 60; 17 S. & R., 81; 7 Id., 404.

The right of appeal given by the Pennsylvania act relating to divorces *a vinculo matrimonii*, was extended, by implication, to the act of 1817, respecting divorces *a mensa et thoro*. *Roberts v. Roberts*, 9 S. & R., 191.

So the right to appeal from justices’ judgments, in cases of contracts, was held to extend to trespass, to which the powers of magistrates had been extended, without expressly giving the right of appeal. 4 S. & R., 73.

And this wise and safe rule of construction has been held to apply to statutes which have been repealed, or may not have been noticed by the statutes to be construed. *Rev v. Loxdale*, 1 Burr., 447.

And Lord Mansfield, in that case, said “that where there are different statutes *in pari materia*, though made at different times, or even expired, and not referring to each other, they shall be taken

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and construed together as one system." In the expressive language of Tilghman, Ch. J. of Pennsylvania, in one of the cases cited, they were so blended together as to form one statute.

And from the cases cited from Burrow, this blending of statutes, this analogy of legislation, is not confined to public statutes, but that public laws may receive aid in their construction from private laws, and *vice versa*; for his lordship says, in the case cited, (page 448,) that the act of Parliament of 1740, relating to St. Martins and the overseers of that parish, (which was, I apprehend, clearly a private act,) which extended the number of overseers of the poor, to be appointed by two justices, under the general act of 43 Elizabeth, to the number of nine, "shows" (says the chief justice) "the construction put by the legislature themselves upon the 43 Elizabeth, on this head, and excepts this very large parish of St. Martins out of it."

I need not burden your honors with any name of books on this, so obvious a rule of construction. This case in Burrow was carefully considered; it had been argued several times before Chief Justice Ryder, and afterwards before Lord Mansfield, by great counsel, and if any case is entitled to respect of courts, it is a case so considered and so decided.

But we have cases nearer home, and more germane to this very matter of private acts, in relation to these very patent-rights.

In the case of *Evans v. Eaton*, 3 Wheat., 454, it was declared that an act of Congress authorizing the Secretary of State to issue a patent to Oliver Evans, for his improvements in the manufacture of flour, "was ingrafted on the general act for the promotion of useful arts, and that the patent was issued under both acts," the public and the private one.

So in the case of *Evans v. Jordan*, 9 Cranch, 199, which was an action to recover damages under the same private act, Washington, J., said, in declaring the opinion of the court, that "it should be recollected that the right of the plaintiff to recover damages for using his improvement, after the issuing of his patent, arises, not under this law, but the general law of 1793."

If the plaintiff is obliged to invoke the aid of the act of 1836, he must take the whole of it. It is a well-established rule of law, that he who claims the benefit of his title must admit its disadvantages. *Qui sentit commodum sentire debet et onus.*

Mr. Chief Justice TANEY delivered the opinion of the court.

The bill in this case was filed by the appellants on the 6th of July, 1850, in the Circuit Court of the United States for the Western Dis-

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trict of Pennsylvania, to obtain an injunction restraining the appellees from the use of two of Woodworth's planing-machines in the city of Pittsburg. The term for which Woodworth's patent was originally granted expired in 1842, but it was extended seven years by the board established by the eighteenth section of the act of 1836. And afterwards, by the act of Congress of February 26, 1845, this patent was extended for seven years more, commencing on the 27th of December, 1849, at which time the previous extension would have terminated.

It appears, from the pleadings and evidence in the case, that, shortly after the passage of the act of Congress of 1845, William Woodworth, the administrator of the patentee, in whose name the certificate of extension was directed to be issued, assigned all his right to James G. Wilson, from whom the appellant purchased the exclusive right to construct and use this machine, and to vend to others the right to construct and use it, in a large district of country described in the grant. Pittsburg, in which the machines in question are used, is included within these limits. And the right which the appellant purchased was regularly transferred to him by Wilson, by an instrument of writing duly recorded in the Patent Office.

In the year 1833, during the term for which the patent was originally granted, the defendants purchased the right to construct and use a certain number of these machines within the limits of the city of Pittsburg and Alleghany county; and the right to do was so regularly transferred to them by different assignments, deriving their title from the original patentee. The two machines mentioned in the bill were constructed and used by the respondents soon after the purchase was made, and the appellees continued to use them up to the time when this bill was filed. And the question is whether their right to use them terminated with the first extension, or still continues under the extension granted by the act of 1845.

The Circuit Court decided that the right of the appellees still continued, and upon that ground dismissed the appellant's bill. And the case is now before us upon an appeal from that decree.

In determining this question, we must take into consideration not only the special act under which the appellant now claims a monopoly, but also the general laws of Congress in relation to patents for useful improvements, and the special acts which have from time to time been passed in favor of the particular patentees. They are statutes *in pari materia*; and all relate to the same subject, and must be construed together. It was so held in the case of *Evans v. Eaton*, 3 Wheat., 518, where the court said that the special act of Congress in



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favor of Oliver Evans, granting him a new patent for fourteen years, for his improvements in manufacturing flour and meal, was ingrafted on the general act for the promotion of useful arts, and the patent issued in pursuance of both. The rule applies with more force in the present case; for this is not the grant of a new patent, but an enlargement of the time for which a patent previously extended under the act of 1836 should continue in force.

Indeed, this rule of construction is necessary to give effect to the special act under which the appellant claims the monopoly; for this law does not define the rights or privileges which the patent shall confer, nor prescribe the remedy to which he shall be entitled if his rights are infringed. It merely extends the duration of the patent, and nothing more. And we are necessarily referred, therefore, to the general law upon the subject, to ascertain the rights to which the patent entitled him, and also the remedy which the law affords him if these rights are invaded.

Now, the act of 1836, in express terms, gives the benefit of the extension authorized by that law to the assignees and grantees of the right to use the thing patented to the extent of their respective interests therein. And under this provision it was decided, in the case of *Wilson v. Rousseau*, 4 Howard, 688, that the party who had purchased and was using this planing-machine during the original term for which the patent was granted, had a right to continue the use during the extension; and the distinction is there taken between the grant of the right to make and vend the machine, and the grant of the right to use it.

The distinction is a plain one. The franchise which the patent grants consists altogether in the right to exclude every one from making, using, or vending the thing patented, without the permission of the patentee. This is all that he obtains by the patent. And when he sells the exclusive privilege of making or vending it for use in a particular place, the purchaser buys a portion of the franchise which the patent confers. He obtains a share in the monopoly, and that monopoly is derived from and exercised under the protection of the United States; and the interest he acquires necessarily terminates at the time limited for its continuance by the law which created it. The patentee cannot sell it for a longer time; and the purchaser buys with reference to that period, the time for which exclusive privilege is to endure being one of the chief elements of its value. He therefore has no just claim to share in a further monopoly subsequently acquired by the patentee. He does not purchase or pay for it.

But the purchaser of the implement or machine, for the purpose of using it in the ordinary pursuits of life, stands on different ground. In using it, he exercises no rights created by the act of Congress, nor does he derive title to it by virtue of the franchise or exclusive privilege granted to the patentee. The inventor might lawfully sell it to him, whether he had a patent or not, if no other patentee stood in his way. And when the machine passes to the hands of the purchaser, it is no longer within the limits of the monopoly. It passes outside of it, and is no longer under the protection of the act of Congress. And if his right to the implement or machine is infringed, he must seek redress in the courts of the State, according to the laws of the State, and not in the courts of the United States, nor under the law of Congress granting the patent. The implement or machine becomes his private, individual property, not protected by the laws of the United States, but by the laws of the State in which it is situated. Contracts in relation to it are regulated by the laws of the State, and are subject to State jurisdiction. It was so decided in this court, in the case of *Wilson v. Sanford* and others, 10 Howard, 99. Like other individual property, it is then subject to State taxation; and from the great number of patented articles now in use, they no doubt, in some of the States, form no inconsiderable portion of its taxable property.

Moreover, the value of the implement or machine in the hands of the purchaser for use, does not in any degree depend on the time for which the exclusive privilege is granted to the patentee; nor upon the exclusion of others from its use. For example, in the various patented articles used in agriculture, in milling, in manufactures of different kinds, in steam-engines, or for household or other purposes, the value to the purchaser is not enhanced by the continuance of the monopoly. It is of no importance to him whether it endures for a year or twenty-eight years. He does not look to the duration of the exclusive privilege, but to the usefulness of the thing he buys, and the advantages he will derive from its use. He buys the article for the purpose of using it as long as it is fit for use and found to be profitable. And in the case before us the respondents derive no advantage from the extension of the patent, because the patentee may place around them as many planing-machines as he pleases, so as to reduce the profits of those which they own to their just value in an open and fair competition.

It is doubtless upon these principles that the act of 1836 draws the distinction between the assignee of a share in the monopoly, and the purchase of one or more machines, to be used in the ordinary pur-

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suits of business; and that distinction is clearly pointed out and maintained in the case of *Wilson v. Rousseau*, before referred to.

Upon the authority, therefore, of the cases of *Evans v. Eaton* and *Wilson v. Rousseau*, these two propositions may be regarded as settled by judicial decision: 1. That a special act of Congress in favor of a patentee, extending the time beyond that originally limited, must be considered as ingrafted on the general law; and 2. That under the general law in force when this special act of Congress was passed, a party who had purchased the right to use a planing-machine during the period to which the patent was first limited, was entitled to continue to use it during the extension authorized by that law.

Applying these rules to the case before us, the respondents must be entitled to continue the use of their planing-machines during the time for which the patent is extended by the special act of Congress, unless there is something in the language of the law requiring a different construction.

But there is nothing in the law to justify the distinction claimed in this respect on behalf of the patentee. Its language is plain and unambiguous. It does not even grant a new patent, as in the case of *Oliver Evans*. It merely extends the time of the monopoly to which the patentee was entitled under the general law of 1836. It gives no new rights or privileges, to be superadded to those he then enjoyed, except as to the time they should endure. The patent, such as it then was, is continued for seven years longer than the period before limited. And this is the whole and only provision contained in this special act. In order, therefore, to determine the rights of the patentee during the extended term, we are necessarily referred to the general law, and compelled to inquire what they were before this special act operated upon them, and continued them. Indeed, the court has been obliged to recur to the act of 1836, in every stage of this suit, to guide it in deciding upon the rights of the parties, and the mode of proceeding in which they are to be tried. It is necessarily referred to in order to determine whether the patent under which the complainant claims was issued by lawful authority, and in the form prescribed by law; it was necessary to refer to it in the Circuit Court in order to determine whether the patentee was entitled to the patent as the original inventor, that fact being disputed in the Circuit Court; also, for the notices to which he was entitled in the trial of that question; and for the forum in which he was authorized to sue for an infringement of his rights; and the rights of the appellant to bring the case before the court for adjudication is derived altogether from the provisions of the general law,—for there is no evidence

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in the record to show that the machines are worth two thousand dollars, and no appeal therefore would lie from the decision of the Circuit Court, but for the special provision in relation to patent cases in the act of 1836. And while it is admitted that this special act is so ingrafted on the general law as to entitle the patentee to all the rights and privileges which that law has provided for the benefit and protection of inventors, it can hardly be maintained that the one in favor of the purchaser of a machine is by construction to be excepted from it, when there are no words in the special act to indicate that such was the intention of Congress.

This construction is confirmed by the various special acts which have been passed from time to time in favor of particular inventors, granting them new patents after the first had expired, or extending the time for which they were originally granted. Many of these acts have been referred to in the argument, some of which contain express provisions, protecting the rights of the purchaser under the first term, and others contain no provision on the subject, and merely grant a new patent, or, as in the case before the court, extend the duration of the old one. And in several instances special laws in favor of different inventors have been passed within a short time of each other, in one of which the rights of the previous purchaser are expressly reserved, and in the other there is no provision on the subject. And the act of March 3, 1845, authorizing the patent of William Gale, for an improvement in the manufacture of silver spoons and forks, to be extended, was passed only a few days after the act in favor of Woodworth; and Gale's patent is subjected, in express terms, to the conditions and restrictions in the act of 1836, and consequently protects previous purchasers from a new demand.

It has been contended, on behalf of the appellant, that the insertion of these restrictions in one special law, and the omission of them in another, shows that in the latter Congress did not intend to exempt the purchaser from the necessity of obtaining a new license from the patentee; and that Congress might well suppose that one inventor had stronger claims upon the public than another, and might on that account give him larger privileges on the renewal.

But this argument only looks to one side of the question, that is, to the interest and claims of the inventor. There is another and numerous class of persons who have purchased patented articles, and paid for them the full price which the patentee demanded, and we are bound to suppose that their interests and their rights would not be overlooked or disregarded by Congress; and still less that any distinction would be drawn between those who purchased one de-

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scription of patented machines and those who purchased another. For example, the act granting a new patent to Blanchard in 1834, for cutting or turning irregular forms, saves the rights of those who had bought under the original patent. And we ought not to presume, without plain words to require it, that, while Congress acknowledged the justice of such claims in the case of Blanchard, they intended to disregard them in the case of Woodworth. Nor can it be said that the policy of Congress has changed in this respect after 1834, when Blanchard's patent was renewed; for, as we have already said, the same protection is given to purchasers in the special law authorizing the renewal of Gale's patent, which was passed a few days after the law of which we are speaking.

The fair inference from all of these special laws is this: that Congress has constantly recognized the rights of those who purchase for use a patented implement or machine; that in these various special laws the patentee and purchasers of different inventions were intended to be placed on the same ground; and that the relative rights of both parties under the extension by special act of Congress were intended to be the same as they were when the extension was granted under the general law of 1836. It would seem that in some cases the attention of the legislature was more particularly called to the subject, and the rights of the purchaser recognized and cautiously guarded. And when the provision is omitted, the just presumption is that Congress legislated on the principle decided by this court in *Evans v. Eaton*, and regarded the special law as ingrafted on the general one, and subject to all of its restrictions and provisions, except only as to the time the patent should endure. Time is the only thing upon which they legislate; and any other construction would make the legislation of Congress, on these various special laws, inconsistent with itself, and impute to it the intention of dealing out a different measure of justice to purchasers of different kinds of implements and machines,—protecting some of them, and disregarding the equal and just claims of others.

And if such could be the interpretation of this law, the power of Congress to pass it would be open to serious objections; for it can hardly be maintained that Congress could lawfully deprive a citizen of the use of his property after he had purchased the absolute and unlimited right from the inventor, and when that property was no longer held under the protection and control of the general government, but under the protection of the State, and on that account subject to State taxation.

The fifth amendment to the Constitution of the United States

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declares that no person shall be deprived of life, liberty, or property, without due process of law.

The right to construct and use these planing-machines had been purchased and paid for, without any limitation as to the time for which they were to be used. They were the property of the respondents. Their only value consists in their use. And a special act of Congress, passed afterwards, depriving the appellees of the right to use them, certainly could not be regarded as due process of law.

Congress undoubtedly have power to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries.

But it does not follow that Congress may, from time to time, as often as they think proper, authorize an inventor to recall rights which he had granted to others, or reinvest in him rights of property which he had before conveyed for a valuable and fair consideration.

But we forbear to pursue this inquiry, because we are of opinion that this special act of Congress does not, and was not intended to, interfere with rights of property before acquired; but that it leaves them as they stood during the extension under the general law. And in this view of the subject the appellant was not entitled to the injunction he sought to obtain, and the Circuit Court were right in dismissing the bill.

As the decision on this point disposes of the case, it is unnecessary to examine the other grounds of defense taken by the appellees.

The decree of the Circuit Court must be affirmed.

Mr. Justice McLEAN and Mr. Justice NELSON dissented.

Mr. Justice McLEAN.

Woodworth's patent bears date the 27th of December, 1828, and runs for fourteen years. On the 29th of July, 1830, the patentees conveyed to Isaac Collins and Barzillai C. Smith the right to construct, use, and vend to others the planing-machine invented within several States, including Pennsylvania, except the city of Philadelphia. On the 19th of May, 1832, Collins and Smith transferred to James Barnet the right to construct and use, during the residue of the aforesaid term of fourteen years, fifty planing-machines, within Pittsburg and Alleghany county, for which he agreed to pay four thousand dollars. Barnet agreed not to construct or run more than fifty machines during the term aforesaid, and Collins and Smith bound themselves not to license during the term, nor to construct

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or use themselves during the term, or allow others to do so, in the limits of Pittsburg and Alleghany county.

On the 27th of December, 1842, the patent expired, but it was renewed and extended for seven years, under the act of 1836. This extension expired in 1849; but Congress, on the 26th of February, 1845, passed an act which provided that "the said letters patent be, and the same is hereby, extended for the term of seven years from and after the 27th day of December, 1849."

The patentee, by deed dated the 14th of March, 1845, and also by a further deed dated the 9th of July, 1845, conveyed to James E. Wilson all his interest, as administrator, in the letters patent under the extension by the act of Congress. And Wilson, on the 4th of June, 1847, for the consideration of twenty-five thousand dollars, gave to Bloomer, the plaintiff, a license to construct and use, and vend to others to construct and use, during the two extensions, "all that part of Pennsylvania lying west of the Alleghany Mountains, excepting Alleghany county, for the first extension, which expires on the 27th day of December, 1849, and the States of Virginia, Maryland, Kentucky, and Missouri, excepting certain parts of each State."

The defendants continued to run their machines during the residue of the fourteen years for which the patent was granted, and during the first extension; and the complainant filed his bill to enjoin the defendants from running their machines under the second extension by the act of Congress.

The contract of the defendants was entered into the 19th of May, 1831, and under it Barnet had a right "to construct and use, during the residue of the aforesaid term of fourteen years, fifty planing-machines," &c. The patent expired on the 27th of December, 1842. The contract of defendants was made the 19th of May, 1832, leaving about nine years and six months for the patent to run, and this was the time limited by the contract, and for which the consideration of four thousand dollars was paid. This was not left to construction from the life of the patent, but the contract expressly declared the right was purchased "for the residue of the aforesaid term of fourteen years."

This term was enjoyed by the defendants, and under the decision of this court, in the case of *Wilson v. Rousseau*, 4 Howard, 646, the seven years' extension under the act of 1836 was also enjoyed by the defendants. This construction of the act of 1836, in my judgment, was not authorized, and was not within the intention of the law, as was expressed at the time. That extension having expired, another extension is claimed under the act of Congress. This claim

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is set up to an injunction bill, filed by the complainant, who is the assignee of the patent for a part of Pennsylvania and other States. And by the decision of four of my brethren, just delivered, the defendants are to enjoy this extension, making fourteen years beyond their control. This would seem to imply, that, under the act of 1836, and under the act of 1845, the assignees were the favored objects of Congress. But this is not the case. The patentee who made the invention, and through whose ingenuity, labor, and expense a great benefit has been conferred on the public, in justice is entitled to remuneration; and that only was the ground of extension, whether under the law of 1836, or the special act of 1845.

This, as well as the former decision, was influenced by the consideration that the owners of the machines are, in equity, entitled to run them so long as the exclusive right of the patent shall be continued. It is said that the machines are property, and that no act of Congress should deprive the owners of the use of their property. But in this view, the property of the patentee seems not to be taken into the account. He is the meritorious claimant for protection. The assignee for a specific time rests upon his contract. He has conferred no benefit on society. His investment was made with an exclusive reference to his own advantage. He has no more claims upon the public sympathy than he who rents a mill, a farm, or engages in a business open to all who expect a profit by it.

But the hardship is supposed to exist in the fact that to use the right a planing-machine must be constructed at an expense of some four or five hundred dollars, and this will be lost to the occupier, if by an extension he shall not be permitted to run his machine. The answer is, when he entered into the contract he knew, or is presumed to have known, that the patent might be extended under the law of 1836 or by special act, and if he desired an interest under the renewed patent he should have provided for it in his contract. Having failed to do this, it would seem to be unjust that, under a contract to run the machine less than ten years, he should be entitled to run it sixteen years. The consideration paid was limited to the term specified in the contract. But it is answered that the assignee expected to run his machine after the termination of the contract on which the exclusive right would end and become vested in the public.

Let us examine this plea, and it will be found that a great fallacy prevails on this subject. A right that is common is no more valuable to one person than another, as all may use it. The injury, then, consists, so far as the licensee is concerned, in the reduction of the



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value of his machine, by the extension of the exclusive right in the patentee, to the exclusion of the assignee. It is true, this deprives him of the monopoly which his contract secured to him. But he has enjoyed this to the extent of his contract, and for which he has paid the stipulated consideration. Now, his only equitable plea to run his machine during the renewed patent, arises alone from the supposed difference in the value of his machine under the renewal, without a license, and where the right becomes vested in the public.

If there had been no renewal, the licensee might run his machine, and any other person might run one. It is a fact known to every observing individual, when a new business is set up, as a planing-machine, supposed to be very profitable generally, a competition is excited which reduces the profit below a reasonable compensation for the labor and expense of the business. If the monopoly continued as enjoyed under the contract, the consideration paid for the monopoly would be added to the profits, which would make them large. But when the monopoly ceases, the profits, if not destroyed, are reduced by competition, at least as low, if not below the ordinary profit of capital employed in other investments.

If the business of the county or city required the number of planing-machines in operation, the licensee could sell his machine at a reasonable reduction for the time it had run. The machines of the defendant had run, probably, from twelve to fifteen years. A considerable reduction would be expected by the purchaser, as a machine could not be expected to last more than twenty years. But suppose it can be used thirty, then one-half of the value must be deducted for the wear of the machine fifteen years, which would reduce it to some two hundred and fifty or three hundred dollars.

But suppose the exclusive right should be continued in the patentee by an extension of it seven years. Then, if the machines were not more numerous than the public required, they would be wanted by their owners, or by others disposed to engage in the business. And I hazard nothing in saying, that, after deducting the compensation from the profits paid for the exclusive right, they would be larger than could be hoped for where the right was common. Under such circumstances, I can entertain no doubt that a machine would sell for more money, under the extension of the patent, than where the right goes to the public.

The idea that to refuse the use of a machine under the extension of a patent is an unjust interference with property, I think, is unfounded. There is no interference with the property in the machine. The owner may sell it to any one who has a license to use it. It is

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not the property in the machine that is complained of, but because the right to run it longer than the contract provided for is not given. The licensee has used the franchise as long as he purchased and paid for it; and can he, in justice, claim more than his contract? The extension of the right to use, while the extended patent continues, does a wrong to the patentee, by taking his property, without compensation, and giving it to the licensee. The franchise is property, and it can no more be transferred to another, without compensation or contract, than any other property. It would seem that this description of property is not governed by contract. That a contract to use the franchise ten years does not mean what is expressed, but may mean a right for twenty years, or any other term to which the patent may be extended.

Every man who has sense enough to make a contract, takes into his estimate the contingency of a loss, to some extent, in going out of the business. He fixes his own time for the contract, and if he wishes to provide for the contingency arising from the renewal of a patent, he can embrace it in his contract for a stipulated compensation.

It may be true, that, unless the contrary appear, when the patentee sells a planing-machine, a right to use it may be applied. But the right to construct and the right to use are distinct. Some purchase of the patentee the right to construct the machine; others to use it. This planing-machine cannot be compared to a plow, or any any other article which may be considered the product of the patent. The machine is the instrument through which the plank is planed. The plank is the product, and may be sold in the market as other property. But the planing-machine cannot be used without a license. The law protects the franchise, by prohibiting the use of the machine without a license. When Barnet purchased the franchise for the fifty machines, he did not buy the machines for a term as long as the machines could run, but for nine years and six months. The contract, neither expressly nor impliedly, extended beyond that term.

In this view, I think that I am not mistaken; and if I am not, the licensee is not injured a dollar by the termination of his right to run his machine, as fixed in his contract. But on whom is the injury inflicted by extending the contract of the licensee with the patentee; and that without compensation? In the present case, the patentee has been injured, by the use of the fifty machines, at least four thousand dollars, the amount agreed to be paid for the right to run them less than ten years. And must not the property of the patentee be taken into the account, as well as the imagined rights of the licensee?

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The patentee is justly considered a public benefactor. He has conferred a great benefit upon the world, and he is entitled, under our laws, to at least a compensation for his expense, ingenuity, and labor.

That the patentee is the only one whose interests are regarded, as the ground of extending the patent, in the act of 1836, is clear. Now, suppose the patentee has assigned the whole of the patent, without receiving such a compensation as the law authorizes, there can be no doubt he is entitled, on that ground, to a renewal of the patent; and yet, under the decision now given, his assignees would receive all the benefits of the renewal. Should not this fact cause doubts whether the rule of construction of the statute can be a sound one which defeats its avowed object? If this be the consequence of the assignment of the entire interest by the patentee, any partial assignment must produce the same result, though to a more limited extent. A principle which will not bear this test is not sound.

The act of 1845, extending this patent, annexed no conditions. The exclusive right was extended to the administrator of Woodworth for seven years from the 27th of December, 1849. But the decision now given, in effect, declares this exclusive right is not given. Indeed, the object of Congress must be defeated, if the machines in operation at the time of the passage of the act are to be continued without compensation. It is presumed there are few places where planing-machines were not constructed before 1849, the time the renewal took effect, if the public required them. On this supposition, the extension of the patent can be of little or no benefit to the heirs of the patentee. Congress could have granted the act only upon the ground to remunerate the heirs of the inventor.

There seems to be a great mistake as to the profits of this patent. It was a valuable patent, but, as in all other cases, its value excited the rapacity of men who seek to enrich themselves by taking the property of others. The records of the courts show that piracies were committed on this patent in every part of the country; and that to sustain it, much expenditure and labor have been required. It is stated that the sum of near two hundred thousand dollars has been thus expended to establish this patent. Congress have extended many patents. In some instances, conditions have been imposed; in others, the franchise has been extended unconditionally. Now, where the patent is extended by act of Congress without conditions, I am unable to perceive how the court can impose conditions. Such an act would be legislation, and not construction.

By the act of the 15th of February, 1847, the patent of Thomas Blanchard, for cutting irregular forms out of wood, brass, or iron, was

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extended for fourteen years from the 20th of January, 1848: "Provided that such extension shall inure to the use and benefit of the said Thomas Blanchard, his executors and administrators, and to no other persons whomsoever, except that a *bona-fide* assignee of the invention, by virtue of an assignment from the patentee heretofore made, shall have the benefit of this act upon just, reasonable, and equitable terms, according to his interest therein. And if the said Thomas Blanchard, his executors or administrators, cannot agree with such assignee, the terms shall be ascertained and determined by the Circuit Court of the United States for the district in which such assignee resides, to be decreed upon a bill to be filed by such assignee for that purpose. And provided further, that no assignee shall have the benefit of this act unless he shall, within ninety days from its passage, agree with the said Thomas Blanchard as to the consideration upon which he is to have it, or file his bill," &c.

Every one must perceive the justice and propriety of this act. Under the decision now given, the assignee of Blanchard would have had the benefit of the extension without paying for it. This act, extending Blanchard's patent, was passed two years after the decision of this court in *Wilson v. Rousseau*, which, under the act of 1836, gave the benefit of the extension to the assignee. This must have been known to Congress, and yet they deemed a special provision in behalf of the assignee necessary. This act, and several others of a similar character, cannot fail to convince every one that Congress did not suppose that the courts have power to annex a condition to a legislative grant.

In the case of *Evans v. Jordan and Morehead*, 9 Cranch, 199, this court held, that the act of January, 1808, for the relief of Oliver Evans, does not authorize those who erected their machinery between the expiration of their old patents and the issuing of the new one to use it after the issuing of the latter.

The above act extended the patent fourteen years, "provided that no person who may have heretofore paid the said Oliver Evans for license to use the said improvements shall be obliged to renew said license, or be subject to damages for not renewing the same; and provided also, that no person who shall have used the said improvements, or have erected the same for use, before the issuing of the said patent, shall be liable to damages therefor."

This was a much stronger case for equitable considerations than the one before us. Evans' patent had expired. His improvements were free to the public, and they were adopted by the defendants before he made application to Congress for a renewal of his patent. I will

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cite the reasoning of the Supreme Court on that case. "The language," they say, "of this last proviso is so precise, and so entirely free from all ambiguity, that it is difficult for any course of reasoning to shed light upon its meaning. It protects against any claim for damages which Evans might make, those who have used his improvements, or who may have erected them for use, prior to the issuing of his patent under this law. The protection is limited to acts done prior to another act thereafter to be performed, to wit, the issuing of the patent. To extend it, by construction, to acts which might be done subsequent to the issuing of the patent; would be to make, not to interpret, the law." "The injustice of denying to the defendants the use of machinery which they had erected after the expiration of Evans' first patent, and prior to the passage of this law, has been strongly urged as a reason why the words of this proviso should be so construed as to have a prospective operation. But it should be recollected that the right of the plaintiff to recover damages for using his improvement after the issuing of his patent under this law, although it had been erected prior thereto, arises, not under this law, but under the general law of the 21st of February, 1793. The provisos in this law profess to protect, against the operation of the general law, three classes of persons: those who had paid Evans for a license prior to the passage of the law; those who may have used his improvements; and those who may have erected them for use before the issuing of the patent."

And the court say: "The legislature might have proceeded still further, by providing a shield for persons standing in the situation of these defendants. It is believed that the reasonableness of such a provision could have been questioned by no one. But the legislature have not thought proper to extend the protection of these provisos beyond the issuing of the patent under that law, and this court would transgress the limits of the judicial power by an attempt to supply, by construction, this supposed omission of the legislature. The argument, founded upon the hardship of this and similar cases, would be entitled to great weight, if the words of this proviso were obscure and open to construction. But considerations of this nature can never sanction a construction at variance with the manifest meaning of the legislature, expressed in plain and unambiguous language."

The above views do not conflict with the opinion of the court in *Evans v. Eaton*, 3 Wheat., 454. In that case the court say: "Some doubts have been entertained respecting the jurisdiction of the courts of the United States, as both the plaintiff and defendants are citizens

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of the same State. The fifth section of the act to promote the progress of useful arts, which gives to every patentee a right to sue in a Circuit Court of the United States, in case his rights be violated, is repealed by the third section of the act of 1800, which gives the action in the Circuit Court of the United States where a patent is granted, 'pursuant' to that act, or to the act for the promotion of useful arts. This patent, it has been said, is granted, not in pursuance of either of those acts, but in pursuance of the act 'for the relief of Oliver Evans.' But this court is of opinion that the act for the relief of Oliver Evans is ingrafted on the general act for the promotion of useful arts, and that the patent is issued in pursuance of both. The jurisdiction of the court is therefore sustained."

There can be no question, that the special law extending the grant, as to its validity, is subject to the general Patent Law. The right was intended to be exclusive, if it be established that Evans was the original inventor of the improvements claimed, and such improvements were stated with the necessary precision; and, also, that it came under the class of cases on which suit could be brought in the courts of the United States, without regard to the citizenship of the parties. But it could not have been intended to apply to any contract subsequent to the patent, and it could only be held to embrace those general provisions of the Patent Law which relate to the validity of the patent. Under the act of Congress, a specification was necessarily filed, and it seems to be the practice to issue a patent under the act. This, it appears to me, is unnecessary, as the grant in the act is sufficient. But the schedule is necessary to show the nature and extent of the claim, and these must be sustained on those principles which apply to patents generally.

To give any other construction to the above remarks of the court, would be in direct contradiction to the language used, and the principle decided in the case above cited from Cranch. In fact, the remark that the relief of Evans was ingrafted on the general law, was made in reference to the jurisdiction of the court, and cannot be extended beyond that and other questions, in relation to the validity of the patent.

This argument of the court, in *Evans v. Jordan*, applies with all its force and authority to the case before us; and I need only say it was the language of Marshall, of Story, of Washington, and of the other judges of the court, except Judge Todd, who appears to have been absent. I can add nothing to the weight of the argument; but I will proceed to name the judges of this court who have given opinions opposed to the decision of this case by four of my brethren.

## Syllabus.

Mr. Justice Wayne being sick, did not sit in the case. In *Wilson v. Rousseau*, he held that, under the act of 1836, the licensee had no right to run his machine under the extended patent.

Mr. Justice Curtis having, as counsel, given an opinion opposed to the right of the defendants, did not sit in the case. Mr. Justice Thompson and Mr. Justice Story had both given opinions against the right of the assignee, unless under a special assignment. This was the opinion of Mr. Justice Woodbury, as expressed in the case of *Wilson v. Rousseau*. Mr. Justice McKinley gave an opinion against the right of the assignee under the act of 1845, extending Woodworth's patent. The same decision has been frequently given, by the justices of this bench, in the second and seventh circuits.

Sustained by the authority of seven justices of this court, and by an argument of the Supreme Court, above cited, which I think is unanswerable, I shall deem it to be my duty to bring the same question now decided, when it shall arise in my circuit, for the consideration and decision of a full bench.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Western District of Pennsylvania, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs.

AFFIRMED.

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URIAH A. BOYDEN, PLAINTIFF IN ERROR, v. EDMUND BURKE.

(14 Howard, 575.)

1. Where an action was brought against the Commissioner of Patents for refusing to give copies of papers in his office, and no special damage was set out in the declaration, evidence of the professional pursuits of the applicant was not admissible.
2. Where the application was made through a third person, letters of both parties to this third person were admissible in evidence, as part of the *res gestæ*.
3. Patents are public records, and it is the duty of the Commissioner to give authenticated copies to any person, on payment of the legal fees.
4. But the party entitled to such services must request their performance in a proper manner, and not accompany his demand with insult or abuse.
5. Hence the Commissioner could not be held responsible for refusing to comply with a demand couched in such language.
6. But when a second application was made, in a proper manner, the Commissioner ought to have complied with it.

## Statement of the case.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Columbia, holden in and for the county of Washington.

Boyden was a citizen of Massachusetts, and Burke was Commissioner of Patents at the time when the transactions took place which were the subject of the suit.

The ground of the action was, that Burke willfully, maliciously, and corruptly, and with intent to injure Boyden, had refused to give copies of certain patents.

The bills of exceptions referred to certain letters, which will be mentioned chronologically.

On the 14th of December, 1847, Boyden wrote a long letter to Burke, too long to be inserted. The following extract from it will be sufficient:

"If, in your letter of August 10, 1847, you mean by the 'office' yourself, or the author of the letters which I have received from you, you prescribe two conditions in said letter which are inconsistent, viz., that my letters to you or to the author of those letters subscribed by you, should be both respectful and proper. It is improper to treat a person respectfully while it is known that he is unworthy of respect; therefore it is impossible to comply with your prescriptions. The claim of unworthy officeholders to have people, as they say, respect the offices they hold, while it is known that the incumbents are unworthy of respect, is absurd. Do you mean, when you urge people to respect 'the office,' to have them respect you merely because you hold the office, while it is known that you are unworthy of respect? This is a free country!" &c.

On the same day Mr. Boyden wrote to Mr. Greenough, in Washington, as follows:

BOSTON, MASS., *December 14, 1847.*

SIR: Your letter of the 23d ult. was duly received. I wrote to Mr. Burke to-day, criticising his conduct, and informing him that I wish him to deliver to you a certified copy of each of the following patents, including drawings, specifications, and claims, or of all of them which are recorded in the Patent Office: George W. Henderson and John E. Cayford's patent, dated April 14, 1830; Charles Kenzie's patent, dated July 1, 1836; and J. K. Millard's patent, dated May 9, 1846.

You will oblige by tendering the fees for those copies if he declines furnishing them; and if you obtain them, I wish you to send them by mail to me at Boston. Respectfully,

(Signed,)

Test:

URIAH A. BOYDEN.

JOHN A. SMITH, *Clerk.*



## Statement of the case.

Mr. Greenough, accordingly, called upon Mr. Burke, who declined to cause the copies to be prepared for him, as the agent of Mr. Boyden, and addressed to Mr. Greenough an explanatory letter, from which the following is an extract:

“Of these reasons, for declining to cause the copies to be made for him, which you requested, you were duly apprised. And you were also informed, as Mr. Boyden himself has been informed, that until he comes to the conclusion to treat this office with the civility which the customs and rules of official intercourse require, this office will have no intercourse with him, directly or through the agency of others. When he concludes to conduct his intercourse with this office with decency and propriety, his business will be attended to.”

On the 20th of January, 1848, Mr. Burke made the following memorandum, which he handed to Mr. Laskey, who had called for the same papers:

PATENT OFFICE, *January 20, 1848.*

Mr. R. H. Laskey, as the agent of Uriah A. Boyden, calls for the following copies of patents, including drawings, specifications, and claims, or all of them which are recorded in the Patent Office, viz.: George W. Henderson and John E. Cayford's patent, dated April 14, 1830; Charles Kenzie's patent, dated July 1, 1846; and J. K. Millard's patent, dated May 9, 1846; for which he offers to pay the usual fees required by law for copies.

I hereby refuse to give him the copies called for, for Mr. Boyden, or to transact any other business for Mr. Boyden with Mr. Laskey. I do not refuse copies of any patents or other papers which Mr. Laskey requires for himself or for any other person except Mr. Boyden. I refuse to do any business for Mr. Boyden, whether he applies for the same personally or by agent, until he comes to the conclusion to observe, in his communications with this office, or its official head, the proprieties usually observed in official intercourse. When he comes to the conclusion to address this office, or its head, in respectful language, any business which he may have with it will be done as it is done for other persons, whether he applies in person or by agent.

EDMUND BURKE.

Mr. Boyden soon afterwards brought his action against Burke, as above stated.

On the trial of the cause, the plaintiff's counsel took four bills of exceptions; the first three of which related to evidence, and the fourth an exception to a general instruction that the plaintiff was not entitled to recover.

They were as follows:

*First Exception.*—On the trial of the issue in this cause, the plaintiff, to maintain the issue on his part joined, offered to give evidence tending to show that he is a citizen of the United States, residing in Boston, in the State of Massachusetts; that he is a civil engineer and machinist, and as such was, in the month of January, 1848, engaged in making improvements in “turbines” and “water-wheels”; that this fact was known to the defendant; that the defendant was at the same time Commissioner of Patents; that the plaintiff, in order to see what machinery having in view the same purpose had been theretofore patented, as well to guard himself against any suit by such previous patentees, for any alleged infringement of their said patents, as also to avoid any infringement thereof, and to save himself time, labor, and expense, required copies of certain patents then of record in the Patent Office, and which had been theretofore issued to the persons mentioned in the memorandum of January 20; that on the 20th day of January, 1848, the said plaintiff applied to the said defendant, as Commissioner of Patents as aforesaid, for copies of the said patents, and tendered himself ready, and “offered to pay the usual fees required by law for copies,” and the defendant thereupon, as Commissioner as aforesaid, answered the said application in writing as follows.

To all which evidence so as aforesaid offered by the plaintiff, and to every part thereof, except the said memorandum last above mentioned, the defendant, by his counsel, objects, as inadmissible upon the issue joined, and the court refused to permit the said evidence so objected to to be given; and thereupon the plaintiff, by his counsel, excepts thereto.

*Second Exception.*—The plaintiff then read in evidence, without objection, the memorandum made by the defendant, dated January 20, 1848, and then gave evidence tending to show that on or about the 22d day of December, 1847, J. J. Greenough, by authority of the plaintiff, called at the Patent Office to obtain for him copies of three several patents, which had theretofore been issued by said office for “turbines” or “water-wheels”; that he was referred by the clerk to whom he applied to the defendant, and informed defendant that he had been requested by the plaintiff to obtain for him copies of those patents, and defendant refused, saying he would not have anything to do with Mr. Boyden, directly or indirectly, or words to that effect; and, upon his cross-examination, witness stated that he asked Mr. Burke to give him in writing his reasons for so refusing, which he then and there promised to do; and, some days after, the witness re-

## Argument for the plaintiff in error.

ceived a letter from the defendant containing those reasons, which letter he had transmitted to the plaintiff; and then, upon cross-examination, the counsel for the defendant called upon the plaintiff to produce said letter, and the plaintiff, admitting he had said letter then in court, refuses to produce the same, on the ground that the said letter, if produced, would not be evidence; but the court overruling the objection of the defendant, ordered the same to be produced, and thereupon the said letter was produced by the plaintiff; and the defendant, by his counsel, offers to read the same in evidence, and the plaintiff, by his counsel, objects thereto, but the court permits the same to be read in evidence, and it is read accordingly, as follows; and the plaintiff, by his counsel, excepts thereto, &c.

*Third Exception.*—And here the plaintiff rested; and thereupon the defendant offered to read in evidence a letter addressed to him by the plaintiff, dated 14th of December, 1847, and also a letter from plaintiff to J. J. Greenough, which, it is admitted, is the same letter referred to in the testimony of said Greenough, as containing the authority under which he applied for the copies of patents, as testified by him in his examination by the plaintiff, which letter bears date the 14th of December, 1847, to the admissibility of which said letters, or either of them, as evidence in this cause, the plaintiff, by his counsel, objects, and the court overrules the said objection, and permits both of said letters to be read in evidence; and the handwriting of the plaintiff thereto being admitted, the same are read accordingly, and the plaintiff, by his counsel, excepts thereto, &c.

*Fourth Exception.*—And thereupon, and upon the whole evidence aforesaid, the defendant prayed the court to instruct the jury, that upon the evidence aforesaid, if the same is believed by the jury, the plaintiff is not entitled to recover in this action; which instruction the court gave, and the plaintiff, by his counsel, excepts thereto, &c.

Upon these exceptions, the case came up to this court, and was argued by *Mr. Bradley*, for the plaintiff in error, and by *Mr. Coxe*, for the defendant in error.

*Mr. Bradley* contended that the Circuit Court erred in each one of the above rulings.

*First.* The defendant was, by law, bound to give the copies asked for, if they could be made consistently with the public interest.

1. The Patent Office is, for certain purposes, an office of public

record, in like manner as the office in which the titles to real property are recorded :

From the very name, the object, the nature of the contract between the government and the patentee, the effect of the granting the patent as to the right granted, and the notice implied, the manner in which the title is secured, and by which a right under it is to be transferred, the necessity to prevent litigation, to prevent conflicts, to avoid the expenditure of time and money.

2. For like reasons, if no provision were made by law for copies, still the keepers of those records should be bound to give them.

3. The original statute, and each successive one, made provision for such copies. Act 10th of April, 1790, 1 Stat. at Large, 109, secs. 1, 2, 3; act 21st of February, 1793, Id., 318, secs. 1, 4, 11; act 4th of July, 1836, 5 Stat. at Large, 118, secs. 4, 5, 11; act 3d of March, 1837, Id., 191, secs. 1, 2, 12; act 3d of March, 1839, Id., 353, secs. 2, 8; act 29th of August, 1842, Id., 542, secs. 2, 6.

The law, in terms, provides copies in cases in which they are to be used as evidence, and makes them evidence. It does not stop here, but directs copies of the records, drawings, and other papers deposited in the office, to be given to any person making application for them, on their paying certain fees therefor.

It requires a record of the claim, specification, drawings, the patent therefor, and the assignment thereof. It imposes heavy penalties upon an infringement of the patent, and makes these records notice of the particulars of the right granted.

Its design, in authorizing copies to every person applying for them, is obvious; that is, protection against the danger of incurring these penalties. The reason for requiring copies in such cases, is obviously the same as that which requires them to be given in cases of contest. Prevention is often better than redress.

*Second.* The duty was purely ministerial, involving no discretion; and it will be further contended—

1. The general proposition, that, for a refusal by a public officer to do a mere ministerial act, to the injury of another's right, an action will lie.

2. The injury is to be compensated in damages, and if the officer has acted in good faith, the measure of damages is the actual injury sustained; if he has acted willfully, maliciously, corruptly, or by color of his office, with intent to injure, the party injured will be entitled to recover such damages as the jury may see fit to give.

As to the first branch of this second point, *Tracy & Ballestier v. Swartwout*, 10 Pet., 80; 9 How., 259.

Argument for the plaintiff in error.

As to the second branch, *Huckle v. Money*, 2 Wils., 205; *Beardmore v. Carrington*, Id., 244; *Dinsman v. Wilkes*, 12 How., 401-406; *Day v. Woodworth*, 13 How., 371.

*Third.* Evidence is admissible, in this last case, to show that the officer knew the nature of the injury he was inflicting, and therefore it was competent for the plaintiff to give in evidence the facts stated in plaintiff's bill of exceptions, not as indicating a measure of damages, but to give the jury some knowledge of the nature, character, and degree of the injury, as a guide in forming an estimate of the extent to which they might rightfully go in inflicting punitive as well as compensatory damages. *Marest v. Harveg*, 5 Taunt., 442; *Woert v. Jenkins*, 14 Johns., 352; *Whipple v. Walpole*, 10 N. H. Rep., 130; *Wallace, Jr.*, 164; and cases under second point.

*Fourth.* The letter written by the defendant to Mr. Greenough, set out in the second bill of exceptions, was not in evidence for any purpose.

1. Mr. Greenough had no authority to require it.

2. It was but an amplification of his first refusal, and not explanatory of it.

3. It was the party's own letter, offered in evidence by himself, not originally called for by plaintiff, and not in any manner admitted or acquiesced in by him. *Farlie v. Denton*, 3 C. & P., 103; 14 E. C. L. R., 227, 228; *Healey v. Thatcher*, 8 C. & P., 338; 34 E. C. L. R., 442; *Whitford v. Buckmeyer & Adams*, 1 Gill, 127, 140; *Van Buren v. Digges*, 11 How., 461, 477; *Towle v. Stevenson*, 1 Johns. Ca., 112; *Champlin v. Tilley*, 3 Day, 306; *Antoine v. Coit*, 2 Hall, (N. Y.,) 40, 46, 47.

*Fifth.* The letter to the defendant, set out in the third bill of exceptions, was not evidence for the defendant for any purpose. The letter from the plaintiff to Mr. Greenough was admissible to show his authority from the plaintiff, and shows conclusively that he had no authority to ask for or to receive defendant's written statement, set out in the second exception.

But the letter written by plaintiff to defendant, on the 14th of December, 1847, was not evidence in mitigation of his refusal on the 22d of December, 1847, or on the 2d of January, 1848; and it could have been admissible for no other purpose.

That letter would have reached here on the 18th of December, 1847, at furthest, by due course of mail, and the defendant had abundant time to get cool before the 22d of that month.

The refusals were both given deliberately, willfully, with the intent

to punish, that is, to injure the plaintiff, and the malice is so much the greater.

Mr. *Coxe*, for the defendant in error, made the following points:

1. That the Circuit Court ruled according to law on all the points raised in the bills of exception.

2. That the action is founded upon a misconception of the fourth section of the act of Congress of July 4, 1836.

3. That if the plaintiff's case is embraced by that section, the evidence in the record furnishes a complete justification of the acts of defendant.

4. That the declaration sets forth no legal cause of action.

Mr. Justice GRIER delivered the opinion of the court.

The bills of exception taken by the plaintiff to the rejection and admission of testimony on the trial have not been supported.

The declaration charges that the defendant Burke was Commissioner of Patents, and as such was bound to grant to applicants therefor copies of patents, &c., on payment of fees; that the plaintiff tendered the customary fees and demanded copies of certain patents, which defendant refused to give him, to the damage of plaintiff ten thousand dollars, &c.

As no special damage is alleged, the court very properly refuse to receive evidence tending to prove it.

A demand for certain copies was made through the agency of Mr. Greenough, but accompanied with a letter from plaintiff to defendant, requesting him to deliver the copies to Mr. Greenough. This letter, with the answer of defendant thereto, was properly received as part of the *res gestæ*, or as a conversation between the parties, reduced to writing.

A bill of exceptions was also taken to the charge of the court, who instructed the jury, "that, upon the evidence before them, the plaintiff was not entitled to recover."

As the plaintiff had shown a demand of the copies, with tender of fees, and a refusal of defendant, he had made out his case as laid in his declaration, and was entitled to a verdict for nominal damages, unless by law he was not entitled to demand such copies, or defendant had shown a sufficient excuse for refusing them. Patents are public records. All persons are bound to take notice of their contents, and consequently should have a right to obtain copies of them. The Patent Law of 1836, section four, enacts that "any person making application therefor may have certified copies," &c. These rec-

## Order.

ords being in the care and custody of the Commissioner of Patents, it is his duty to give authenticated copies to any person who shall demand the same, as soon as he conveniently can, on payment of the legal fees. Where there is a right on the one side, and a corresponding duty imposed on the other, a refusal to perform such duty, on the reasonable request of the party entitled to demand it, will subject the officer to an action. But the party entitled to such services must request it in a proper manner. He has no right to accompany his demand with personal insult, or vulgar abuse of the officer. Those to whom the people have committed high trusts are entitled at least to common courtesy, and are not bound to submit to the insolence or ill temper of those who disregard the decencies of social intercourse. A demand accompanied with rudeness and insult is not a legal demand. The letter accompanying the plaintiff's demand in this case was taunting, insulting, and libellous, indicating a want of taste and temper. And if the case had rested here, we could have found no fault with the instruction of the court. But the plaintiff showed another demand, some two weeks after the first, by his agent, which was made in a proper manner, and unaccompanied with any insulting missive. The defendant was not justified in refusing this demand on account of the former misconduct of the plaintiff, or to enforce an apology by withholding his rights. Ill manners or bad temper do not work a forfeiture of men's civil rights. While the want of an apology for his previous rudeness and insult might well justify the defendant in refusing all social intercourse with the plaintiff, yet it could not release him from the obligations imposed upon him by his official station, or entitle him to disregard the rights guaranteed to the plaintiff by the laws of the land.

The court below erred, therefore, in not instructing the jury, that, if they believed the testimony, the plaintiff was entitled to a verdict for nominal damages.

The judgment is reversed, and a *venire de novo* awarded.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Columbia, holden in and for the county of Washington, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

REVERSED WITH COSTS.

## Syllabus.

HENRY O'REILLY, EUGENE L. WHITMAN, AND W. F. B. HASTINGS,  
APPELLANTS, v. SAMUEL F. B. MORSE, ALFRED VAIL, AND FRANCIS  
O. J. SMITH.

(15 Howard, 62.)

1. Morse was the first and original inventor of the electro-magnetic telegraph, for which a patent was issued to him in 1840, and reissued in 1848. His invention was prior to that of Steinheil, of Munich, or Wheatstone or Davy, of England.
2. Their respective dates compared.
3. But even if one of these European inventors had preceded him for a short time, this circumstance would not have invalidated his patent. A previous discovery in a foreign country does not render a patent void, unless such discovery, or some substantial part of it, had been before patented or described in a printed publication. And these inventions are not shown to have been so.
4. Besides, there is a substantial and essential difference between Morse's and theirs, that of Morse being decidedly superior.
5. An inventor does not lose his right to a patent because he has made inquiries or sought information from other persons. If a combination of different elements be used, the inventors may confer with men, as well as consult books, to obtain this various knowledge.
6. There is nothing in the additional specifications in the reissued patent of 1848 inconsistent with those of the patent of 1840.
7. The first seven inventions set forth in the specifications of his claims are not subject to exception. The eighth is too broad, and covers too much ground. It is this: "I do not propose to limit myself to the specific machinery, or parts of machinery, described in the foregoing specification and claims, the essence of my invention being the use of the motive-power of the electric or galvanic current, which I call electro-magnetism, however developed, for making or printing intelligible characters, signs, or letters, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer."
8. The case of *Neilson et al. v. Harford et al.*, in the English Exchequer Reports, examined; and also the American decisions. The acts of Congress do not justify a claim so extensive.
9. But although the patent is illegal and void, so far as respects the eighth claim, yet the patentee is within the act of Congress which gives him a right to disclaim, and thus save the portion to which he is entitled. No disclaimer having been entered before the institution of this suit, the patentee is not entitled to costs.
10. In 1846, Morse obtained a second patent for the local circuits, which was reissued in 1848. It is no objection to this patent that it was embraced in the eighth claim of the former one, because that eighth claim was void. Nor is it an objection to it that it was an improvement upon the former patent, because a patentee has a right to improve his own invention.
11. This new patent, and its reissue, were properly issued. The improvement was new, and not embraced in the former specification.
12. These two patents of 1848 being good, with the exception of the eighth claim, are substantially infringed upon by O'Reilly's telegraph, which uses the same means, both upon the main line and upon the local circuits.



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Statement of the case.

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(Mr. Justice CURTIS, having been of counsel, did not sit in this cause.)

THIS was an appeal from the Circuit Court of the United States for the District of Kentucky, sitting as a court of equity.

It is difficult to make a fair report of this case without writing a book. The arguments of counsel would fill a volume by themselves.

The history of the case was drawn up by the learned judge who presides over the District Court of the United States in Kentucky, and whose decree was under review. Permission has been given, by Judge Monroe, that the reporter may use his statement as preliminary to this report, and he avails himself with pleasure of this kindness; because, although the narrative is occasionally interspersed with the opinions which induced the judge to decree an injunction in favor of Morse, yet the history is given with great precision and clearness.

The following statement is extracted from the opinion of Judge Monroe:

The complainants, in their bill, allege that Samuel F. B. Morse, one of them, was the true and original inventor of the electro-magnetic telegraph, worked by the motive-power of electro-magnetism, and of the several improvements thereon, by which intelligence which is in one place is transmitted to other distant places, and that by the letters patent of the United States duly issued to him, Samuel F. B. Morse, and by his partial assignments to F. O. J. Smith and Alfred Vail, the other complainants, they together are lawfully invested with the exclusive right of constructing and employing such telegraph for such purpose, throughout the United States, for the terms in the letters patent mentioned, and which have not yet expired, and they exhibit the letters patent.

They show that the practicability and great utility of the invention was fully established by the telegraph constructed under the superintendence of Morse, by means of an appropriation made by the Congress of the United States for the purpose, and put in operation between the cities of Washington and Baltimore, in the year 1844.

That afterwards there had been constructed, by the agency and means of joint-stock companies, promoted by the complainant, and operating under contracts and license of the patentee, Morse and his assignees, telegraphs along lines, amounting, in the aggregate, to upwards of four thousand five hundred miles, whereby telegraphic communication was established between the principal cities of the United States, from New Orleans to Boston; and that there were now in pro-

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gress of construction numerous additional and other lines, under contracts with them, for more widely extending the benefits of the invention, and they believe that if they are protected in the lawful use of their rights, every section of the United States will, in a short time, have the benefits of their improvements in telegraphic correspondence.

They represent that in all the lines of telegraphic communication now in successful operation in the United States in transmitting intelligence by means of electro-magnetism, the improvement of S. F. B. Morse, or the chief and essential principles and parts thereof, are employed.

They show that they had caused to be established, a line of telegraphic communication from Louisville, by way of Frankfort and Lexington, to Maysville, Ky., which was in successful operation.

They represent that they had caused to be constructed, lines of posts and wires from Louisville, in the district of Kentucky, by way of Bardstown, Glasgow, and Scottsville, in Kentucky, and thence by way of Gallatin to Nashville, in the district of Tennessee, for the transmission of intelligence by means of their improved telegraph; and that they had expended great sums of money therein; and that this line is in the extension to New Orleans, State of Louisiana; and is connected by another line with Memphis, Tennessee; and that large sums of money will be expended in this work; and all the lines in a short time completed, and the assignments.

They represent that their rights have been repeatedly and explicitly acknowledged and admitted in divers ways, and by individuals and large bodies of associated citizens in various sections of the United States; that these had treated with them for the purchase of their rights, or parts thereof, and of licenses to use their patented improvements; and that they had made extensive sales, or licenses to use them, to companies and individuals upon various lines, and amongst others to the New York, Albany, and Buffalo line; the Washington and New York line; the New York and Boston line; the Washington and Petersburg line; the line from Petersburg to New Orleans, besides numerous shorter and side lines.

They state that they had been thus in the successful and uninterrupted exercise of the rights granted to them by the letters patent of the United States, and had been in nowise disturbed therein, until, by the operations of the defendant, O'Reilly, and the committing of the wrongs presently mentioned, by him and his co-defendants.

This defendant, O'Reilly, they state, had, as early as 1845, entered into a contract with the complainants, and another, then having an

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interest in the patent, whereby he, O'Reilly, acknowledged their right; and that he had afterwards, in various ways and for a long period of time, manifested his acquiescence in, and admissions of, the rights and privileges of them, the complainants, and even insisted on his right to the use of them himself under his contract with them; that he had, under this contract and his claims under it, in fact, used and employed the improved telegraph of the complainants, and persisted in such, his claim, to employ it on all the lines embraced by his contract, without questioning the validity of their patents. But

They allege that this defendant, Henry O'Reilly, had, by himself, his agents and servants, constructed a line of posts and suspended metallic wires thereon, from the city of Louisville, in the district of Kentucky, by way of Bardstown to Nashville, in the State of Tennessee, and well knowing all the facts by the complainants set forth, he and his co-defendants had worked and employed upon said line a telegraph substantially the same with the electro-magnetic telegraph invented by the complainant Morse, and in his patents mentioned, against the will and without any authority from them, the complainants. They show that the terms of the contract under which O'Reilly claimed their right to the use of the telegraph, on certain other lines where he employed it, did not extend to any country north of the Ohio River, and that there was no color for any claim by the defendants to the use thereof within the district of Kentucky, or on any part of the lines by them lately constructed.

They represent especially that the defendants, in the operation and working of their line of telegraph, so by them constructed, used and employed instruments, apparatus, and means which are, in the material, substantial, and essential parts thereof, so upon the principle and plan of the said several improvements patented by the complainant Morse, or the plan and principle of some of said improvements, and not other or different. And

They state that by such means the defendants, their servants and agents, had been, for the space of more than four months past, and were still, transmitting intelligence over said line for any person who desired the same; and for such service had been, and are yet, receiving compensation from the persons for whom the same is performed; all which they allege is in violation of the rights granted by the letters patent, or of some of the parts thereof.

They further represent that the defendant O'Reilly was extending the line from Nashville to New Orleans, and had extended it to Memphis, and was operating upon the last-mentioned line to Memphis, in violation of the rights of them, the complainants, by the use

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of their patented improvements, or the principal and essential parts thereof; and that he had declared his intention of completing the other line from Louisville to New Orleans, and of then employing the same instruments as he was then using on the line from Louisville to Nashville.

They state that they are informed that the defendants sometimes give out, in speeches, that the patents of the complainant Morse are void; and at other times, give out and pretend that the machinery and apparatus which they use for the transmission and the reception of the intelligence upon the said line is a distinct and separate invention, which they, the complainants, are informed the defendants call the Columbian Telegraph:

Whereas, the complainants charge that the patents are good and valid in law, and that the defendant O'Reilly, by his contract with the patentee, and by his having exercised, and his persisting in his claim to exercise, under it, the exclusive privileges by the patents granted, is estopped from denying their validity. And

That the said pretended new invention is, in its essential principles, identical with and upon the plan of the patented improvements of Morse, and that the use of the same is a violation and infringement of the patent issued to the complainant Morse.

They allege that the defendants had received, and were then receiving, considerable sums of money for transmitting intelligence on the line from Louisville, within the district of Kentucky, in violation of the rights of the complainants; and they complain that the defendants had, by their unlawful operations, greatly disturbed them in the lawful exercise of their rights, so granted and held by them, and had caused a great diminution of the business of them, the complainants, on their line of telegraph, which they had caused to be constructed, and had now in operation within the district of Kentucky; and that the defendants refused to desist from such violation of the complainants' rights. Wherefore,

The complainants pray that the defendants, by an order, and the process of the court, may be enjoined from hereafter using or employing such telegraphs in the violation and infringement of the rights of them, the complainants, within the district of Kentucky; that they may be compelled to account for the money received by them, in consideration of their unlawful operations and wrongful exercise of the rights, privileges, and property of the complainants; and that, on due proceeding and final hearing, such order of injunction may be made final and effectual, and that the complainants may have such other relief as their case may require. And

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They propound numerous interrogatories, framed on all the material allegations of the bill, and pray that each defendant may be compelled to answer, on his oath, such as are for him designated, and to this end, and that they may have the relief which shall be adjudged them, they pray the writ of subpœna.

*Answer and Grounds of Defense.*

The defendants appeared by their counsel, and admitted that they had sufficient notice. O'Reilly read his answer to the complainants' bill.

The respondent admits the contract with the complainants of 1845, stated in the bill, and seems to admit that he had used, under it, portions of the "machine or combinations" described in the patent to Mr. Morse of 1840; but denies he had used others under this contract.

He says he was not scientific, and had not seen the patent until after the complainants had alleged he had forfeited his contract, and instituted a suit to have it vacated; and insists that he is not estopped to deny the validity of the patents.

He sets up no defense under this contract, and disclaiming any license from the complainants in respect to the line of telegraph in question, answers, that he believes, on grounds which he sets forth, that Mr. Morse is not the original and first inventor of the telegraph described in his patents, and insists that his patents are, on that ground, and upon their face, and for other causes he states, null and void.

He admits the construction and operation of the lines of telegraph in Kentucky and elsewhere, by himself and others; but, denying that the instruments employed on them are within the description of the complainants' patents, even on the supposition of their validity, denies the infringement.

But other grounds of defense, not presented by the answer, were assumed in the argument; and the matter of the answer will be more fully stated under the several heads of the whole defense. The defendants all united in opposition to the motion.

The parties respectively read, without objection, a great mass of documentary proof, in support of their positions, and a model of the telegraph described in the letters patent to Mr. Morse, and of the telegraph employed, and proposed to be employed, by the defendants, was exhibited and subjected to the application of the proofs, the explanation of the parties, and the inspection of the tribunal.

The grounds of defense presented by the answer of O'Reilly, and

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assumed on the proofs, will be comprehended under these heads of primary division :

I. The complainant Morse was not the true and original inventor of this telegraph.

II. The letters patent to him are null and void upon their face, and for other causes *dehors*.

III. The telegraph constructed and employed by them, the defendants, is substantially and in law different from the telegraph described in the letters patent to Morse, and of which he can lawfully claim the exclusive employment ; and, therefore, on the supposition of the validity of the patents to any extent, there has been no infringement.

IV. The case on the pleadings and proofs is not one, whatever might be considered of it on a final hearing of the bill, which will justify an order for injunction presently.

These subjects in their order.

Is Mr. Morse the original inventor of this telegraph, and of the several improvements thereon described in his letters patent ?

It is necessary that we now ascertain and settle what is the thing which was invented ; and to this end it will be most convenient to begin at its conception, and accompany it in its progress down to its present state of apparent maturity and completeness.

*History of the Invention.*

Its conception is fixed by Mr. Morse himself in October, 1832, on board the packet-ship *Sully*, on her passage from Havre, France, to New York.

He says that he was by profession a historical painter, and had, in 1829, gone to Europe for perfecting himself in that art ; that on his return home, in October, 1832, there were among the passengers in the ship the Hon. William C. Rives, Minister of the United States to the Court of France, Dr. C. T. Jackson, James Fisher, Esq., of Philadelphia, William Constable, Esq., and other gentlemen of extensive reading and intelligence ; and that soon after the voyage commenced the then experiments and discoveries in relation to electro-magnetism, and the affinity of electricity to magnetism, or their probable identity, became a subject of conversation.

In the course of this discussion, it occurred to him, that, by means of electricity, signs representing figures, letters, or words might be legibly written down at any distance, and that the same effect might be produced by bringing the current in contact with paper saturated with some saline solution. These ideas took full possession of his

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mind; and during the residue of the voyage he occupied himself, in a great measure, in devising means of giving them practical effect.

Before he landed in the United States, he had conceived and drawn out, in his sketch-book, the form of an instrument for an electro-magnetic telegraph, and had arranged and noted down a system of signs composed of a combination of dots and spaces, which were to represent figures; and these were to indicate words to be found in a telegraphic dictionary, where each word was to have its number. He had also conceived and drawn out the mode of applying the electric or galvanic current, so as to mark signs by its chemical effects.

This is the account of the inventor himself; but it is supported by the testimony of disinterested witnesses.

Mr. Rives, under date of September 27, 1837, addressing himself to Mr. Morse, says:

"I remember perfectly that you explained to me the idea of your ingenious instrument, during the voyage which we made together in the autumn of 1832. I also remember, that, during our many conversations on this subject, I suggested several difficulties to you, and that you obviated them with promptness and confidence."

Captain Pell, the commander of the ship, says, on the same day, addressing himself to Mr. Morse:

"When I examined your instrument, a few days since, I recognized in it the same mechanical principles and arrangements which I had heard you explain on board of my vessel in 1832."

And it appears, by the depositions of two brothers of Mr. Morse, that on their meeting him on board the ship, immediately she had moored at New York, the greeting had hardly passed between the three brothers, and before they had reached the house of one of them, which they immediately proceeded to from the ship, he announced to them his discovery, and told them that he had, during his voyage, made an important invention, which had occupied almost all his time on shipboard,—one that would astonish the world, and of the success of which he was perfectly sanguine; and that he said this invention was a means of communicating intelligence by electricity, so that a message could be written down in characters, in a permanent manner, at any distance; and he took from his pocket and showed them, in his sketch-book, a representation of his invention.

And this was the invention in October, 1832.

Mr. Morse further says:

"Immediately after his landing in the United States he communicated his invention to a number of his friends, and employed himself in preparations to prove its practicability and value, by actual experi-

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ment. To that end, he made a mould, and cast, at the house of his brother, in New York, before the commencement of the year 1833, a set of type representing dots and spaces, intended to be used for the purpose of closing and breaking the circuit in his contemplated experiments."

And this statement is also supported by other testimony.

But he was unable to proceed, for the want of money to purchase the materials for a galvanic battery and wire, and was compelled for subsistence to return to his pencil; and having been led in pursuit of employment from place to place, from 1832 to the latter part of 1835, he had no opportunity of making experiments of his invention. But he affirms he never lost faith in its practicability, or abandoned his intention of testing it as soon as he could command the means.

"In 1835, he was appointed professor in the New York City University, and about the month of November, in that year, occupied rooms in the University buildings. Here he immediately commenced, with very limited means, to experiment upon his invention.

"His first instrument was made up of an old picture or canvass frame fastened to a table; the wheels of an old wooden clock, moved by a weight, to carry the paper forward; three wooden drums, upon one of which the paper was wound, and passed thence over the other two; a wooden pendulum, suspended to the top piece of the picture or stretching frame, and vibrating across the paper as it passed over the center wooden drum; a pencil at the lower end of the pendulum, in contact with the paper; an electro-magnet, fastened to a shelf across the picture or stretching frame, opposite to an armature made fast to the pendulum; a type rule and type for closing and breaking the circuit, resting on an endless band composed of carpet-binding, which passed over two wooden rollers moved by a wooden crank, and carried forward by points projecting downwards into the carpet-binding; a lever, with a small weight on the upper side, and a tooth projecting downwards at one end, operated on by the type and a metallic fork, also projecting downwards over two mercury cups; at the other end, a galvanic battery of one cup, and a short circuit of wire embracing the helices of the electro-magnet, connected with the positive and negative poles of the battery, and terminating in the mercury cups.

"When the instrument was at rest, the circuit was broken at the mercury cups. As soon as the first type in the type rule (put in motion by turning the wooden crank) came in contact with the tooth on the lever, it raised that end of the lever, and depressed the other,



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bringing the prongs of the fork down into the mercury, thus closing the circuit. The current passing through the helices of the electro-magnet, caused the pendulum to move, and the pencil to make an oblique mark upon the paper, which in the meantime had been put in motion over the wooden drum. The tooth in the lever falling into the space between the first two types, the circuit was broken when the pendulum returned to its former position, the pencil making another mark as it returned across the paper. Thus, as the lever was alternately raised and depressed by the points of the type, the pencil passed to and fro across the strip of paper, passing under it, making a mark resembling a succession of V's, the points only of which, however, were considered as telegraphic signs. The spaces between the types caused the pen to mark horizontal lines, long or short, in proportion to their own length.

"With this apparatus, made as it was, and completed before the first of the year 1836, he was enabled to mark down intelligibly telegraphic signs; and having arrived to that point, he exhibited it to some of his friends early in that year, and first of all to Professor Leonard D. Gayle, who was a colleague professor in the university.

"Here was an actual operation of the instrument, and a demonstration of its capacity to accomplish the end of the invention."

And this statement is fully supported by the affidavit of Dr. Gayle. He says:

"That in the month of January, in the year one thousand eight hundred and thirty-six, I was a colleague professor, in the University of the city of New York, with Professor Samuel F. B. Morse, who had rooms in the University buildings, on Washington square, in said city; that during said month of January of the year aforesaid, the said Professor Morse invited me into his private room in the said university, where I saw, for the first time, certain apparatus, constituting his electro-magnetic telegraph. The invention, at that time, consisted of the following pieces of apparatus."

Here the witness gives a full description of the apparatus, and of its operation, and of the result; and this result was the making of the permanent and legible record.

And this was the state of the invention in January, 1836.

Thus far it had not been ascertained what was the limit of the magnetic power, and therefore it was not known on what length of wire it would be found of sufficient force to make the record, and there had been no means devised of extending the operation, further than the magnetic current of one battery would be effectual. But this matter had not escaped the attention of Mr. Morse, and he had

been devising means for the supply of whatever defect might be found in this respect.

He says: "Early in 1836 he procured forty feet of wire, and putting it in circuit, found that his battery of one cup was not sufficient to work his instrument. This result suggested to him the probability that the magnetism to be obtained from the electric current would diminish in proportion as the circuit was lengthened, so as to be insufficient for any practical purpose at great distances; and to remove that probable obstacle to his success, he conceived the idea of combining two or more circuits together, each with an independent battery, making use of the magnetism of the first to close and break the second; that of the second to close and break the third; and so on.

"His chief concern, therefore, in his subsequent experiments, was to ascertain at what distance from the battery sufficient magnetism could be obtained to vibrate a piece of metal to be used for that purpose, knowing that if he could obtain the least motion at the distance of eight or ten miles, the ultimate object was within his grasp."

A mode of communicating the impulse of one circuit to another, analogous to the receiving magnet now in use, was matured early in the spring of 1837, and then exhibited to Professor Gayle, his confidential friend.

And this statement is also fully confirmed by the statement of Dr. Gayle. He says:

"It was early a question between Professor Morse and myself, where was the limit of the magnetic power to move a lever? I expressed a doubt whether a lever could be moved by this power at the distance of twenty miles, and my settled conviction was, that it could not be done with sufficient force to mark characters on paper at 100 miles distance. To this Professor Morse was accustomed to reply, 'If I can succeed in working a magnet ten miles, I can go around the globe.' The chief anxiety, at this stage of the invention, was to ascertain the utmost limits at which he, Morse, could work or move a lever by magnetic power. He often said to me, 'It matters not how delicate the movement may be, if I can obtain it at all, it is all I want.' Professor Morse often referred to the number of stations which might be required, and which he observed would add to the complication and expense. The said Morse always expressed his confidence of success in propagating magnetic power through any distance of electric conductors which circumstances might render desirable. His plan was thus often explained to me: 'Suppose,' said Professor Morse, 'that in experimenting on twenty miles of wire, we should find that the power of magnetism is so feeble that it will but

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move a lever with certainty a *hair's-breadth*, that would be insufficient, it may be, to write or to print, yet it would be sufficient to close and break another or a second circuit twenty miles further, and this second circuit could be made, in the same manner, to close and break a third circuit; and so on around the globe.'

"This general statement of the means to be resorted to, now embraced in what is called the *receiving magnetic*, to render practical writing or printing by telegraph, through long distances, was shown to me more in detail, early in the spring of the year 1837, (one thousand eight hundred and thirty-seven,) and I am enabled to approximate the date very nearly, from an accident that occurred to me, in falling on the ice formed of late snow in the spring of that year.

"The accident happened on the occasion of removing to Professor Morse's rooms in the New York University some pieces of apparatus to prepare a temporary magnet.

"The apparatus was arranged on a plan substantially as indicated in the drawings on sheet 2, accompanying this affidavit. Figure 1 is a battery at one terminus of a line of conductors representing twenty miles in length, from one pole of which the conductor proceeds to the helix of an electro-magnet at the other terminus, the helix forming part of the conductor; from thence it returns to the battery, and terminating in a mercury cup *o*, from the contiguous mercury cup *p*, a wire proceeds to the other pole of the battery. When the fork of the lever *c* unites the two cups of mercury, the circuit is complete, and the magnet *b* is charged and attracts the armature of the lever *d*, which connects the circuit of battery 2 in the same manner, which again operates in turn lever *c*, twenty miles further; and so on.

"This I depose and say was the plan then and there revealed and shown to me by the said Professor Morse, and which, so far as I know, has constituted an essential part of his electro-magnetic telegraph from that date till the present time."

The diagram referred to by the witness is attached to the deposition, and exhibits the combination of the circuits of electricity claimed by Mr. Morse as a part of his invention. Their construction is fully described, and their operation having been witnessed by the deponent, is described in his deposition.

And this was the state of the invention early in the spring of 1837.

It fully appears that the completing of the invention had been retarded by the want of means by Mr. Morse. But in the spring of this year he appears to have been excited by the publication of an account of the invention of a telegraph by two French gentlemen, M. Gonon and Serval, which it was at first apprehended, from the

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terms of its announcement, was no other than the electro-magnetic telegraph, but which afterwards turned out to be only a form of the common telegraph formerly in use; and he consented to a notice being taken, in one of the newspapers of New York, of his invention, and renewed and increased his exertions to perfect and demonstrate its great superiority and value.

He was assisted by his fellow-professor, Dr. Gayle, in trying experiments, and in consideration thereof, and of his further assistance in such work, he presented him an interest in the invention; and by the united work of the two, from April to September, they were enabled to exhibit it in an improved form.

In the latter part of August, Dr. Gayle states, the operations of the instrument were shown to numerous visitors in the university. And he continues:

"It was on Saturday, the second day of September, 1837, that *Professor Dauberry, of the English Oxford University*, being on a visit to this country, was invited, with a few friends, to see the operations of the telegraph in its then rude form, in the cabinet of the New York City University, where it then had been put up with a circuit of 1,700 feet of copper wire, stretched back and forth in that long room. I well remember that Professor Dauberry, Professor Torrey, and Mr. Alfred Vail were present, among others. This exhibition of the telegraph, although of very rude and imperfectly-constructed machinery, demonstrated to all present the practicability of the invention; and it resulted in enlisting the means, the skill, and the zeal of Mr. Alfred Vail, who early the next week called at the rooms, and had a more perfect explanation from Professor Morse of the character of the invention."

"The doubt to be dispelled in Mr. Vail's mind, as he then stated, and has since frequently stated, was whether the power by magnetism could be propelled to such a distance as to be practically effective. This doubt was dissipated in a few minutes' conversation with Professor Morse; and I have ever been under the full conviction that it was the means then disclosed by Professor Morse to Mr. Vail, to wit, the plan of repeating the power of magnetism at any distance required, which I have stated, that induced Mr. Alfred Vail and his brother, George Vail, at once to interest themselves in the invention, and to furnish Professor Morse with the means, material, and labor for an experiment on a large scale."

And this was the state of the invention in September, 1837.

Mr. Morse accordingly proceeded to have constructed a new,

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larger, and more perfect instrument for exhibition on an application for a patent to Washington.

*Caveat.*

In the meantime, on the — day of October, 1837, in order to protect his right to his invention, he filed his caveat in the Patent Office.

It is in these words:

*“To the Commissioner of Patents.*

“The petition of Samuel F. B. Morse \* \* represents: That your petitioner has invented a new method of transmitting and recording intelligence by means of electro-magnetism, which he denominates the American electro-magnetic telegraph, and which he verily believes has not been known or used prior to the invention thereof by your petitioner. Your petitioner further states, that the machinery for a full, practical display of his new invention is not yet completed, and he therefore prays protection of his right till he shall have matured the machinery; and desires that a caveat for that purpose may be filed in the confidential archives of the Patent Office, and preserved in secrecy, according to the terms and conditions expressed in the act of Congress in that case made and provided; he having paid twenty dollars into the treasury, and complied with other provisions of the said act.

“New York, September 28, 1837.”

These are the specifications annexed to the caveat:

“The nature of my invention consists in laying an electric or galvanic circuit or conductors of any length to any distance. These conductors may be made of any metal, such as copper or iron wire, or strips of copper or iron, or of cords or twine, or other substances, gilt, silvered, or covered with any metal leaf, properly insulated in the ground, or through or beneath the water, or through the air, and by causing the electric or galvanic current to pass through the circuit, by means of any generator of electricity, to make use of the visible signs of the presence of electricity in any part of the said circuit, to communicate any intelligence from one place to another.

“To make the said visible signs of electricity available for the purpose aforesaid, I have invented the following apparatus, namely:

“First. A system of signs, by which numbers, and consequently words and sentences, are signified.

“Second. A set of type adapted to regulate and communicate the signs, with cases for convenient keeping of the type, and rules in which to set up the type.

“Third. An apparatus called a port rule, for regulating the move-

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ment of the type rules, which rules, by means of the type, in their turn regulate the times and intervals of the passage of electricity.

“Fourth. A register, which records the signs permanently.

“Fifth. A dictionary or vocabulary of words, numbered and adapted to this system of telegraph.

“Sixth. Modes of laying the conductors, to preserve them from injury.”

Here is a description of each of the articles of the invention, after which he concludes in these words:

“What I claim as my invention, and desire to secure by letters patent, and to protect for one year, is a method of recording permanently electrical signs, which, by means of metallic wires, or other good conductors of electricity, convey intelligence between two or more places.”

The new instrument, which Mr. Morse was enabled to have constructed by his arrangement with Mr. Vail, was completed in the latter end of this year, and in the succeeding February, 1838, it was exhibited in the Franklin Institute at Philadelphia, where it operated with success through a circuit of ten miles of wire; and a committee of the institute made a report of its success.

It was thence removed to the city of Washington, where it was publicly exhibited in the hall of the House of Representatives, and a committee having been appointed to examine it, made a favorable report, and recommended an appropriation of thirty thousand dollars, to have effectually tested the utility of the invention.

And this was the state of the invention early in the spring of 1838.

*Petition for Patent and its Specifications.*

The caveat was followed, on the 7th of April, 1838, by the petition of Mr. Morse for the patent. It is to this effect:

“Be it known, that I, Samuel F. B. Morse, of the city, county, and State of New York, have invented a new and useful machine and system of signs for transmitting intelligence between distant points, by the means of a new application and effect of electro-magnetism, in producing sounds and signs, or either, and also for recording permanently, by the same means and application and effect of electro-magnetism, any signs thus produced, and representing intelligence, transmitted as before named, between distant points, and I denominate said invention the American electro-magnetic telegraph, of which the following is a full and exact description, to wit:

“It consists of the following parts: First, of a circuit of electric or

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galvanic conductors from any generator of electricity or galvanism, and of electro-magnets at any one or more points in said circuit."

Here he gives the several parts of which his invention consisted, and adds a long description of each of them, and then sums up what he had affirmed he had himself invented, in these words:

"What I claim as my invention, and desire to secure by letters patent, is as follows:

"1st. The formation and arrangement of the several parts of mechanism constituting the type rule, the straight port rule, the circular port rule, the two signal levers, and the register lever, and alarm lever with its hammer, as combining respectively with each of said levers, one or more armatures of an electro-magnet, and as said parts are severally described in the foregoing specification.

"2d. The combination of the mechanism constituting the recording cylinder, and the accompanying rollers and train wheels, with the formation and arrangement of the several parts of mechanism, the formation and arrangement of which are claimed as above, and as described in the foregoing specification.

"3d. The use, system, formation, and arrangement of type and of signs for transmitting intelligence between distant points, by the application of electro-magnetism, and metallic conductors combined with mechanism, as described in the foregoing specification.

"4th. The mode and process of breaking, by mechanism, currents of electricity or galvanism, in any circuit of metallic conductors, as described in the foregoing specification.

"5th. The mode and process of propelling and connecting currents of electricity or galvanism in and through any desired number of circuits of metallic conductors, from any known generator of electricity or galvanism, as described in the foregoing specification.

"6th. The application of electro-magnets, by means of one or more circuits of metallic conductors, from any known generator of electricity or galvanism, to the several levers in the machinery described in the foregoing specification, for the purpose of imparting motion to said levers, and operating said machinery, and for transmitting, by signs and sounds, intelligence between distant points, and simultaneously to different points.

"7th. The mode and process of recording, or marking permanently, signs of intelligence transmitted between distant points, and simultaneously to different points, by the application and use of electro-magnetism or galvanism, as described in the foregoing specification.

"8th. The combination and arrangement of electro-magnets in one

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or more circuits of metallic conductors, with armatures of magnets, for transmitting intelligence by signs and sounds, or either, between distant points, and to different points simultaneously.

"9th. The combination and mutual adaptation of the several parts of the mechanism and system of type, and of signs, with and to the dictionary or vocabulary of words, as described in the foregoing specification."

It appears that no objection was found to the issuing of the patent immediately, except that there had not been filed with the specifications a duplicate set of the drawings, and that the Commissioner wrote, in answer to an application for it, to this effect, on the 1st of May.

*In England and France.*

But Mr. Morse had conceived a hope that he might secure a consideration for the use of his invention in foreign countries, as well as in the United States; and on the 15th of May he returned this answer to the Commissioner, and departed the next day for Liverpool:

"NEW YORK CITY UNIVERSITY, *May 15, 1838.*"

"HON. HENRY L. ELLSWORTH—*Dear Sir:* Excuse the delay in answering your letter of the 1st instant, relative to a duplicate set of drawings for my letters patent. May I ask the favor of you to delay issuing the letters patent until you hear from me in Europe, as I fear issuing them here will at present interfere with my plans abroad?"

"I sail to-morrow in the ship *Europe*, for Liverpool. Farewell."

In England, a patent was refused to the American inventor, on the ground that some description of his invention—the substance of which will appear hereafter—had been published in the *London Magazine*.

But he was otherwise received in France.

*In the French Academy of Sciences.*

He communicated a description of his invention, and exhibited the instrument in operation, before the French Academy of Sciences, on the 10th of September, 1838.

And this is the account of the invention published in the *Comptes Rendus*, the weekly journal of the academy:

"*Applied Physics.*—Electro-magnetic telegraph of Mr. Morse, professor in the University of New York."

"The instrument has been put in operation under the eyes of the



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academy. The following is a literal translation of a large portion of the notice delivered by Mr. Morse to the perpetual secretaries :

"Mr. Morse conceives that his instrument is the first practicable application which has been made of electricity to the construction of a telegraph.

"This instrument was invented in October, 1832, whilst the author was on his way from Europe to America, in the packet-ship *Sully*. The fact is attested by the captain of the ship and several of the passengers. Among the number of the latter was Mr. Rives, the Minister of the United States near the French government.

[Here is given the account of Mr. Rives and Captain Pell, already set out, after which the account proceeds:]

"The idea of applying galvanism to the construction of telegraphs is not new. Dr. Coxe, a distinguished citizen of Philadelphia, makes mention of it in a note inserted by him in February, 1816, in the *Annals of Dr. Thompson*, page 162, first series ; but he did not give any means of effecting it.

"Since the period to which the invention of Mr. Morse's telegraph goes back, other arrangements, founded on the same principles, have been announced, of which the most celebrated are those of Mr. Steinheil, of Munich, and of Mr. Wheatstone, of London. They differ very much in mechanism.

"The American telegraph employs but one circuit.\* The following is an abridged description of it :

"At the extremity of the circuit, where the news is to be received, is an apparatus called the register. It consists of an electro-magnet, the wire covering of which forms the prolongation of the wire of the circuit.

"The armature of this magnet is attached to the end of a small lever, which, at its opposite extremity, holds a pen ; under this pen is a ribband of paper which moves forward as required, by means of a certain number of wheels. At the other extremity of the circuit, that is to say, at the station from which the news is to be sent out, is another apparatus called the port rule ; it consists of a battery or generator of galvanism, at the two poles of which the circuit ends ; near the battery, a portion of this circuit is broken ; the two extremities disjoined are plunged into two cups of mercury near each other.

"By the aid of a bent wire attached to the extremity of a little

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\* "Suppose the places to be put in communication with each other occupy the three angles of a triangle, the four angles of a quadrilateral, or certain points of a line inclosing a space, a single wire passing through all those points would be sufficient, at least according to theory."

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lever, the two cups may be, at will, placed in connection with each other, or left separated; thus the circuit is completed and interrupted at pleasure. The movement of the mechanism is as follows:

"When the circuit is complete, the magnet is charged; it attracts the armature, the movement of which brings the pen into contact with the paper. When the circuit is interrupted, the magnetism of the horseshoe ceases, the armature returns to its first position, and the pen is withdrawn from the paper. When the circuit is completed and broken rapidly in succession, mere dots are produced upon the moving paper; if, on the contrary, the circuit remain complete for a certain length of time, the pen marks a line, the length of which is in proportion to the time during which the circuit remains complete. This paper presents a long interval of blank if the circuit remain interrupted during some considerable time. These points, lines, and blanks lead to a great variety of combinations. By means of these elements, Professor Morse has constructed an alphabet and the signs of the ciphers. The letters may be written with great rapidity by means of certain types which the machine causes to move with exactness, and which give the proper movements to the lever bearing the pen. Forty-five of these characters may be traced in one minute.

"The register is under the control of the person who sends the news. In fact, from the extremity called the port rule, the mechanism of the register may be set in motion and stopped at will. The presence of a person to receive the news is, therefore, not necessary, though the sound of a bell, which is rung by the machine, announces that the writing is about to be begun.

"The distance at which the American telegraph has been tried is ten miles English, or four post leagues of France. The experiments have been witnessed by a committee of the Franklin Institute of Philadelphia, and by a committee appointed by the Congress of the United States. The reports of these committees, which we have not copied, are extremely favorable. The committee of Congress recommended the appropriation of thirty thousand dollars."

*French Patent, 1838.*

A patent was accordingly granted to Mr. Morse, by the French government, but it yielded him no pecuniary profit.

It is dated on the 20th of August, 1838, and was delivered to him on the 30th of October afterwards.

But the law of France required the invention to be put into use in two years, and on failure the exclusive privilege of the patentee was

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forfeited. Mr. Morse had not the means of complying with the condition, and he returned home in 1838, with the hope of inspiring in his own countrymen sufficient confidence in his great invention. But the embarrassed condition of the country caused him to despair of success at that time, and being compelled to betake himself again to his pencil, he made no farther movement until the succeeding year.

*American Patent, 1840.*

On recurring to his former application for his patent, which had remained on the files of the office, the duplicate set of his drawings were still wanting; but having supplied this, and complied with some other directions of the Commissioner, the patent was issued.

It was sealed, and bears date June 20, 1840.

The specifications filed in 1838, on the application for the patent, are annexed to it as part thereof. These specifications, or so much of them as may be necessary, will be set out hereafter, before or when they become the subject of discussion.

But the confidence of the capitalists in an invention so extraordinary, and one promising such incredible results, could not be inspired, and the patentee was not able, himself, to construct a line of telegraph, and introduce it into actual use, and he again applied to the Congress of the United States. This resulted in the appropriation of thirty thousand dollars, according to the recommendation of the committee in 1838, for the purpose of testing the practicability and utility of the system, under the superintendence of Mr. Morse.

And this resulted in the construction of the line of telegraph from Baltimore to Washington, and a complete demonstration of the practicability and great public utility of his invention.

And this was the state of the invention in June, 1844, twelve years after its conception.

Efforts were then made for the extension and multiplication of its advantages, but difficulties were encountered in the introduction and establishment of an affair of such novelty, and requiring such a large amount of capital, and some time was necessary to overcome them.

The exertions were, however, continued, and with the success which the progress in the establishment of the telegraphs stated in the bill of exhibits.

And in the meantime, as will be presently seen, Mr. Morse continued his exertions to improve and perfect this great invention.

*1840 Patent Reissued 1846.*

In January, 1846, the specifications of the invention and description of the mode of its operation having been supposed to be in

some respects defective, the patent was surrendered, and a new patent taken out in its stead.

The specifications annexed to this patent will be adverted to hereafter. It will be sufficient for the present to state, that, in the summing up of what the patentee affirmed he had invented, there is found one article corresponding to the fifth and some of the other clauses in the specifications of the patent of 1840. He says:

"I also claim the combination of two or more circuits of galvanism or electricity, generated by independent batteries, by means of electro-magnetism, as above described."

It appears that originally the design was that this part of the invention was to be resorted to only in case the galvanic current of one battery should be found insufficient, on a long line, to afford the motive-power necessary to work the register and record the intelligence, and it does not appear that it had been, before this date, ascertained that the one battery and circuit would not be sufficient for any distance.

*Patent of 1846 for New Improvement.*

But on the 16th of April, 1846, Mr. Morse applied for and obtained another patent for an improvement on his own original invention.

And it appears from his representations, contained in the specifications annexed to this patent, that it had then been ascertained that the galvanic current generated by one battery would be sufficient to continue the electric current on any length of line, and afford sufficient motive-power to open and close the battery; but that it would not be sufficient at any considerable distance to work the register and make the record, unless this battery was made of great magnitude; and that by such battery the expense of the operation would be greatly increased.

He had, therefore, contrived what he called a receiver or receiving magnet, worked by a local battery, or battery situated at the place to which the intelligence is transmitted, by which a second, but short, local circuit, connected with the main circuit, was opened and closed, and sufficient force given to the register to make the record.

The second patent is for this and for other improvements, which he sums up in these words:

"What I claim as my invention, and desire to secure by letters patent, is the receiving magnet, or a magnet having a similar character, that sustains such a relation to the register magnet, or other magnetic contrivances for registering, and the length of the current or telegraphic line, as will enable me to accomplish, with the aid of

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a main galvanic battery and the introduction of a local battery, such motion or power for registering as could not be obtained otherwise without the use of a much larger galvanic battery.

"I claim as my invention the use of a local battery and magnet, in combination with a battery and magnet connected with the main line or lines of conductors, for the purpose above specified.

"I also claim the combination of the apparatus connected with the clock-work, for setting off the paper and stopping it with the pen lever, M.

"I also claim the combination of the points affixed in the pen lever, with the grooved roller, N, for marking on paper, as above described."

But on the 13th of June, 1848, on the supposition there were some defects in the specifications of each of these two patents then extant, they were both surrendered and cancelled, and new patents obtained in the stead of each, respectively.

And these are the patents upon which the exclusive right to the employment of the telegraph now before us is claimed by the complainant.

But it is necessary, to a fair and intelligible statement and discussion of the case, that large portions of the schedules be set out in their own words.

*1840 Patent Reissued 1848.*

The patent itself, which is a reissue of the patents of 1846, which was a reissue of the original patent of 20th June, 1840, will be given at length, because the terms of it will be the subject of discussion hereafter, in connection with the statute. It is in the following words:

"The United States of America to all to whom these letters patent shall come:

"Whereas, Samuel F. B. Morse, of Poughkeepsie, New York, has alleged that he has invented a new and useful improvement in the mode of communicating information by signals, by the application of electro-magnetism, for which letters patent were granted on the 20th of June, 1840, which letters patent were surrendered and rescinded on the 15th day of January, 1846, which last letters patent are hereby cancelled, on account of a defective specification, which he states has not been known or used before his application; has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer of the said improvement, and that the same has not, to the best of his knowledge and belief, been previously known or used; has paid into the treasury of

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the United States the sum of fifteen dollars, and presented a petition to the Commissioner of Patents, signifying a desire of obtaining an exclusive property in the said improvement, and praying that a patent may be granted for that purpose:

"These are, therefore, to grant, according to law, to the said Samuel F. B. Morse, his heirs, administrators, or assigns, for the term of fourteen years from the twentieth day of June, one thousand eight hundred and forty, the full and exclusive right and liberty of making, constructing, using, and vending to others to be used the said improvement, a description whereof is given, in the words of the said Samuel F. B. Morse, in the schedule hereunto annexed, and is made part of these presents."

The schedule annexed is in the words :

"To all to whom these presents shall come: Be it known, that I, Samuel F. B. Morse, now of ———, State of New York, have invented a new and useful apparatus for, and a system of, transmitting intelligence between distant points, by means of electro-magnetism, which puts in motion machinery for producing sounds or signs, and recording said signs upon paper or other suitable material, which invention I denominate the American electro-magnetic telegraph, and that the following is a full, clear, and exact description of the principle or character thereof, which distinguishes it from all other telegraphs previously known, and of the manner of making and constructing said apparatus and of applying said system, reference being had to the accompanying drawings, making part of this specification."

Here follows a description of the instruments and of the mode of their operation, which will be omitted here and adverted to hereafter.

These particular specifications and descriptions completed, the patentee sums up what he intends it should be understood he had and had not invented; and after disclaiming all pretensions to the invention of what he says was before known, he specifies what he affirms he had himself discovered or invented, and thus designates his improvement or improvements, a description whereof he had just before given in this, his schedule, and which is made part of the patent:

"First. Having thus fully described my invention, I wish it to be understood that I do not claim the use of the galvanic current, or current of electricity, for the purpose of telegraphic communications generally; but what I specially claim as my invention and improvement is making use of the motive-power of magnetism, when developed by the action of such current or currents, substantially as set forth in the foregoing description of the first principal part of my

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invention, as means of operating or giving motion to machinery, which may be used to imprint signals upon paper or other suitable material, or to produce sounds in any desired manner, for the purpose of telegraphic communication at any distances.

"The only ways in which the galvanic currents had been proposed to be used prior to my invention and improvement were by bubbles resulting from decomposition, and the action or exercise of electrical power upon a magnetized bar or needle; and the bubbles and deflections of the needles thus produced were the subjects of inspection, and had no power or were not applied to record the communication. I therefore characterize my invention as the first recording or printing telegraph by means of electro-magnetism.

"There are various known modes of producing motion by electro-magnetism, but none of these had been applied prior to my invention and improvement, to actuate or give motion to printing or recording machinery, which is the chief point of my invention and improvement.

"Second. I also claim as my invention and improvement the employment of the machinery called the register or recording instrument, composed of the train of clock-wheels, cylinders, and other apparatus, or their equivalent, for removing the material upon which the characters are to be imprinted, and for imprinting said characters, substantially as set forth in the foregoing description of the second principal part of my invention.

"Third. I also claim as my invention and improvement the combination of machinery herein described, consisting of the generation of electricity, the circuit of conductors, the contrivance for closing and breaking the circuit, the electro-magnet, the pen or contrivance for marking, and the machinery for sustaining and moving the paper, altogether constituting one apparatus of telegraphic machinery, which I denominate the American electro-magnetic telegraph.

"Fourth. I also claim as my invention the combination of two or more galvanic or electric circuits, with independent batteries, substantially by the means herein described, for the purpose of obviating the diminished force of electro-magnetism in long circuits, and enabling me to command sufficient power to put in motion registering or recording machinery at any distance.

"Fifth. I claim as my invention the system of signs, consisting of dots and spaces, and of dots, spaces, and horizontal lines, for numerals, letters, words, or sentences, substantially as herein set forth and illustrated, for telegraphic purposes.

"Sixth. I also claim as my invention the system of signs, con-

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sisting of dots and spaces, and of dots, spaces, and horizontal lines, substantially as herein set forth and illustrated, in combination with machinery for recording them, as signals for telegraphic purposes.

"Seventh. I also claim as my invention the types, or their equivalent, and the type rule and post rule, in combination with the signal lever, or its equivalent, as herein described, for the purpose of breaking and closing the circuit of galvanic or electric conductors.

"Eighth. I do not propose to limit myself to the specific machinery, or parts of machinery, described in the foregoing specifications and claims; the essence of my invention being the use of the motive-power of the electric or galvanic current, which I call electro-magnetism, however developed, for making or printing intelligible characters, letters, or signs at any distance, being a new application of that power, of which I claim to be the first inventor or discoverer."

*1846 Patent Reissued 1848.*

This patent is the reissue of the patent of April, 1846, and is for a new and useful improvement in "electro-magnetic telegraphs." It grants the exclusive use to the patentee for the term of fourteen years from the eleventh day of April, 1846, and refers in the common form to the schedule annexed for the specifications of the improvement. This schedule is in these words:

"Be it known, that I, Samuel F. B. Morse, \* \* \* have invented a new and useful improvement in the electro-magnetic telegraph, and I do hereby declare that the following is a full, clear, and exact description of the object, construction, and operation thereof, reference being had to the accompanying drawings, and making part of the same.

"Object of the invention:

"The original and final object of all telegraphing is the communication of intelligence at a distance by signs or signals.

"Various modes of telegraphing, or making signs or signals at a distance, have for ages been in use. The signs employed heretofore have had one quality in common. They are evanescent—shown or heard a moment, and leaving no trace of their having existed. The various modes of these evanescent signs have been by beacon-fires of different characters, by flags, by balls, by reports of fire-arms, by bells heard from a distant position, by movables, arms from posts, &c.

"I do not, therefore, claim to be the inventor of telegraphs generally. The electric telegraph is a more recent kind of telegraph, proposed within the last century, but no practical plan was devised until about sixteen years ago. Its distinguishing feature is the employ-



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ment of electricity to effect the same general result of communicating intelligence at a distance by signs or signals.

"The various modes of accomplishing this end by electricity have been—

"The employment of common or machine electricity, as early as 1787, to show an evanescent sign by the divergence of pith balls.

"The employment of common or machine electricity, in 1794, to show an evanescent sign by the electric spark.

"The employment of voltaic electricity, in 1809, to show an evanescent sign by the evolution of gas bubbles, decomposed from solution in a vessel of transparent glass.

"The employment of voltaic electricity in the production of temporary magnetism, in 1820, to show an evanescent sign by deflecting a magnet or compass needle.

"The result contemplated from all these electric telegraphs was the production of evanescent signs or signals only.

"I do not, therefore, claim to have first applied electricity to telegraphing for the purpose of showing evanescent signs and signals.

"The original and final object of my telegraph is to imprint characters at any distance as signals for intelligence; its object is to mark or impress them in a permanent manner.

"To obtain this end, I have applied electricity in two distinct ways: 1st. I have applied, by a novel process, the motive-power of electromagnetism, or magnetism produced by electricity, to operate machinery for printing signals at any distance. 2d. I have applied the chemical effects of electricity to print signals at any distance.

"The apparatus or machine with which I mark or imprint signs or letters for telegraphic purposes at a distance, I thus describe."

Here follows a description of the instruments and of how they are employed. After which the patentee sums up, and specifies what he affirms he had invented, and desires to have secured to him by the grant, in these words:

"First. What I claim as my invention, and desire to secure by letters patent, is the employment, in a main telegraphic circuit, of a device or contrivance called the receiving magnet, in combination with a short local independent circuit or circuits, each having a register and register magnet, or other magnetic contrivances for registering and sustaining such a relation to the register magnet, or other magnetic contrivances for registering, and to the length of circuit of telegraphic line, as will enable me to obtain, with the aid of a galvanic battery and main circuit, and the intervention of a local battery and local circuit, such motion or power for registering as could not

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be obtained otherwise without the use of a much larger galvanic battery, if at all.

"Second. I also claim as my invention the combination of the apparatus called the self-stopping apparatus, connected with the clock-work by the register, for setting said register in action and stopping it with the pen lever, F, as herein described.

"Third. I also claim as my invention the combination of the point or points of the pen and pen lever, or its equivalent, with the grooved roller, or other equivalent device, over which the paper or other material suitable for marking upon may be made to pass for the purpose of receiving the impression of the characters; by which means I am enabled to mark or print signs or signals upon paper or other fabric by indentation, thus dispensing with the use of coloring matter for marking, as specified in my letters patent of January 15, 1846."

But the telegraph itself, constructed according to the specifications of the patents, and in actual use, having been exhibited and given in proof, it is necessary, in order to put on paper the case which has been heard, that the instruments themselves be described.

*Description of the Telegraph.*

It consists of—

1. The main circuit, with its battery.
2. The key, with the signal lever.
3. The local circuit, with its battery.
4. The receiver or mutator, with its electro-magnet.
5. The register, with its electro-magnet, pen lever, and grooved roller.

It will be observed that in this description the relay magnet, as it was called, by which the combination of the circuit was originally effected, will not be found. It has been substituted by the subsequently invented receiver or mutator, on the same principle by which the main circuit is combined with each local circuit, or circuit in the telegraph office, whereby sufficient motive-power is obtained to work the register.

And that the port rule is also absent. It has been supplied by the improved register and pen lever, with its pen point and grooved rollers in connection.

And it will be observed that the telegraphic dictionary has been also abandoned; and that the characters indented by the pen constitute an alphabet, differing in little else beside the figure of the letters

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from the common alphabet, and which is therefore read, not by a peculiar dictionary, but as common manuscript.

Nothing occurred in the case which makes it necessary to describe the self-stopping apparatus.

The main circuit of conductors, in connection with the principle battery and key, with its pen lever which operates upon it, may be thus described.

It is begun in a plate of copper buried in the ground under the first telegraph office, and consists of these conductors:

A copper wire, having one end inserted in the copper-plate, and the other in one pole of the galvanic battery, in a room of the office.

Another copper wire, with one end inserted in the other pole of the battery, and after passed through the rooms as may be convenient, with the other end of it extended up and inserted in and under one end of a short bar of brass, which is part of the instrument called the key.

We will here stop the description of the circuit of conductors, and describe this instrument.

*Key with its Signal Lever.*

This key consists of a cross formed of two flat bars of brass, about two or three inches long, screwed down upon the table, or upon a pedestal fixed upon the table; on each end of the arms of this cross there rise similar bars, after the manner of the sights of a surveyor's compass, about a couple of inches high. These support the fulcrum of the signal lever. This fulcrum of the lever is a steel cylinder extended between the two upright bars on the arms of the cross, with its ends terminating in axles extending through the bars near the upper ends, so that it may be turned when the lever is worked.

The lever is a bar of brass fixed with its center upon this fulcrum. It is horizontal when at rest, and is kept in its position by a spring fixed under its fulcrum and extended back. A sort of button of brass is fixed immediately under the front end of the lever, and in proximity to the foot of the cross; so that when the lever is pressed down it is brought into contact with it and the end of a wire which is extended up through its center. This button is so contrived that, by a short lever extended from it, it is turned from or brought into contact with the cross. We now return to the circuit of conductors.

It is in and under the head of this cross that the wire from the battery was inserted; and this bar constitutes the next conductor.

There are now here two conductors: one the conductor when intelligence is not being transmitted from the office, and the other when

intelligence is being transmitted from the office. When intelligence is not being transmitted, then, after this bar of the key, the button having the brass wire through its center is the conductor. But when the position of the button is so changed that it is not in contact with this bar, then it is not the next conductor, and the right and left hand arms of the cross and the fulcrum are the next conductors, and the signal lever pressed down and brought into contact with the button is the conductor to it and the wire projecting up through it.

When intelligence is to be transmitted from the office, the operator changes the position of the button, brings it out of contact with the foot of the cross, and the circuit at this point is broken, and the lever constituted the conductor next the button towards the key. The operator has then command of the circuit for his operation. By pressing the key down into contact with the button, the circuit is closed; and the pressure off, the circuit is broken. This produces the corresponding action of the pen lever, which registers the intelligence he sends off.

We now return to the circuit of conductors.

The wire extended from the button is the next conductor. It is copper, and is extended down under the table, and then up through it near the pedestal of the receiving magnet, situated on the table at a convenient distance from the key, and inserted in a brass standard near its upper end, which stands on one corner of the pedestal of this receiver, which will be presently described.

And this standard is the next conductor.

The next is a small brass wire, extending from the foot of this standard up through the pedestal into proximity to the horseshoe magnet. This wire, prolonged and covered with silk, is wound around the shanks of the horseshoe, first around the one end and then around the other, and made to constitute the helices of the magnet; after which it is returned down through the pedestal, and inserted in the foot of another standard on another corner of the pedestal of the magnet.

And this standard is the next conductor.

The next is the brass wire with one end inserted into the standard near its upper end, and the other, after its extension out of the office, united to the iron wire on the posts.

This iron wire is the next conductor to the next office. On entering this office, it is united to the end of a copper wire, which has its other end inserted in and under the head of the cross of the key in the office. Thence the circuit is continued through the instruments of this office as in the first office, when it is again extended out upon

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the posts to another office; and thus through any number, and over any distance, to the last office of the circuit. It is then, after being passed through the instruments of this office as in the other offices, extended down and fastened in a plate of copper in the ground.

The earth, it is said, constitutes the conductor from this copper-plate to the other, from which we set out, and thereby the circuit is completed.

We will now return and describe the receiver, more properly called the mutator.

*Receiving Magnet.*

This magnet rests on the pedestal which has been already mentioned, eight or ten inches long, and four or five broad, with the axis of its helices horizontal, and parallel to the sides of its pedestal, and with what corresponds to the front part of the horseshoe presented to the left, in proximity to the two standards we passed on the circuit.

It is kept in its position by a brass bar extended across the helices, near the heels of the horseshoe, and pressed and kept firmly upon them by a screw extended down from either end into the pedestal.

Its heels present themselves to a horizontal armature of a movable upright lever within their attractive power, and which, it will be presently found, is one of the conductors of the local circuit.

This local circuit can now be described. It begins in a galvanic battery in the office, and consists of these things:

A copper wire, with one end inserted in one pole of the local battery in a room of the office, and the other end brought up through the table and screwed into an upright brass bar or standard near its upper end, standing on the back right-hand corner of the pedestal of the receiver.

The next conductor is this standard.

And then a copper wire extended from its lower end under the pedestal, and there connected with a steel cylinder, which constitutes the fulcrum, on which stands the movable lever already mentioned in describing the main circuit.

This cylinder is horizontal, parallel to the heels of the magnet, but below them, is fixed in a channel across the pedestal, and has its ends in sockets, in which it turns and allows the lever which stands upon it to move forward and back.

And this lever is the next conductor.

It stands perpendicular, and is held in this position by a spiral spring extended from behind it and holding it back against the end of a screw projected in like manner against its back; but which, when

the armature fixed across it is attracted by the heels of the magnet, readily consents to its motion forward to meet near its upper end another conductor, which will be presently described, and when the attraction is not as quickly, withdraws it to its former position.

We will now return back to the local battery, and commence at its other pole.

The first conductor thence in this direction is another copper wire.

This has one end inserted in the battery, and after being extended around, according to the situation of the room, has its other end brought up under the table near the electro-magnet of the register, where it is united to a small wire, which is the next conductor.

It is prolonged and wound on the horseshoe bar in like manner with the wire on the main circuit, and made to constitute the helices of this magnet, and then has its other end fastened to a large wire.

And this wire is the next conductor.

It is extended under the table, and afterwards brought up, and has its other end screwed into a brass standard upon the right-hand front or remaining corner of the pedestal of the receiver.

And this standard is the next conductor.

It is succeeded by a brass wire, extended from its lower end under the pedestal, and brought up between the helices of the receiving magnet to the under side of the horizontal bar, which we lately left extended across the helices, near the heels of the magnet, and there inserted in this bar.

Immediately over this end of this wire, and fixed upon this horizontal bar, stands a perpendicular bar, which is the next conductor.

And the last conductor is a brass screw, which, passed through this bar, near its upper end, and extended out horizontally from it, presents its platina point to the movable lever, which we lately left in describing the conductors from the other end of the battery, ready to close the circuit whenever attracted forward by the heels of the magnet presented to its armature below.

When, by the act of the operator on his signal key, the main circuit is complete or "closed," as it is called, the horseshoe is instantly an electro-magnet, and the armature of the lever, attracted towards, not to, its heels, the lever is brought into contact with the platina point of the brass screw, presented to its front, and the local circuit of conductors is "closed"; and the horseshoe, whereon we just said the wire of the local circuit had formed the helices, being converted into an electro-magnet for the register, instantly acts upon the pen lever in the register, in the mode we will presently describe, and records the intelligence which the operator proposed.

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This done, and the main circuit broken, the spiral spring behind the lever, which had before readily assented to its attraction forward, as quickly withdraws it to its former position, and awaits another signal.

*Register, Pen Lever, and Grooved Rollers.*

The register consists of a horseshoe magnet, the pen lever, a spiral spring, the grooved rollers, and the clock-work, all fixed in a proper frame upon a brass pedestal ten or twelve inches long and about half that breadth, fixed down upon the table at a convenient distance from the other instruments.

The magnet is fixed on the right-hand end of the pedestal, the axis of the helices perpendicular, and the heels upwards, presenting themselves to an armature of the pen lever within their attraction above.

The pen lever is a brass bar. It rests in a horizontal position, with one end extended to the right, across the heels of the magnet, where its armature is fixed across it, and the other extended to the left, towards the rollers.

It has for its fulcrum a steel cylinder, fixed across its center, with its ends in sockets in the framework. It is held to the position by the spiral spring, extended from the lower end of a bar fixed in, and extended down from, the center of the fulcrum, and thence extended back towards the magnet, and made fast, which, by its facile extension, instantly assents to the action of the lever with its pen, and as quickly withdraws it.

The rollers are fixed each with its axis in the framework, one with its axis on a level with the lever, the other with its axis over the line of the periphery next the lever of the lower roller.

The pen, fixed upon this end of its lever, and projected forward, presents its point upwards, in proximity to the center of this upper roller, in proper direction for action upon the paper in its transit over it when cast up by the attraction down of the other end of the magnet.

The paper is guided from above this upper roller and passed around it and between the two rollers, and by their revolution is drawn forward at a rate suited to the action of the pen.

There is around each roller, under the paper and exactly opposite the pen, a narrow groove of such depth that the pen point, in making its indentations on the paper, does not extend to the metal of the roller, whereby its point is preserved and the line of characters on the paper is kept from contact with either roller, and protected from being dimmed by the compression of the paper, in its transit between them.

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The revolution of the rollers is by the clock-work on the left.

The rollers having been put in motion, the electro-magnet charged, the armature with that end of the lever attracted down, and the other cast up, the pen with its point indents a character upon the paper, and the magnet is charged, the spiral spring has brought down the pen, and holds it in position for a repetition of the act.

But we will return to the signal key, or correspondent, stationed in the distant office whence the intelligence is to be transmitted, and follow it in its course and see it recorded.

The operator having been put in possession of the intelligence, and broken the circuit in the lower conductors of his key, and thereby made his signal lever a conductor of the main circuit, applies his hand upon the signal lever and presses it down upon the conductor below, the main circuit is instantly closed; the horseshoe within the helices of this main circuit is a magnet, the armature has drawn its movable lever into contact with the platina point, the local circuit is closed; the horseshoe within the helices of this circuit is an electro-magnet, the armature of the pen lever is upon its heels, the other end of the lever has cast up the pen, and indented an intelligible character upon the paper.

The operator's hand taken off, and the main circuit is broken; the receiver within it is not a magnet; the movable lever has been withdrawn by its spring from the platina point, the local circuit is broken; the register magnet is no longer a magnet, and the pen has been sprung down from the paper, and stands ready to repeat and add another character of the intelligence.

The operator's hand upon his lever, and another character is added.

And these are the characters recorded, and how they are read: — is A, — — — is B, — — — is C, — — — is D, — is E, — — — is F, — — — is G, — — — is H, — — is I, — — — — is J, — — — is K, — — — is L, — — — is M, — — — is N, — — is O, — — — — is P, — — — — is Q, — — — is R, — — — is S, — is T, — — — is U, — — — — is V, — — — — is W, — — — — is X, — — — — is Y, — — — — is Z, — — — — is &; and such is the alphabet.

Then — — — — is 1, — — — — is 2, — — — — is 3, — — — — is 4, — — — — is 5, — — — — is 6, — — — — is 7, — — — — is 8, — — — — is 9, — — — — is 0; and these are the numerals.

The holding down the lever an instant indented one dot (-); the holding it longer made a dash (—) of a length corresponding to the time. The dots were made at distances corresponding to the time the hand was held off the lever.

And this is the telegraph and its operations before us.



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(Judge Monroe then proceeded to examine the law and evidence upon all other points in the case, and then passed the following decree:)

*Decree of the Circuit Court, 12th November, 1849.*

It is found and adjudged by the court that the letters patent of the United States to the complainant, Samuel F. B. Morse, for his invention of a new and useful improvement in the mode of communicating information by signals, by the application of electro-magnetism, originally issued June 20, 1840, but reissued on the 15th day of January, 1846, and afterwards finally reissued on the 13th of June, 1848, in their bill exhibited and read on the hearing of this cause, are valid and effectual acts of the government; and that the complainants are thereby, and by the assignments by them in their bill alleged, vested with the exclusive rights thereby granted.

And it is found and adjudged by the court that the defendants have, in those rights, disturbed the complainants as in their bill alleged; that they, the defendants, after the grant thereof to the patentee, Samuel F. B. Morse, and his assignments to his co-complainants, and after the final reissue of the letters patent above mentioned, did, within the district of Kentucky, and elsewhere, wrongfully construct and unlawfully employ a telegraph, consisting of combined circuits of electricity, worked by the motive-power of electro-magnetism, substantially the same plan of construction and principle of operation with the telegraph of the said Morse in his letters patent described and specified; and by which intelligence which was in one station was, by the defendants, transmitted to other distant stations, by making thereat a permanent record thereof in the alphabetical characters described and specified in the letters patent to the said Morse, and did thereby violate and infringe the exclusive rights so granted by the United States to him, the said Samuel F. B. Morse, and invested in the complainants as above found; and it is considered that the injunction heretofore granted herein was rightfully awarded and enforced.

It appears, however, by the document itself, read by the complainants among their proof, that the patentee, Samuel F. B. Morse, had, on the 30th day of October, 1838, prior to the issuing of his original patent, awarded by the United States for his original invention, obtained of the government of France a patent for the invention of his electro-magnetic telegraph, in principle and plan of construction the same with that described in his said letters patent so afterwards obtained of the United States.

And it seems to the court that the exclusive right of the complain-

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ant, in respect to his original invention, is limited by this foreign patent to the term of fourteen years from its date.

It is therefore ordered, adjudged, and decreed that the defendants, their servants and agents, be, and they are hereby, enjoined and commanded that they, and each of them, do still desist, and shall for and during the term of fourteen years from the 30th day of October, 1838, altogether refrain from all and every use of the electro-magnetic telegraph which the complainants, in their bill, charged was, by the defendants, employed in violation of their rights, which, in its several forms, is described in the proofs of the cause, and denominated by the witness in the depositions, and by defendant O'Reilly in his answer, the Columbian telegraph, in the transmission of intelligence which is in one place to another distant place, by making thereat a permanent record in the alphabetical characters in the patent of Samuel F. B. Morse for his original invention specified; or by making thereat, with the action of the instrument which would make such characters, alphabetical sounds, and out of them composing such characters or words in the ordinary alphabet; and from the using of such telegraph, or any part thereof, in any other mode, in violation of the exclusive rights so granted by the United States and vested in the complainants; and that they shall, for and during the said term of fourteen years, refrain from making, constructing, or vending to be used within the district of Kentucky any other telegraph, consisting of combined circuits of electricity, worked by the motive-power of electro-magnetism, on the plan and principle of the electro-magnetic telegraph of the complainant Morse, described and specified in his letters patent, by which intelligence shall or may be transmitted by making, in the mode above stated, a record thereof in the said alphabetical characters of the said Samuel F. B. Morse, or in an alphabet formed on the same plan and principle, or by making in such mode sounds whereof such characters shall or may be composed, in the violation and infringement of the exclusive right of the complainants as they are above adjudged.

It is also found and adjudged by the court that the letters patent of the United States to Samuel F. B. Morse, for his invention of "a new and useful improvement in electro-magnetic telegraph," originally issued on the 11th day of April, 1846, but afterwards reissued on the 13th of June, 1848, with the amended specifications of the improvements invented, which is in the bill of the complainants exhibited, and made part of the record of this cause, is a valid and effectual act of the government; and that the complainants are there-

## Statement of the case.

by, and by the assignments in their bill alleged, vested with the exclusive rights thereby granted.

And it is found and adjudged that the defendants have disturbed the complainants in these their exclusive rights. It is found that the defendants, before and after the issuing of the said last-mentioned letters patent of the 13th of June, 1848, in renewal of the said former patent, did, within the district of Kentucky, and elsewhere, wrongfully cause to be constructed, and did unlawfully use and employ, as a part of the electro-magnetic telegraph denominated the Columbian telegraph, an instrument denominated by them the mutator, in plan of construction, principle of operation, and in the purpose accomplished by it, substantially the same with the improvement described and specified in the said last-mentioned letters patent to the complainant Morse, which consists of the contrivance called, in his schedule to his patent, the receiving magnet, which is by this denomination described and specified under the head of the first claim of the improvements in his schedule.

And that they did, in like manner, cause to be constructed, and unlawfully employ as another part of the said Columbian telegraph, certain other apparatus and instruments, and combinations thereof, in plan of construction, principle of operation, and purpose, substantially the same with the improvements of the register invented by him, the said Samuel F. B. Morse, and in the schedule described and specified as the third thing claimed by him as his invention, consisting of the combination of the point of the pen and pen lever, with the grooved roller over which the paper is passed, and receives the indentations of his alphabetical characters, and whereby is dispensed with the use of the coloring material, as specified in the patent for the original invention of the telegraph first above mentioned, issued and bearing date January 15, 1846.

And it is found that the said telegraph, called the Columbian telegraph, containing and consisting in part of the said two improvements of the said Morse, described and specified in his said last-mentioned letters patent, was, by the defendants, employed, before and after the last issue of the said last-mentioned letters patent, within the district of Kentucky and elsewhere, in the transmission of intelligence in the mode above mentioned, in violation and infringement of the exclusive right so granted by the United States by these last-mentioned letters patent, and held by the complainants, as by them alleged and by the court adjudged.

It is therefore ordered, and adjudged, and decreed that the defendants, their servants and agents, be, and they are hereby, enjoined and

## Argument for the appellants.

commanded that they, and each of them, do still desist, and shall forever, and during the term of fourteen years from the eleventh day of April, eighteen hundred and forty-six, altogether refrain from all and every use and employment of the above-mentioned telegraphic instruments, denominated the mutator, in the combination with the other above-described instruments of such telegraph, or in any other combination on the same plan and principle, in the transmission of intelligence in the district of Kentucky.

And that they do still desist and, for and during the said term of fourteen years, refrain from all and every such employment in the transmission of intelligence within the district of Kentucky, of the above-mentioned improvement of the complainant Morse, in the register of his telegraph, whereby is accomplished the making of his alphabetical characters before mentioned, described, and specified by indentation, instead of by coloring matter, in violation of the exclusive rights of complainants, by them held under the aforesaid letters patent as above adjudged.

And that the defendants shall, for and during the said term of fourteen years from the said eleventh day of April, eighteen hundred and forty-six, refrain from constructing or vending, to be employed in such transmission of intelligence, within the district of Kentucky, any of the above-mentioned improvements, either the instrument denominated the mutator, the improved register of said Morse, or any other of the improvements in the electro-magnetic telegraph, so described and specified in said letters patent as the invention of the said Samuel F. B. Morse, and whereof the exclusive right is granted him; and that they shall in no other wise, for the term aforesaid, violate or in anywise infringe the aforesaid rights of the complainants within said district of Kentucky.

And it is ordered that the complainants may have the proper writs of execution on what is above decreed.

(The decree then went on to provide for damages, which part is omitted.)

The defendants appealed from this decree.

The cause was argued in this court by *Mr. Gillet* and *Mr. Chase*, for the appellants; and *Messrs. Campbell* and *Harding*, of Philadelphia, and *Mr. Gifford*, of New York, for the appellees.

It is impossible for the reporter to do more than merely state the positions assumed by the respective counsel.

The counsel for the appellants contended—

*First.* Morse's patent of 1840 is void, because it runs fourteen

years from the date of its issue, instead of that length of time from the date of his French patent.

*Second.* In construing a patent and deciding what are the inventions patented thereby, the summing up is conclusive. Nothing is patented but what is expressly claimed in the summing up as the invention.

*Third.* What is described in a patent and not claimed, whether invented by the patentee or not, is dedicated to the public, and cannot be afterwards claimed as a part of his patent, in a reissue or otherwise.

*Fourth.* A patent void in part is void in whole, except when otherwise provided by statute.

*Fifth.* An invention is not complete, so as to be patentable, or to bar the obtaining a patent by another inventor, until it is perfected and adapted to use.

*Sixth.* Where a patent is for a combination of parts, and not for the different parts composing the combination, the use of any of those parts less than the whole is not an infringement.

*Seventh.* Morse's patents of 1846 and 1848 are void, because he was not the first inventor of the things patented, or of substantial and material parts thereof.

*Eighth.* Morse's reissued patents, dated June 13, 1848, are void, because he has not shown that the surrendered patents were inoperative or invalid, for defective specification or otherwise, so as to confer on the Commissioner jurisdiction to make such reissues. The surrendered patents, being set out, disprove any such jurisdiction.

*Ninth.* The patent of 1840, as secondly reissued, is void, because the Commissioner had no authority to accept a second surrender and make a second reissue.

*Tenth.* Morse's patent of 1840, as secondly reissued, is void, because it is broader than the invention originally patented.

*Eleventh.* Morse's patent of 1846 is void:

1. Because material parts of it had been known and in public use before his application.

The first claim covers the inventions for connecting circuits used by Davy, Wheatstone, and Henry in 1837.

2. Because the same was described by Henry in Silliman's Journal, and in the London Mechanics' Magazine, containing an account of Davy's invention; and by Vail, in giving Morse's and others.

3. Because the same invention, or a substantial part thereof, was patented by Wheatstone, Davy, and Morse himself, prior to his application for his patent of 1846.

This first claim in the reissue of the patent of 1846 is the same thing as the fourth claim of the last reissue of the patent of 1846.

The account given by Henry and Morse shows that Henry's, Wheatstone's, and Davy's were the same as Morse's first claim of the reissue of the patent of 1846.

*Twelfth.* Morse's reissue of 1846 is void, because it is broader than the original.

1. He claims the employment of a receiving magnet, or its equivalent, in combination with a short local independent circuit, having a register magnet to obtain power.

There is no such claim in the original. He there claimed the invention of the receiving magnet or registering contrivances, which sustained certain relations as would enable him to obtain power, &c., without mentioning a short local independent circuit. He now claims two short local circuits. The claim is materially enlarged.

2. His third claim is for a combination which includes the pen lever, or "its equivalent," and for anything over which paper may be passed for the purpose of receiving the impression of characters, &c., by indentation on paper and other fabrics, dispensing with coloring matter, &c.

Here is a palpable enlargement of his claim.

3. His historical recital is an unauthorized addition, and not necessary to perfect his specification.

*Thirteenth.* The surrender and reissue on account of a defective specification authorizes amendments only, and not changing the specification into a new one; nor does it authorize new claims.

*Fourteenth.* In the second reissue of the letters of 1840, Morse patents a principle or effect, and not a machine, manufacture, or composition of matter, or an improvement upon either; and it is, therefore, void.

The counsel for the appellees considered the patents separately, viz.:

Patent of 1840. Reissued 1848.

Patent of 1846. Reissued 1848.

Patent of 1840. Reissued 1848.

To this patent, and the claim under it, five defenses are presented.

It is alleged by the appellants—

I. That it is void by reason of an alleged error in date; *i. e.*, not date of French patent.

II. That the things claimed in the fifth, the sixth, and the eighth claims are not patentable.

## Argument for the appellees.

III. That Morse was not the inventor of substantial parts of the improvement as claimed.

IV. That the description in the specification is insufficient.

V. That the appellants do not infringe.

(Each one of these heads was examined separately. The particular attention bestowed by the court to the following head renders the insertion of the view of the counsel proper:)

II. *Are the Fifth, Sixth, and Eighth Claims Patentable?*

I. Of the fifth and sixth. The fifth is a claim to the system of signs composed of dots, spaces, and horizontal lines, (susceptible of being variously combined, representing numerals, words, and sentences,) for telegraphic purposes; being an improved instrumentality in the art of telegraphing by electricity or galvanism.

The sixth is a claim to the art, consisting of the marking the signs composed of dots, spaces, and horizontal lines, (susceptible of being variously combined, representing numerals, words, and sentences,) by closing and breaking a galvanic circuit more or less rapidly for telegraphing; combined with machinery to record them.

An art is patentable by the act of 1836, and so is an improvement on it. *Whittemore v. Cutter*, 1 Gall., 478; *Phillips on Patents*, 102, 110; *The King v. Wheeler*, 2 Barn. & Ald., 349; *Crane v. Price*, Webster's P. C., 409; *Schuylkill Bank v. Kneass*, 4 Wash. C. C. Rep., 9 and 12; *McClurg v. Kingsland*, 1 Howard, 204; *Curtis on Patents*, sec. 37; *French v. Rogers*, opinion Judges Grier and Kane; Pamphlet, Kane, J., *Parker v. Hulme*, p. 7.

The art is distinct from the means employed in its exercise; both may be, and under this patent are, patented.

II. Of the eighth claim. This claim is declaratory, and is to the effect that, having been the first to conceive and carry into effect a plan for imprinting telegraphic characters by the power of electro-magnetism, he negatives the idea that the mere instrumentalities described in his patent constitute the whole of the invention claimed by him, or even the most important part thereof, or that he intended to surrender to the public the conception he had reduced to practical utility, should anybody else be able to devise other means for accomplishing the same end, by the use of the same power, but claims it as his property.

He who discovers a principle and devises one mode by which the same can be rendered practically useful, is entitled to a patent which shall protect him to the full extent of his invention, and against all other devices for using it.

## Argument for the appellees.

If Morse, therefore, was the first to discover that the power of electro-magnetism could be used for the purpose of recording telegraphic signs, and devised one practical mode for using it, he may, by a general claim, secure to himself the right of so applying it, as well as the particular devices by which he did so. London Jour. and Rep. Arts, 1850, p. 130; *Jupe v. Pratt*, Webster's P. C., 145, 146; Forsyth's Patent, Webster's P. C., 96, 97; *Crane v. Price*, Webster's P. C., 409, 410; *Park v. Little*, 3 Wash. C. C. Rep., 197.

See the cases collected in Loud on Patents, Law Lib., September, 1851, p. 37, illustrating the proposition that the rights of the patentee are not restricted to the particular application or embodiment of his invention, but extend to the exclusion of other like applications.

Judge Kane's opinion, Blanchard's case; Fr. Inst. Jour., 1847; and Pamphlet, *Parker v. Hulme*, Judge Kane's opinion.

*Patent of 1846. Reissued 1848.*

The defenses suggested by the appellants to this patent are—

I. That the improvement is not sufficiently described, and that the improvement is not sufficiently discriminated.

II. That it is for the same invention that was patented to Morse in the patent of 1840.

III. That it was in use and on sale with patentee's consent, before his application for a patent.

IV. That Morse was not the inventor.

As to the fourth head, the counsel for the appellees contended that the following list were shown by the evidence to have been invented by Morse:

1. He was the first person who employed an electro-magnet, placed in a long circuit, for telegraphic purposes.

2. He was the first person who devised suitable machinery for recording, and adapted such machinery to an electro-magnet placed in a long galvanic circuit.

3. He was the first person who employed an electro-magnet, placed in a long galvanic circuit, to open and close another long galvanic circuit, for telegraphic purposes.

4. He was the first person who employed an electro-magnet, placed in a long galvanic circuit, to open and close a short local circuit at a distance, for telegraphic purposes.

5. He was the first person who placed, in the course of a long galvanic circuit, at various distances apart, a series of electro-magnets, to open and close, at one and the same time, a corresponding series of short recording circuits, by means of which arrangement an oper-



## Argument for the appellees.

ator at one station could simultaneously record at a series of distant telegraphic stations.

6. He was the first person who adapted, to an electro-magnet placed in a long galvanic circuit, suitable machinery for recording the establishment and duration of a galvanic current through such a long galvanic current.

7. He was the first person who devised a process or mode of establishing and continuing, at determinate intervals of time, a galvanic current through a circuit of conductors, and of recording the establishment of such current in dots and lines.

8. He was the first person who devised a system of signs formed of the combination of dots and lines, and so applicable to the above process of recording as to render it available for representing at a distance letters, words, and sentences.

9. He was the first person who employed electro-magnetism, when developed in the manner and by the means specified, to produce distinguishable signs for telegraphing.

10. He was the first person who adapted, to an electro-magnet, a lever with an adjustable reacting spring, and adjustable stops, for limiting the play of such armature, and thus formed a receiving electro-magnet, susceptible of nice regulation, so as to operate equally with the varying force of the galvanic currents in a long or main circuit.

11. He was the first person who combined such an electro-magnet in a long circuit with a short recording circuit, to be opened and closed by such electro-magnet.

12. He was the first person who devised and constructed an apparatus or machine for telegraphing, consisting of the several following parts, sustaining to each other the several following relations, and performing the several following functions, respectively:

1. A main circuit,	which consists of	a long conductor extending through several stations,	the function of which is	to transmit the galvanic current through its whole length whenever it is closed.
2. A main battery series,	"	a number of cups arranged along the main conductor,	"	to supply the main conductor with a current sufficient to work the electro-magnets in its course.
3. Operating keys,	each of which consists of	a small metallic lever	"	to break and close the main circuit.
4. A series of receiving magnets,	"	an electro-magnet with lever, and reacting spring,	"	to close the office circuit when a current passes through the main circuit.
5. Adjusting screws,	"	movable screws to regulate force of reacting spring and play of lever,	"	to render receiving magnets sensitive to varying force of main current.

## Argument for the appellees.

6. Office circuits,	each of which consists of	a circuit of conductors limited to each office,	the function of which is	to transmit the power to mark the paper.
7. Office battery series,	"	a certain number of grove cups at each station,	"	to generate and supply the office circuit with a current of greater force than the main circuit current.
8. Marking apparatus,	which consists of	a fine pointed piece of iron, pen lever, and grooved roller,	"	to indent dots and lines upon paper.
9. Registers,	"	a series of clock-work moved by a weight regulated by a fly,	"	to move the paper uniformly under the point of the pen.
10. Office magnets,	"	an electro-magnet,	"	1. To develop the power by which the pen marks in the groove of a roller. 2. To produce audible distinguishable sounds.
11. Certain process,	"	in establishing, continuing, and interrupting a galvanic current through the main circuit at determinate intervals,	"	to record dots and lines at one or many distant stations at the will of a distant operator:
12. A system of signs	"	dots and lines to represent the letters of the alphabet and numerals,	"	1. When applied to the record, to render such record intelligible. 2. When applied to the sounds of the office magnet, to render those sounds intelligible.

13. The art of recording dots and lines at a distance for telegraphing.

(The counsel then examined the question of infringement of each patent separately, and concluded with the following:)

*The Appellants infringe the Patents of 1840 and 1846, Jointly Considered.*

It is proper to consider the claims of the patents together, and in connection with the specifications as well as separately, in order to secure the real invention to the patentee.

The joint effect of the several claims of the first patent, apart from the specific things claimed in each, makes it a patent also for Morse's new art, process, and system of telegraphing, by recording the variable duration of the galvanic current in dots and lines.

The second patent is for an improvement in the means by which that art was carried into effect.

The two together constitute the art, process, system, and means of telegraphing as improved, or, in other words, *the telegraph*.

This whole system or telegraph so jointly considered, as used by the appellants, in all its main features, is copied from that of the appellees. That it is so, will appear from the following table, showing the several parts of the apparatus used by each, and their several relations and functions.

The appellants and appellees agree in employing an apparatus for

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telegraphing, consisting of the following parts, sustaining to each other the several following relations, and performing the several following functions, respectively :

1. A main circuit,	which consists of	a long conductor extending through several stations,	the function of which is	to transmit the galvanic current through its whole length whenever it is closed.
2. A main battery series,	"	a number of cups arranged along the main conductor,	"	to supply the main conductor with a current sufficient to work the electro-magnets in its course.
3. Operating keys,	each of which consists of	a small metallic lever	"	to break and close the main circuit.
4. A series of receiving magnets,	"	an electro-magnet with lever, and reacting spring,	"	to close the office circuit when a current passes through the main circuit.
5. Adjusting screws,	"	movable screws to regulate force of reacting spring and play of lever,	"	to render receiving magnets sensitive to varying force of main currents.
6. Office circuits,	"	a circuit of conductors limited to each office,	"	to transmit the power to mark the paper.
7. Office battery series,	"	a certain number of grove cups at each station,	"	to generate and supply the office circuit with a current of greater force than the main circuit current.
8. A pen point, pen lever, and grooved lever,	which consists of	a fine pointed piece of iron, lever, and grooved roller,	"	to indent dots and lines upon paper.
9. Registers,	"	a series of clock-work moved by a weight regulated by a fly,	"	to move the paper uniformly under the point of the pen.
10. Office magnets,	"	an electro-magnet,	"	1. To develop the power by which the pen marks in the groove of a roller. 2. To produce audible distinguishable sounds.
11. Certain process,	which consists	in establishing, continuing, and interrupting a galvanic current through main circuit at determinate intervals,	"	to record dots and lines at one or many distant stations at the will of a distant operator.
12. A system of signs	"	dots and lines to represent the letters of the alphabet and numerals,	"	1. When applied to the record, to render such record intelligible. 2. When applied to the sounds of the office magnet, to render those sounds intelligible.

Mr. Chief Justice TANEY delivered the opinion of the court.

In proceeding to pronounce judgment in this case, the court is sensible, not only of its importance, but of the difficulties in some of the questions which it presents for decision. The case was argued at the last term, and continued over by the court, for the purpose of giving it a more deliberate examination. And since the continuance, we have received from the counsel on both sides printed arguments, in

which all of the questions raised on the trial have been fully and elaborately discussed.

The appellants take three grounds of defense. In the first place, they deny that Professor Morse was the first and original inventor of the electro-magnetic telegraphs described in his two reissued patents of 1848. Secondly, they insist, that if he was the original inventor, the patents under which he claims have not been issued conformably to the acts of Congress, and do not confer on him the right to the exclusive use. And thirdly, if these two propositions are decided against them, they insist that the telegraph of O'Reilly is substantially different from that of Professor Morse, and the use of it, therefore, no infringement of his rights.

In determining these questions, we shall, in the first instance, confine our attention to the patent which Professor Morse obtained in 1840, and which was reissued in 1848. The main dispute between the parties is upon the validity of this patent; and the decision upon it will dispose of the chief points in controversy in the other.

In relation to the first point, (the originality of the invention,) many witnesses have been examined on both sides.

It is obvious that, for some years before Professor Morse made his invention, scientific men in different parts of Europe were earnestly engaged in the same pursuit. Electro-magnetism itself was a recent discovery, and opened to them a new and unexplored field for their labors, and minds of a high order were engaged in developing its power and the purposes to which it might be applied.

Professor Henry, of the Smithsonian Institute, states, in his testimony, that prior to the winter of 1819-'20, an electro-magnetic telegraph—that is to say, a telegraph operating by the combined influence of electricity and magnetism—was not possible; that the scientific principles on which it is founded were until then unknown, and that the first fact of electro-magnetism was discovered by Oersted, of Copenhagen, in that winter, and was widely published, and the account everywhere received with interest.

He also gives an account of the various discoveries, subsequently made from time to time, by different persons in different places, developing its properties and powers, and among them his own. He commenced his researches in 1828, and pursued them with ardor and success, from that time until the telegraph of Professor Morse was established and in actual operation. And it is due to him to say, that no one has contributed more to enlarge the knowledge of electro-magnetism, and to lay the foundations of the great invention of which we are speaking, than the Professor himself.

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It is unnecessary, however, to give in detail the discoveries enumerated by him, either his own or those of others. But it appears from his testimony that, very soon after the discovery made by Oersted, it was believed by men of science that this newly-discovered power might be used to communicate intelligence to distant places. And before the year 1823, Ampere, of Paris, one of the most successful cultivators of physical science, proposed to the French Academy a plan for that purpose. But his project was never reduced to practice. And the discovery made by Barlow, of the Royal Military Academy of Woolwich, England, in 1825, that the galvanic current greatly diminished in power as the distance increased, put at rest, for a time, all attempts to construct an electro-magnetic telegraph. Subsequent discoveries, however, revived the hope; and in the year 1832, when Professor Morse appears to have devoted himself to the subject, the conviction was general, among men of science everywhere, that the object could, and sooner or later would, be accomplished.

The great difficulty in their way was the fact that the galvanic current, however strong in the beginning, became gradually weaker as it advanced on the wire, and was not strong enough to produce a mechanical effect after a certain distance had been traversed. But, encouraged by the discoveries which were made from time to time, and strong in the belief that an electro-magnetic telegraph was practicable, many eminent and scientific men, in Europe as well as in this country, became deeply engaged in endeavoring to surmount what appeared to be the chief obstacle to its success. And in this state of things it ought not to be a matter of surprise that four different magnetic telegraphs, purporting to have overcome the difficulty, should be invented and made public so nearly at the same time that each has claimed a priority, and that a close and careful scrutiny of the facts in each case is necessary to decide between them. The inventions were so nearly simultaneous that neither inventor can be justly accused of having derived any aid from the discoveries of the other.

One of these inventors, Doctor Steinheil, of Munich, in Germany, communicated his discovery to the Academy of Science, in Paris, on the 19th of July, 1838, and states in his communication that it had been in operation more than a year.

Another of the European inventors, Professor Wheatstone, of London, in the month of April, 1837, explained to Professors Henry and Bache, who were then in London, his plan of an electro-magnetic telegraph, and exhibited to them his method of bringing into action a second galvanic circuit, in order to provide a remedy for the diminution of force in a long circuit; but it appears, by the testi-

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mony of Professor Gale, that the patent to Wheatstone and Cooke was not sealed until January 21, 1840, and their specification was not filed until the 21st of July, in the same year; and there is no evidence that any description of it was published before 1839.

The remaining European patent is that of Edward Davy. His patent, it appears, was sealed on the 4th of July, 1838, but his specification was not filed until January 4, 1839; and when these two English patents are brought into competition with that of Morse, they must take date from the time of filing their respective specifications. For it must be borne in mind that, as the law then stood in England, the inventor was allowed six months to file the description of his invention after his patent was sealed; while, in this country, the filing of the specification is simultaneous with the application for patents.

The defendants contend that all, or at least some, of these European telegraphs were invented and made public before the discovery claimed by Morse; and that the process and method by which he conveys intelligence to a distance is substantially the same, with the exception only of its capacity for impressing upon paper the marks or signs described in the alphabet he invented.

Waiving for the present any remarks upon the identity or similitude of these inventions, the court is of opinion that the first branch of the objection cannot be maintained, and that Morse was the first and original inventor of the telegraph described in his specification, and preceded the three European inventions relied on by the defendants.

The evidence is full and clear that, when he was returning from a visit to Europe, in 1832, he was deeply engaged upon this subject during the voyage; and that the process and means were so far developed and arranged in his own mind, that he was confident of ultimate success. It is in proof that he pursued these investigations with unremitting ardor and industry, interrupted occasionally by pecuniary embarrassments; and we think that it is established, by the testimony of Professor Gale and others, that, early in the spring of 1837, Morse had invented his plan for combining two or more electric or galvanic circuits, with independent batteries for the purpose of overcoming the diminished force of electro-magnetism in long circuits, although it was not disclosed to the witness until afterwards; and that there is reasonable ground for believing that he had so far completed his invention that the whole process, combination, powers, and machinery were arranged in his mind, and that the delay in bringing it out arose from his want of means; for it required the highest order of mechan-

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ical skill to execute and adjust the nice and delicate work necessary to put the telegraph into operation, and the slightest error or defect would have been fatal to its success. He had not the means at that time to procure the services of workmen of that character; and without their aid no model could be prepared which would do justice to his invention. And it, moreover, required a large sum of money to procure proper materials for the work. He, however, filed his caveat on the 6th of October, 1837, and on the 7th of April, 1838, applied for his patent, accompanying his application with a specification of his invention, and describing the process and means used to produce the effect. It is true, that O'Reilly, in his answer, alleges that the plan by which he now combines two or more galvanic or electric currents, with independent batteries, was not contained in that specification, but discovered and interpolated afterwards; but there is no evidence whatever to support this charge. And we are satisfied, from the testimony, that the plan, as it now appears in his specification, had then been invented, and was actually intended to be described.

With this evidence before us, we think it is evident that the invention of Morse was prior to that of Steinheil, Wheatstone, or Davy. The discovery of Steinheil, taking the time which he himself gave to the French Academy of Science, cannot be understood as carrying it back beyond the months of May or June, 1837. And that of Wheatstone, as exhibited to Professors Henry and Bache, goes back only to April in that year. And there is nothing in the evidence to carry back the invention of Davy beyond the 4th of January, 1839, when his specification was filed, except a publication said to have been made in the *London Mechanics' Magazine*, January 20, 1838; and the invention of Morse is justly entitled to take date from early in the spring of 1837. And in the description of Davy's invention, as given in the publication of January 20, 1838, there is nothing specified which Morse could have borrowed; and we have no evidence to show that his invention ever was or could be carried into successful operation.

In relation to Wheatstone, there would seem to be some discrepancy in the testimony. According to Professor Gale's testimony, as before mentioned, the specification of Wheatstone and Cooke was not filed until July 21, 1840, and his information is derived from the *London Journal of Arts and Sciences*. But it appears, by the testimony of Edward F. Barnes, that this telegraph was in actual operation in 1839. And in the case of the *Electric Telegraph Company v. Brett & Little*, 10 Common Pleas Reports, by Scott, his specification is said

to have been filed December 12, 1837. But if the last-mentioned date is taken as the true one, it would not make his invention prior to that of Morse. And even if it would, yet this case must be decided by the testimony in the record, and we cannot go out of it and take into consideration a fact stated in a book of reports. Moreover, we have noticed this case merely because it has been pressed into the argument. The appellants do not mention it in their answer, nor put their defense on it. And if the evidence of its priority was conclusive, it would not avail them in this suit; for they cannot be allowed to surprise the patentee by evidence of a prior invention of which they gave him no notice.

But if the priority of Morse's invention was more doubtful, and it was conceded that in fact some one of the European inventors had preceded him a few months or a few weeks, it would not invalidate his patent. The act of Congress provides that when the patentee believes himself to be the first inventor, a previous discovery in a foreign country shall not render his patent void, unless such discovery, or some substantial part of it, had been before patented or described in a printed publication.

Now, we suppose no one will doubt that Morse believed himself to be the original inventor, when he applied for his patent, in April, 1838. Steinheil's discovery does not appear to have been ever patented, nor to have been described in any printed publication until July of that year. And neither of the English inventions is shown by the testimony to have been patented until after Morse's application for a patent, nor to have been so described in any previous publication as to embrace any substantial part of his invention. And if his application for a patent was made under such circumstances, the patent is good, even if, in point of fact, he was not the first inventor.

In this view of the subject, it is unnecessary to compare the telegraph of Morse with these European inventions, to ascertain whether they are substantially the same or not. If they were the same in every particular, it would not impair his rights. But it is impossible to examine them, and look at the process and the machinery and results of each, so far as the facts are before us, without perceiving at once the substantial and essential difference between them and the decided superiority of the one invented by Professor Morse.

Neither can the inquiries he made nor the information or advice he received from men of science in the course of his researches impair his right to the character of an inventor. No invention can possibly be made, consisting of a combination of different elements of power, without a thorough knowledge of the properties of each of them, and



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the mode in which they operate on each other. And it can make no difference, in this respect, whether he derives his information from books or from conversation with men skilled in the science. If it were otherwise, no patent in which a combination of different elements is used could ever be obtained; for no man ever made such an invention, without having first obtained this information, unless it was discovered by some fortunate accident. And it is evident that such an invention as the electro-magnetic telegraph could never have been brought into action without it; for a very high degree of scientific knowledge and the nicest skill in the mechanic arts are combined in it, and were both necessary to bring it into successful operation. And the fact that Morse sought and obtained the necessary information and counsel from the best sources, and acted upon it, neither impairs his rights as an inventor nor detracts from his merits.

Regarding Professor Morse as the first and original inventor of the telegraph, we come to the objections which have been made to the validity of his patent.

We do not think it necessary to dwell upon the objections taken to the proceedings upon which the first patent was issued, or to the additional specifications of the reissued patent of 1848. In relation to the first, if there was any alteration at the suggestion of the Commissioner, it appears to have been a matter of form, rather than of substance; and, as regards the second, there is nothing in the proof or on the face of the reissued patent to show that the invention therein described is not the same with the one intended to be secured by the original patent. It was reissued by the proper lawful authority, and it was the duty of the Commissioner of Patents to see that it did not cover more than the original invention. It must be presumed, therefore, that it does not, until the contrary appears. Variations from the description given in the former specification do not necessarily imply that it is for a different discovery. The right to surrender the old patent, and receive another in its place, was given for the purpose of enabling the patentee to give a more perfect description of his invention, when any mistake or oversight was committed in his first. It necessarily, therefore, varies from it; and we see nothing in the reissued patent that may not, without proof to the contrary, be regarded as a more careful description than the former one, explaining more fully the nice and delicate manner in which the different elements of power are arranged and combined together, and act upon one another, in order to produce the effect described in the specification. Nor is it void because it does not bear the same date with his

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French patent. It is not necessary to inquire whether the application of Professor Morse to the Patent Office, in 1838, before he went to France, does or does not exempt his patent from the operation of the act of Congress upon the subject; for, if it should be decided that it does not exempt it, the only effect of that decision would be to limit the monopoly to fourteen years from the date of the foreign patent. And in either case the patent was in full force at the time the injunction was granted by the Circuit Court, and when the present appeal stood regularly for hearing in this court.

And this brings us to the exceptions taken to the specification and claims of the patentee in the reissued patent of 1848.

We perceive no well-founded objection to the description which is given of the whole invention and its separate parts, nor to his right to a patent for the first seven inventions set forth in the specification of his claims. The difficulty arises on the eighth.

It is in the following words:

“Eighth. I do not propose to limit myself to the specific machinery, or parts of machinery, described in the foregoing specification and claims; the essence of my invention being the use of the motive-power of the electric or galvanic current, which I call electro-magnetism, however developed, for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer.”

It is impossible to misunderstand the extent of this claim. He claims the exclusive right to every improvement where the motive-power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters, at a distance.

If this claim can be maintained, it matters not by what process or machinery the result is accomplished. For aught that we know, some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification. His invention may be less complicated—less liable to get out of order—less expensive in construction, and in its operation. But yet, if it is covered by this patent, the inventor could not use it, nor the public have the benefit of it, without the permission of this patentee.

Nor is this all; while he shuts the door against inventions of other persons, the patentee would be able to avail himself of new discoveries in the properties and powers of electro-magnetism which scientific men might bring to light. For he says he does not confine his claim to the machinery, or parts of machinery, which he specifies; but

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claims for himself a monopoly in its use, however developed, for the purpose of printing at a distance. New discoveries in physical science may enable him to combine it with new agents and new elements, and by that means attain the object in a manner superior to the present process, and altogether different from it. And if he can secure the exclusive use by his present patent, he may vary it with every new discovery and development of the science, and need place no description of the new manner, process, or machinery upon the records of the Patent Office. And when his patent expires, the public must apply to him to learn what it is. In fine, he claims an exclusive right to use a manner and process which he has not described, and indeed had not invented, and therefore could not describe when he obtained his patent. The court is of opinion that the claim is too broad, and not warranted by law.

No one, we suppose, will maintain that Fulton could have taken out a patent for his invention of propelling vessels by steam, describing the process and machinery he used, and claimed under it the exclusive right to use the motive-power of steam, however developed, for the purpose of propelling vessels. It can hardly be supposed that under such a patent he could have prevented the use of the improved machinery which science has since introduced, although the motive-power is steam and the result is the propulsion of vessels. Neither could the man who first discovered that steam might, by a proper arrangement of machinery, be used as a motive-power to grind corn or spin cotton, claim the right to the exclusive use of steam as a motive-power for the purpose of producing such effects.

Again, the use of steam as a motive-power in printing-presses is comparatively a modern discovery. Was the first inventor of a machine or process of this kind entitled to a patent, giving him the exclusive right to use steam as a motive-power, however developed, for the purpose of marking or printing intelligible characters? Could he have prevented the use of any other press, subsequently invented, where steam was used? Yet, so far as patentable rights are concerned, both improvements must stand on the same principles. Both use a known motive-power to print intelligible marks or letters; and it can make no difference, in their legal rights under the Patent Laws, whether the printing is done near at hand or at a distance. Both depend for success not merely upon the motive-power, but upon the machinery with which it is combined. And it has never, we believe, been supposed by any one that the first inventor of a steam printing-press was entitled to the exclusive use of steam as a

motive-power, however developed, for marking or printing intelligible characters.

Indeed, the acts of the patentee himself are inconsistent with the claim made in his behalf; for in 1846 he took out a patent for his new improvement of local circuits, by means of which intelligence could be printed at intermediate places along the main line of the telegraph; and he obtained a reissued patent for this invention in 1848. Yet in this new invention the electric or galvanic current was the motive-power, and writing at a distance the effect. The power was undoubtedly developed by new machinery and new combinations. But if his eighth claim could be sustained, this improvement would be embraced by his first patent. And if it was so embraced, his patent for the local circuits would be illegal and void; for he could not take out a subsequent patent for a portion of his first invention, and thereby extend his monopoly beyond the period limited by law.

Many cases have been referred to in the argument which have been decided, upon this subject, in the English and American courts. We shall speak of those only which seem to be considered as leading ones. And those most relied on and pressed upon the court in behalf of the patentee are the cases which arose in England upon Neilson's patent for the introduction of heated air between the blowing apparatus and the furnace, in the manufacture of iron.

The leading case upon this patent is that of *Neilson et al. v. Harford et al.*, in the English Court of Exchequer. It was elaborately argued, and appears to have been carefully considered by the court. The case was this:

Neilson, in his specification, described his invention as one for the improved application of air to produce heat in fires, forges, and furnaces, where a blowing apparatus is required; and it was to be applied as follows: The blast, or current of air produced by the blowing apparatus, was to be passed from it into an air vessel, or receptacle made sufficiently strong to endure the blast; and through or from that vessel or receptacle, by means of a tube, pipe, or aperture into the fire, the receptacle be kept artificially heated to a considerable temperature, by heat externally applied. He then described, in rather general terms, the manner in which the receptacle might be constructed and heated, and the air conducted through it to the fire, stating that the form of the receptacle was not material, nor the manner of applying heat to it. In the action above mentioned for the infringement of this patent, the defendant, among other defenses, insisted that the machinery for heating the air, and throwing it hot into the

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furnace, was not sufficiently described in the specification, and the patent void on that account; and, also, that a patent for throwing hot air into the furnace, instead of cold, and thereby increasing the intensity of the heat, was a patent for a principle, and that a principle was not patentable.

Upon the first of these defenses, the jury found that a man of ordinary skill and knowledge of the subject, looking at the specification alone, could construct such an apparatus as would be productive of a beneficial result, sufficient to make it worth while to adapt it to the machinery in all cases of forges, cupalos, and furnaces, where the blast is used.

And upon the second ground of defense, Baron Parke, who delivered the opinion of the court, said:

"It is very difficult to distinguish it from the specification of a patent for a principle, and this, at first, created in the minds of the court much difficulty; but, after full consideration, we think that the plaintiff does not merely claim a principle, but a machine embodying a principle, and a very valuable one. We think the case must be considered as if the principle being well known, the plaintiff had first invented a mode of applying it by a mechanical apparatus to furnaces; and his invention then consists in this: by interposing a receptacle for heated air between the blowing apparatus and the furnace. In this receptacle he directs the air to be heated by the application of heat externally to the receptacle; and thus he accomplishes the object of applying the blast, which was before cold air, in a heated state to the furnace."

We see nothing in this opinion differing in any degree from the familiar principles of law applicable to patent cases. Neilson claimed no particular mode of constructing the receptacle or of heating it. He pointed out the manner in which it might be done; but admitted that it might also be done in a variety of ways, and at a higher or lower temperature, and that all of them would produce the effect in a greater or less degree, provided the air was heated by passing through a heated receptacle. And hence, it seems that the court at first doubted whether it was a patent for anything more than the discovery that hot air would promote the ignition of fuel better than cold. And if this had been the construction, the court, it appears, would have held his patent to be void, because the discovery of a principle in natural philosophy or physical science is not patentable.

But, after much consideration, it was finally decided that this principle must be regarded as well known, and that the plaintiff had invented a mechanical mode of applying it to furnaces; and that his

invention consisted in interposing a heated receptacle between the blower and the furnace, and by this means heating the air after it left the blower, and before it was thrown into the fire. Whoever, therefore, used this method of throwing hot air into the furnace, used the process he had invented, and thereby infringed his patent, although the form of the receptacle, or the mechanical arrangements for heating it, might be different from those described by the patentee; for whatever form was adopted for the receptacle, or whatever mechanical arrangements were made for heating it, the effect would be produced in a greater or less degree if the heated receptacle was placed between the blower and the furnace, and the current of air passed through it.

Undoubtedly, the principle that hot air will promote the ignition of fuel better than cold, was embodied in this machine; but the patent was not supported because this principle was embodied in it. He would have been equally entitled to a patent if he had invented an improvement in the mechanical arrangements of the blowing apparatus, or in the furnace, while a cold current of air was still used. But his patent was supported because he had invented a mechanical apparatus, by which a current of hot air, instead of cold, could be thrown in. And this new method was protected by his patent. The interposition of a heated receptacle, in any form, was the novelty he invented.

We do not perceive how the claim, in the case before us, can derive any countenance from this decision. If the Court of Exchequer had said that Neilson's patent was for the discovery that hot air would promote ignition better than cold, and that he had an exclusive right to use it for that purpose, there might, perhaps, have been some reason to rely upon it. But the court emphatically denied his right to such a patent; and his claim, as the patent was construed and supported by the court, is altogether unlike that of the patentee before us.

For Neilson discovered that by interposing a heated receptacle between the blower and the furnace, and conducting the current of air through it, the heat in the furnace was increased. And this effect was always produced, whatever might be the form of the receptacle, or the mechanical contrivances for heating it, or for passing the current of air through it, and into the furnace.

But Professor Morse has not discovered that the electric or galvanic current will always print at a distance, no matter what may be the form of the machinery or mechanical contrivances through which it passes. You may use electro-magnetism as a motive-power, and

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yet not produce the described effect, that is, print at a distance intelligible marks or signs. To produce that effect, it must be combined with, and passed through, and operate upon certain complicated and delicate machinery, adjusted and arranged upon philosophical principles, and prepared by the highest mechanical skill. And it is the high praise of Professor Morse that he has been able, by a new combination of known powers, of which electro-magnetism is one, to discover a method by which intelligible marks or signs may be printed at a distance. And for the method or process thus discovered he is entitled to a patent. But he has not discovered that the electro-magnetic current, used as motive-power, in any other method, and with any other combination, will do as well.

We have commented on the case in the Court of Exchequer more fully, because it has attracted much attention in the courts of this country, as well as in the English courts, and has been differently understood. And perhaps a mistake in construction of that decision has let to the broad claim in the patent now under consideration.

We do not deem it necessary to remark upon the other decisions, in relation to Neilson's patent, nor upon the other cases referred to, which stand upon similar principles. The observations we have made on the case in the Court of Exchequer will equally apply to all of them.

We proceed to the American decisions; and the principles herein stated were fully recognized by this court in the case of *Le Roy et al. v. Tatham et al.*, 14 Howard, 156, decided at the last term.

It appeared that, in that case, the patentee had discovered that lead recently set would, under heat and pressure, in a close vessel, reunite perfectly after a separation of its parts, so as to make wrought instead of cast pipe. And the court held that he was not entitled to a patent for this newly-discovered principle or quality in lead, and that such a discovery was not patentable; but that he was entitled to a patent for the new process or method in the art of making lead pipe which this discovery enabled him to invent and employ, and was bound to describe such process or method fully in his specification.

Many cases have also been referred to, which were decided in the Circuit Courts. It will be found, we think, upon careful examination, that all of them, previous to the decision on Neilson's patent, maintain the principles on which this decision is made. Since that case was reported, it is admitted that decisions have been made which would seem to extend patentable rights beyond the limits here marked out. As we have already said, we see nothing in that opinion which would sanction the introduction of any new principle

in the law of patents. But if it were otherwise, it would not justify this court in departing from what we consider as established principles in the American courts. And to show what was heretofore the doctrine upon this subject, we refer to the annexed cases. We do not stop to comment on them, because such an examination would extend this opinion beyond all reasonable bounds. *Wyeth v. Stone*, 1 Story, 270, 285; *Blanchard v. Sprague*, 3 Sumn., 540. The first-mentioned case is directly in point.

Indeed, independently of judicial authority, we do not think that the language used in the act of Congress can justly be expounded otherwise.

The fifth section of the act of 1836 declares that a patent shall convey to the inventor, for a term not exceeding fourteen years, the exclusive right of making, using, and vending to others to be used his invention or discovery; referring to the specification for the particulars thereof.

The sixth section directs who shall be entitled to a patent, and the terms and conditions on which it may be obtained. It provides that any person shall be entitled to a patent who has discovered or invented a new and useful art, machine, manufacture, or composition of matter; or a new and useful improvement on any previous discovery in either of them. But before he receives the patent, he shall deliver a written description of his invention or discovery, "and of the manner and process of making, constructing, using, and compounding the same," in such exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same.

This court has decided that the specification required by this law is a part of the patent, and that the patent issues for the invention described in the specification.

Now, whether the telegraph is regarded as an art or machine, the manner and process of making or using it must be set forth in exact terms. The act of Congress makes no difference, in this respect, between an art and a machine. An improvement in the art of making bar-iron or spinning cotton must be so described; and so must the art of printing by the motive-power of steam. And in all of these cases, it has always been held that the patent embraces nothing more than the improvement described and claimed as new, and that any one who afterwards discovered a method of accomplishing the same object, substantially and essentially differing from the one described, had a right to use it. Can there be any good reason why the art of



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printing at a distance, by means of the motive-power of the electric or galvanic current, should stand on different principles? Is there any reason why the inventor's patent should cover broader ground? It would be difficult to discover anything in the act of Congress which would justify this distinction. The specification of this patentee describes his invention or discovery, and the manner and process of constructing and using it; and his patent, like inventions in the other arts above mentioned, covers nothing more.

The provisions of the acts of Congress, in relation to patents, may be summed up in a few words.

Whoever discovers that a certain useful result will be produced in any art, machine, manufacture, or composition of matter, by the use of certain means, is entitled to a patent for it; provided he specifies the means he uses in a manner so full and exact that any one skilled in the science to which it appertains can, by using the means he specifies, without any addition to or subtraction from them, produce precisely the result he describes. And if this cannot be done by the means he describes, the patent is void. And if it can be done, then the patent confers on him the exclusive right to use the means he specifies to produce the result or effect he describes, and nothing more. And it makes no difference, in this respect, whether the effect is produced by chemical agency or combination; or by the application of discoveries or principles in natural philosophy, known or unknown before his invention; or by machinery acting altogether upon mechanical principles. In either case, he must describe the manner and process as above mentioned, and the end it accomplishes. And any one may lawfully accomplish the same end, without infringing the patent, if he uses means substantially different from those described.

Indeed, if the eighth claim of the patentee can be maintained, there was no necessity for any specification, further than to say that he had discovered that by using the motive-power of electro-magnetism he could print intelligible characters at any distance. We presume it will be admitted on all hands that no patent could have issued on such a specification. Yet this claim can derive no aid from the specification filed. It is outside of it, and the patentee claims beyond it; and if it stands, it must stand simply on the ground that the broad terms above mentioned were a sufficient description, and entitled him to a patent in terms equally broad. In our judgment, the act of Congress cannot be so construed.

The patent, then, being illegal and void, so far as respects the eighth claim, the question arises whether the whole patent is void, unless

this portion of it is disclaimed in a reasonable time after the patent issued.

It has been urged, on the part of the complainants, that there is no necessity for a disclaimer in a case of this kind; that it is required in those cases only in which the party commits an error in fact in claiming something which was known before, and of which he was not the first discover; that in this case he was the first to discover that the motive-power of electro-magnetism might be used to write at a distance; and that his error, if any, was a mistake in law in supposing his invention, as described in his specification, authorized this broad claim of exclusive privilege; and that the claim, therefore, may be regarded as a nullity, and allowed to stand in the patent without a disclaimer, and without affecting the validity of the patent.

This distinction can hardly be maintained. The act of Congress above recited requires that the invention shall be so described that a person skilled in the science to which it appertains, or with which it is most nearly connected, shall be able to construct the improvement from the description given by the inventor.

Now, in this case, there is no description but one, of a process by which signs or letters may be printed at a distance. And yet he claims the exclusive right to any other mode and any other process, although not described by him, by which the end can be accomplished, if electro-magnetism is used as the motive-power. That is to say, he claims a patent for an effect produced by the use of electro-magnetism distinct from the process or machinery necessary to produce it. The words of the acts of Congress above quoted show that no patent can lawfully issue upon such a claim; for he claims what he has not described in the manner required by law; and a patent for such a claim is as strongly forbidden by the act of Congress as if some other person had invented it before him.

Why, therefore, should he be required and permitted to disclaim in the one case and not in the other? The evil is the same if he claims more than he has invented, although no other person has invented it before him. He prevents others from attempting to improve upon the manner and process which he has described in his specification, and may deter the public from using it, even if discovered. He can lawfully claim only what he has invented and described; and if he claims more, his patent is void; and the judgment in this case must be against the patentee, unless he is within the act of Congress which gives the right to this claim.

The law which requires and permits him to disclaim is not penal, but remedial. It is intended for the protection of the patentee as

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well as the public, and ought not, therefore, to receive a construction that would restrict its operation within narrower limits than its words fairly import. It provides, "that when any patentee shall have, in his specification, claimed to be the first and original inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and shall have no legal or just claim to the same," he must disclaim, in order to protect so much of the claim as is legally patented.

Whether, therefore, the patent is illegal in part because he claims more than he has sufficiently described, or more than he invented, he must, in either case, disclaim, in order to save the portion to which he is entitled; and he is allowed to do so when the error was committed by mistake.

A different construction would be unjust to the public as well as to the patentee, and defeat the manifest object of the law, and produce the very evil against which it intended to guard.

It appears that no disclaimer has yet been entered at the Patent Office. But the delay in entering it is not unreasonable; for the objectionable claim was sanctioned by the head of the office. It has been held to be valid by a Circuit Court, and differences of opinion in relation to it are found to exist among the justices of this court. Under such circumstances, the patentee had a right to insist upon it, and not disclaim it until the highest court to which it could be carried had pronounced its judgment. The omission to disclaim, therefore, does not render the patent altogether void; and he is entitled to proceed in this suit for an infringement of that part of his invention which is legally claimed and described. But as no disclaimer was entered in the Patent Office before this suit was instituted, he cannot, under the act of Congress, be allowed costs against the wrong-doer, although the infringement should be proved. And we think it is proved by the testimony. But as the question of infringement embraces both of the reissued patents, it is proper, before we proceed to that part of the case, to notice the objections made to the second patent for the local circuits, which was originally obtained in 1846, and reissued in 1848.

It is certainly no objection to this patent that the improvement is embraced by the eighth claim in the former one. We have already said that this claim is void, and that the former patent covers nothing but the first seven inventions specifically mentioned.

Nor can its validity be impeached upon the ground that it is an improvement upon a former invention, for which the patentee had himself already obtained a patent. It is true, that under the act of

1836, section 13, it was in the power of Professor Morse, if he desired it, to annex this improvement to his former specification, so as to make it from that time a part of the original patent. But there is nothing in the act that forbids him to take out a new patent for the improvement, if he prefers it. Any other inventor might do so; and there can be no reason, in justice or in policy, for refusing the like privilege to the original inventor. And when there is no positive law to the contrary, he must stand on the same footing with any other inventor of an improvement upon a previous discovery. Nor is he bound in his new patent to refer specially to his former one. All that the law requires of him, is that he shall not claim as new what is covered by a former invention, whether made by himself or any other person.

It is said, however, that this alleged improvement is not new, and is embraced in his former specification; and that if some portion of it is new, it is not so described as to distinguish the new from the old.

It is difficult, perhaps impossible, to discuss this part of the case, so as to be understood by any one who has not a model before him, or perfectly familiar with the machinery and operations of the telegraph. We shall not, therefore, attempt to describe minutely the machinery or its mode of operation. So far as this can be done intelligibly, without the aid of a model to point to, it has been fully and well done in the opinion delivered by the learned judge who decided this case in the Circuit Court. All that we think is useful or necessary to say, is that, after a careful examination of the patents, we think the objection on this ground is not tenable. The force of the objection is mainly directed upon the receiving magnet, which it is said is a part of the machinery of the first patent, and performs the same office. But the receiving magnet is not of itself claimed as a new invention: it is claimed as a part of a new combination or arrangement to produce a new result. And this combination does produce a new and useful result; for by this new combination, and the arrangement and position of the receiving magnet, the local and independent circuit is opened by the electric or galvanic current, as it passes on the main line, without interrupting it in its course; and the intelligence it conveys is recorded almost at the same moment at the end of the line of the telegraph, and at the different local offices on its way. And it hardly needs a model or a minute examination of the machinery to be satisfied that a telegraph which prints the intelligence it conveys at different places, by means of the current, as it passes along on the main line, must necessarily require a different combination and arrangement of powers from the one that prints only at the end. The elements which compose it may all have been used in the former in-

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vention; but it is evident that their arrangement and combination must be different to produce this new effect. The new patent for the local circuits was therefore properly granted; and we perceive no well-founded objection to the specification or claim contained in the reissued patent of 1848.

The two reissued patents of 1848, being both valid, with the exception of the eighth claim in the first, the only remaining question is whether they or either of them have been infringed by the defendants.

The same difficulty arises in this part of the case which we have already stated, in speaking of the specification and claims in the patent for the local circuits. It is difficult to convey a clear idea of the similitude or differences in the two telegraphs to any one not familiarly acquainted with the machinery of both. The court must content itself, therefore, with general terms, referring to the patents themselves for a more special description of the matters in controversy.

It is a well-settled principle of law, that the mere change in the form of the machinery, (unless a particular form is specified as the means by which the effect described is produced,) or an alteration in some of its unessential parts, or in the use of known equivalent powers, not varying essentially the machine, or its mode of operation or organization, will not make the new machine a new invention. It may be an improvement upon the former; but that will not justify its use, without the consent of the first patentee.

The Columbian (O'Reilly's) telegraph does not profess to accomplish a new purpose, or produce a new result. Its object and effect is to communicate intelligence at a distance, at the end of the main line, and at the local circuits on its way; and this is done by means of signs or letters impressed on paper, or other material. The object and purpose of the telegraph is the same with that of Professor Morse.

Does he use the same means? Substantially, we think he does, both upon the main line and in the local circuits. He uses upon the main line the combination of two or more galvanic or electric circuits, with independent batteries, for the purpose of obviating the diminished force of the galvanic current, and in a manner varying very little in form from the invention of Professor Morse. And, indeed, the same may be said of the entire combination set forth in the patentee's third claim; for O'Reilly's can hardly be said to differ substantially and essentially from it. He uses the combination which composes the register, with no material change in the arrangement, or in the elements of which it consists; and with the aid of

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these means he conveys intelligence, by impressing marks or signs upon paper, these marks or signs being capable of being read and understood by means of an alphabet, or signs, adapted to the purpose. And as regards the second patent of Professor Morse for the local circuits, the mutator of the defendant does not vary from it in any essential particular. All of the efficient elements of the combination are retained, or their places supplied by well-known equivalents. Its organization is essentially the same.

Neither is the substitution of marks and signs differing from those invented by Professor Morse any defense to this action. His patent is not for the invention of a new alphabet, but for a combination of powers, composed of tangible and intangible elements, described in his specification, by means of which marks or signs may be impressed upon paper, at a distance, which can there be read and understood. And if any marks, or signs, or letters are impressed in that manner by means of a process substantially the same with his invention, or with any particular part of it covered by his patent, and those marks or signs can be read, and thus communicate intelligence, it is an infringement of his patent. The variation in the character of the marks would not protect it, if the marks could be read and understood.

We deem it unnecessary to pursue further the comparison between the machinery of the patents. The invasion of the plaintiff's rights, already stated, authorized the injunction granted by the Circuit Court, and so much of its decree must be affirmed. But, for the reasons hereinbefore assigned, the complainants are not entitled to costs, and that portion of the decree must be reversed, and a decree passed by this court directing each party to pay his own costs in this and in the Circuit Court.

Mr. Justice WAYNE, Mr. Justice NELSON, and Mr. Justice GRIER dissent from the judgment of the court on the question of costs.

Mr. Justice GRIER.

I entirely concur with the majority of the court, that the appellee and complainant below, Samuel F. B. Morse, is the true and first inventor of the recording telegraph, and the first who has successfully applied the agent or element of nature called electro-magnetism to printing and recording intelligible characters at a distance; and that his patent of 1840, finally reissued in 1848, and his patent for his improvements as reissued in the same year, are good and valid; and that the appellants have infringed the rights secured to the patentee

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by both his patents. But as I do not concur in the views of the majority of the court in regard to two great points of the case, I shall proceed to express my own.

I. Does the complainant's first patent come within the proviso of the sixth section of the act of 1839? and should the term of fourteen years granted by it commence from the date of his patent here, or from the date of his French patent, in 1838?

If the complainant's patent is within the provisions of this section, I cannot see how we can escape from declaring it void. The proviso declares that "in all cases every such patent (issued under the provisions of that section) shall be limited to the term of fourteen years from the date of publication of such foreign letters patent." It is true, it does not say that the patent shall be void if not limited to such term on its face; but it gives no power to the officer to issue a patent for a greater term. If the patent does not show the true commencement of the term granted by it, the patentee has it in his power to deceive the public by claiming a term of fourteen years, while in reality it may be not more than one.

But I am of opinion that the patent in question does not come within this proviso.

The facts of the case, as connected with this point, are these: On the 6th of October, 1837, Morse filed, in the office of the Commissioner of Patents, a caveat, accompanied by a specification, setting forth his invention, and praying that it may be protected till he could finish some experiments necessary to perfect its details. On the 9th of April, 1838, he filed a formal application for a patent, accompanied by a specification and drawings. On the 1st of May, 1838, the Commissioner informs him that his application has been granted. Morse answers, on the 15th of May, that he is just about to sail to Europe, and asks the Commissioner to delay the issue of his patent for the present, fearing its effect upon his plans abroad.

On the 30th of October, 1838, he obtained his useless French patent. On his return to this country, in 1840, he requests his patent to be perfected and issued. In this application, filed on the 9th of April, 1838, there was an oversight in filling up the day and month. This clerical omission was wholly immaterial, but, *ex majori cautela*, a second affidavit was filed, and the patent issued on the 20th of June, 1840, for the term of fourteen years from its date.

The application of 1838 had a set of drawings annexed to the specification. The second set of drawings, required by the sixth section of the act of 1837, being for the purpose of annexation to the patent, they were entirely unnecessary till the patent issued, and are not re-

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quired by law to accompany the application when first made; and the want of them cannot affect the validity of the application.

In many instances, owing to various causes, the patent is not issued till many months, and sometimes a year or more, after the application. The Commissioner requires time to examine the specification; he may suggest difficulties and amendments; and disputes often arise which delay the issuing the patent. But the application does not require to be renewed, and is never considered abandoned in consequence of such delay. It still remains as of the date of its filing, for every purpose beneficial to the applicant. The law does not require that the specification and its accompaniments should be in the precise form which they afterwards assume in the patent. It requires only that the application be "in writing," and that the applicant should "make oath that he is the original inventor," &c. The other requirements of the act must precede the issuing of the patent, but make no part of the application, and are not conditions precedent to its validity.

In the present case, we have, therefore, a regular application in due form, accompanied by a specification and drawings, filed on the 9th of April, 1838. It has not been withdrawn, discontinued, or abandoned. There is nothing in the act of Congress which requires that the patent should be issued within any given time after the application is filed, or which forbids the postponement of it for a time, at the suggestion either of the applicant or the officer. Nor is there anything in the general policy of the Patent Laws which forbids it. On the contrary, it has always been the practice, when a foreign patent is desired, to delay the issuing of the patent here, after application filed, for fear of injuring such foreign application. It forms no part of the policy of any of our Patents Acts to prevent our citizens from obtaining patents abroad.

By the Patent Act of 1793, the applicant must swear "that his invention was not known or used before the application." The filing of the application was the time fixed for determining the applicant's right to a patent. If a patent had issued abroad, or the invention had been in use, or described in some public work, before that time, it was a good defense to it. The time of filing the application was, therefore, made by law the criterion of his right to claim as first inventor. A foreign patent subsequent to the date of his application could not be set up as a defense against the domestic patentee. The American inventor who had filed his application and specification at home, was thus enabled to obtain his patent abroad, without endangering his patent at home. This was a valuable privilege to Amer-



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ican citizens, and one of which he has never been deprived by subsequent legislation. And thus the law stood till the act of 4th of July, 1836.

Before this time, the right to obtain a patent was confined to American citizens, or those who had filed their intentions to become such. The policy of this act was to encourage foreign inventors to introduce their inventions to this country, but in doing so it evinces no intention of limiting our own citizens, by taking away from them rights which they had hitherto enjoyed.

Accordingly, it gave an inventor who had obtained a patent abroad, and who was generally a foreigner, a right to have one here, provided he made his application here within six months after the date of his foreign patent. Neither the letter nor the spirit of this act interferes with the right of an inventor who has filed his application here from obtaining a patent abroad, or his right to a term of fourteen years from the date of his patent.

In 1838, therefore, when complainant filed his application, he was entitled to such a patent. But in March, 1839, an act was passed, by the sixth section of which it is alleged the complainant's rights have been affected. That section is as follows:

"That no person shall be debarred from receiving a patent for any invention, &c., as provided in the act of 4th of July, 1836, to which this is additional, by reason of the same having been patented in a foreign country more than six months prior to his application; provided, that the same shall not have been introduced into public and common use in the United States prior to the application for such patent; and provided, also, that in all cases every such patent shall be limited to the term of fourteen years from the date of publication of such foreign letters patent."

Now, the act of 1836, as we have shown, had given a privilege to foreign patentees to have a patent within six months after date of such foreign patent. It had not affected, in any manner, the right previously enjoyed by American citizens, to take out a foreign patent after filing their applications here. This section gives additional rights to those who had first taken out patents abroad, and holding out an additional encouragement to foreign inventors to introduce their inventions here, subject to certain conditions contained in the proviso. Neither the letter, spirit, nor policy of this act has any reference to, or bearing upon, the case of persons who had just made their applications here. To construe a proviso as applicable to a class of cases not within its enacting clause, would violate all settled rules of construction. The office of a proviso is either to except something from

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the enacting clause, or to exclude some possible ground of misinterpretation, or to state a condition to which the privilege granted by the section shall be subjected.

Here the proviso is inserted to restrain the general words of the section, and impose a condition on those who accept the privileges granted by the section. It enlarged the privileges of foreign patentees, which had been before confined to six months, on two conditions: 1st. Provided the invention patented abroad had not been introduced into public use here; and 2d. On condition that every such patent should be limited in its terms. The general words "in all cases," especially when restrained to every such patent, cannot extend the conditions of the proviso beyond such cases as are the subject-matter of legislation in the section. The policy and spirit of the act are to grant privileges to a certain class of persons which they did not enjoy before; to encourage the introduction of foreign inventions and discoveries, and not to deprive our own citizens of a right heretofore enjoyed, or to affect an entirely different class of cases, when the applications had been filed here before a patent obtained abroad.

It is supposed that certain evils might arise by allowing an applicant for a patent here to delay its issue till he can obtain a foreign patent. To which it is a sufficient answer to say, that if such evil consequences should be found to exist, it is for Congress to remedy them by legislation.

It is no part of the duty of this court, by a forced construction of existing statutes, to attempt the remedy of possible evils by anticipation.

I am, therefore, of opinion that the complainant's patent, as renewed, contained a valid grant of the full term of fourteen years from its original date.

II. The other point in which I cannot concur with the opinion of the majority, arises in the construction of the eighth claim of complainant's first patent, as finally amended. The first claim, as explanatory of all that follow, should be read in connection with the eighth. They are as follows:

"1st. Having thus fully described my invention, I wish it to be understood that I do not claim the use of the galvanic current, or currents of electricity, for the purpose of telegraphic communications generally; but what I specially claim as my invention and improvement, is making use of the motive-power of magnetism, when developed by the action of such current or currents, substantially as set forth in the foregoing description of the first principal part of my invention, as means of operating or giving motion to machinery

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which may be used to imprint signals upon paper or other suitable material, or to produce sounds in any desired manner, for the purpose of telegraphic communication at any distances. The only ways in which the galvanic current had been proposed to be used prior to my invention and improvement, were by bubbles resulting from decomposition, and the action or exercise of electrical power upon a magnetized bar or needle; and the bubbles and the deflections of the needles thus produced were the subjects of inspection, and had no power, or were not applied, to record the communication. I therefore characterize my invention as the first recording or printing telegraph by means of electro-magnetism.

"There are various known modes of producing motions by electro-magnetism, but none of these had been applied prior to my invention and improvement to actuate or give motion to printing or recording machinery, which is the chief point of my invention and improvement."

"8th. I do not propose to limit myself to the specific machinery, or parts of machinery, described in the foregoing specification and claims; the essence of my invention being the use of the motive-power of the electric or galvanic current, which I call electro-magnetism, however developed, for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer."

The objection to this claim is that it is too broad, because the inventor does not confine himself to specific machinery, or parts of machinery, as described in his patent, but claims that the essence of his invention consists in the application of electro-magnetism as a motive-power, however developed, for printing characters at a distance, this being a new application of that element or power, of which the patentee claims to be the first inventor or discoverer.

In order to test the value of this objection, as applied to the present case, and escape any confusion of ideas too often arising from the use of ill-defined terms and propositions, let us examine—

1st. What may be patented, or what forms a proper subject of protection, under the Constitution and acts of Congress relative to this subject?

2d. What is the nature of the invention now under consideration? Is it a mere machine, and subject to the rules which affect a combination of mechanical devices to effect a particular purpose?

3d. Is the claim true, in fact? And if true, how can it be too broad, in any legal sense of the term as heretofore used, either in the acts of Congress or in judicial decisions?

4th. Assuming the hypothesis that it is too broad, how should that affect the judgment for costs in this case?

1st. The Constitution of the United States declares that "Congress shall have the power to promote the progress of science and useful arts, by securing, for limited times; to authors or inventors, the exclusive right to their respective writings and discoveries."

The act of Congress of 1836 confers this exclusive right, for a limited time, on "any person who has discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements on any art, machine, manufacture, or composition of matter, not known or used by others before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use," &c.

A new and useful art, or a new and useful improvement on any known art, is as much entitled to the protection of the law as a machine or manufacture. The English Patent Acts are confined to "manufactures," in terms; but the courts have construed them to cover and protect arts as well as machines, yet without using the term art. Here we are not required to make any latitudinous construction of our statute for the sake of equity or policy; and surely we have no right, even if we had the disposition, to curtail or narrow its liberal policy by astute or fanciful construction.

It is not easy to give a precise definition of what is meant by the term "art," as used in the acts of Congress. Some, if not all the traits which distinguish an art from the other legitimate subjects of a patent are stated with clearness and accuracy by Mr. Curtis, in his *Treatise on Patents*. "The term art applies," says he, "to all those cases where the application of a principle is the most important part of the invention, and where the machinery, apparatus, or other means by which the principle is applied are incidental only, and not of the essence of his invention. It applies also to all those cases where the result, effect, or manufactured article is old, but the invention consists in a new process or method of producing such result, effect, or manufacture." Curtis on Patents, 80.

A machine, though it may be composed of many parts, instruments, or devices combined together, still conveys the idea of unity. It may be said to be invented, but the term "discovery" could not well be predicated of it. An art may employ many different machines, devices, processes, and manipulations to produce some useful result. In a previously-known art, a man may discover some new process, or new application of a known principle, element, or power of nature, to the advancement of the art, and will be entitled to a patent for the

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same, as "an improvement in the art"; or he may invent a machine to perform a given function, and then he will be entitled to a patent only for his machine.

That improvements in the arts which consist in the new application of some known element, power, or physical law, and not in any particular machine or combination of machinery, have been frequently the subject of patents, both in England and in this country, the cases in our books most amply demonstrate. I have not time to examine them at length; but would refer to James Watt's patent for a method of saving fuel in steam-engines, by condensing the steam in separate vessels, and applying non-conducting substances to his steam-pipes; Clegg's patent for measuring gas in water; *Juhr v. Pratt*, Webster's Patent Cases, 103; and the celebrated case of Neilson's patent for the application of hot blast, being an important improvement in the art of smelting iron.

In England, where their statute does not protect an art in direct terms, they have made no clear distinction between an art, or an improvement in an art, and a process, machine, or manufacture. They were hampered and confined by the narrowness of the phraseology of their Patent Acts. In this country, the statute is as broad as language can make it. And yet, if we look at the titles of patents as given at the Patent Office, and the language of our courts, we might suppose that our statute was confined entirely to machines, notwithstanding in *Kneass v. Schuylkill Bank*, 4 Wash. C. C. Rep., 19, Mr. Justice Washington supported a patent which consisted in nothing else but a new application of copper-plates to both sides of a bank-bill as a security against counterfeiting. The new application was held to be an art, and therefore patentable. So the patent in *Mc Clurg v. Kingsland*, 1 Howard, 204, was in fact for an improvement in the art of casting chilled rollers by conveying the metal to the mould in a direction approaching to the tangent of the cylinder; yet the patentee was protected in the principle of his discovery, which was but the application of a known law of nature to a new purpose, against all forms of machinery embodying the same principle.

The great art of printing, which has changed the face of human society and civilization, consisted in nothing but a new application of principles known to the world for thousands of years. No one could say it consisted in the type or the press, or in any other machine or device used in performing some particular function, more than in the hands which picked the types or worked the press. Yet if the inventor of printing had, under this narrow construction of our Patent Law, claimed his art as something distinct from his machinery, the doctrine

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now advanced would have declared it unpatentable to its full extent as an art, and that the inventor could be protected in nothing but his first rough types and ill-contrived press.

I do not intend to review the English cases which adopt the principle for which I now contend, notwithstanding their narrow statute; but would refer to the opinion of my brother Nelson, in 14 Howard, 177; and will add, that Mr. Justice McLean, in delivering the opinion of the court in that case, quotes with approbation the language of Lord Justice Clerke in the Neilson case, which is precisely applicable to the question before us. He says: "The specification does not claim anything as to form, nature, shape, materials, numbers, or mathematical character of the vessel or vessels in which the air is to be heated, or as to the mode of heating such vessels." Yet this patent was sustained as for a new application of a known element; or, to use correct language, as an improvement in the art of smelting iron, without any regard to the machinery, or parts of machinery, used in the application. Such I believe to be the established doctrine of the English courts.

He who first discovers that an element or law of nature can be made operative for the production of some valuable result, some new art, or the improvement of some known art; who has devised the machinery or process to make it operative, and introduced it in a practical form to the knowledge of mankind, is a discoverer and inventor of the highest class. The discovery of a new application of a known element or agent may require more labor, expense, persevering industry, and ingenuity than the inventor of any machine. Sometimes, it is true, it may be the result of a happy thought or conception, without the labor of an experiment, as in the case of the improvement in the art of casting chilled rollers, already alluded to. In many cases, it is the result of numerous experiments,—not the consequence of any reasoning *a priori*, but wholly empirical; as, the discovery that a certain degree of heat, when applied to the usual processes for curing India-rubber, produced a substance with new and valuable qualities.

The mere discovery of a new element, or law, or principle of nature, without any valuable application of it to the arts, is not the subject of a patent. But he who takes this new element or power, as yet useless, from the laboratory of the philosopher, and makes it the servant of man; who applies it to the perfecting of a new and useful art, or to the improvement of one already known, is the benefactor to whom the Patent Law tenders its protection. The devices and machines used in the exercise of it may or may not be used; yet,

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by the doctrine against which I contend, he cannot patent them, because they were known and used before; or if he can, it is only in their new application and combination in perfecting the new art. In other words, he may patent the new application of the mechanical devices, but not the new application of the operative element which is the essential agent in the invention. He may patent his combination of the machinery, but not his art.

When a new and hitherto unknown product or result, beneficial to mankind, is effected by a new application of any element of nature, and by means of machines and devices, whether new or old, it cannot be denied that such invention or discovery is entitled to the denomination of a "new and useful art." The statute gives the inventor of an art a monopoly in the exercise of it as fully as it does to the inventor of a mere machine; and any person who exercises such new art without the license of the inventor is an infringer of his patent, and of the franchise granted to him by the law as a reward for his labor and ingenuity in perfecting it. A construction of the law which protects such an inventor in nothing but the new invented machines, or parts of machinery, used in the exercise of his art, and refuses it to the exercise of the art itself, annuls the Patent Law. If the law gives a franchise or monopoly to the inventor of an art as fully as to the inventor of a machine, why shall its protection not be coëxtensive with the invention in one case as well as in the other? To look at an art as nothing but a combination of machinery, and give it protection only as such, against the use of the same or similar devices or mechanical equivalents, is to refuse it protection as an art. It ignores the distinction between an art and a machine; it overlooks the clear letter and spirit of the statute; and leads to inextricable difficulties. It is viewing a statute or a monument through a microscope.

The reason given for thus confining the franchise of the inventor of an art to his machines and parts of machinery, is that it would retard the progress of improvement, if those who can devise better machines or devices, differing in mechanical principle from those of the first inventor of the art, or, in other words, who can devise an improvement in it, should not be allowed to pirate it.

To say that a patentee who claims the art of writing at a distance by means of electro-magnetism necessarily claims all future improvements in the art, is to misconstrue it, or draws a consequence from it not fairly to be inferred from its language. An improvement in a known art is as much the subject of a patent as the art itself; so, also, is an improvement on a known machine; yet if the original

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machine be patented, the patentee of an improvement will not have a right to use the original. This doctrine has not been found to retard the progress of invention in the case of machines; and I can see no reason why a contrary one should be applied to an art.

The claim of the patentee is, that he may be protected in the exercise of his art as against persons who may improve or change some of the processes or machines necessary in its exercise. The court, by deciding that this claim is too broad, virtually decides that such an inventor of an improvement may pirate the art he improves, because it is contrary to public policy to restrain the progress of invention. Or, in other words, it may be said that it is the policy of the courts to refuse that protection to an art which it affords to a machine, which it is the policy of the Constitution and the laws to grant.

2d. Let us now consider what is the nature of the invention now under consideration.

It is not a composition of matter, or a manufacture, or a machine. It is the application of a known element or power of nature to a new and useful purpose, by means of various processes, instruments, and devices, and if patentable at all, it must come within the category of "a new and useful art." It is as much entitled to this denomination as the original art of printing itself. The name given to it in the patent is generally the act of the Commissioner, and in this, as in many other cases, a wrong one. The true nature of the invention must be sought in the specification.

The word telegraph is derived from the Greek, and signifies "to write afar off, or at a distance." It has heretofore been applied to various contrivances or devices, to communicate intelligence by means of signals or semaphores, which speak to the eye a moment. But in its primary and literal signification of writing, printing, or recording at a distance, it never was invented, perfected, or put into practical operation till it was done by Morse. He preceded Steinheil, Cooke, Wheatstone, and Davy in the successful application of this mysterious power or element of electro-magnetism to this purpose; and his invention has entirely superseded their inefficient contrivances. It is not only "a new and useful art," if that term means anything, but a most wonderful and astonishing invention, requiring tenfold more ingenuity and patient experiment to perfect it than the art of printing with types and press, as originally invented.

3d. Is it not true, as set forth in this eighth claim of the specification, that the patentee was the first inventor or discoverer of the use or application of electro-magnetism to print and record intelligible characters or letters? It is the very ground on which the court



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agree in confirming his patent. Now, the Patent Law requires an inventor, as a condition precedent to obtaining a patent, to deliver a written description of his invention or discovery, and to particularly specify what he claims to be his own invention or discovery. If he has truly stated the principle, nature, and extent of his art or invention, how can the court say it is too broad, and impugn the validity of his patent for doing what the law requires as a condition for obtaining it? And if, it is only in case of a machine that the law requires the inventor to specify what he claims as his own invention and discovery, and to distinguish what is new from what is old, then this eighth claim is superfluous, and cannot affect the validity of his patent, provided his art is new and useful, and the machines and devices claimed separately are of his own invention. If it be in the use of the words "however developed" that the claim is to be adjudged too broad, then it follows that a person using any other process for the purpose of developing the agent or element of electro-magnetism than the common one now in use, and described in the patent, may pirate the whole art patented.

But if it be adjudged that the claim is too broad because the inventor claims the application of this element to his new art, then his patent is to be invalidated for claiming his whole invention, and nothing more. If the result of this application be a new and useful art, and if the essence of his invention consists in compelling this hitherto useless element to record letters and words, at any distance and in many places at the same moment, how can it be said that the claim is for a principle or an abstraction? What is meant by a claim being too broad? The Patent Law and judicial decisions may be searched in vain for a provision or decision that a patent may be impugned for claiming no more than the patentee invented or discovered. It is only when he claims something before known and used, something as new which is not new, either by mistake or intentionally, that his patent is affected.

The act of Congress requires the applicant for a patent to swear that "he is the original and first inventor of the art, machine, &c." It requires the Commissioner to make an examination of the alleged invention, "and if it shall appear that the same has not been invented prior to the alleged invention, he shall grant a patent, &c. But if it shall appear that the applicant is not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented," then the applicant to have leave to withdraw his application.

The thirteenth section treats of defective specifications, and their

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remedy where the applicant, through mistake or inadvertency, had claimed "more than he had a right to claim as new."

The fifteenth section, in enumerating the defenses which a defendant may be allowed to make to a patent, states that *inter alia* he may show "that the patentee was not the original and first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new." And the proviso to the same section allows the court to refuse costs, "when the plaintiff shall fail to sustain his action, on the ground that in his specification or claim is embraced more than that of which he was the first inventor."

The seventh section of the act of March 3, 1837, specially defines the meaning of the phrase "too broad" to be, "when the patent claims more than that of which the patentee was the original and first inventor." And the ninth section of the same act, again providing for cases where, by accident or mistake, the patentee claims more than he is justly entitled to, describes it to be, "where the patentee shall have in his specification claimed to be the original inventor or discoverer of any material or substantial part of which he is not the first and original inventor, and shall have no legal and just right to the same."

Thus we see that it is only where, through inadvertence or mistake, the patentee has claimed something of which he was not the first inventor, that the court are directed to refuse costs.

The books of reports may be searched in vain for a case where a patent has been declared void for being too broad in any other sense.

Assuming it to be true, then, for the purpose of the argument, that the new application of the power of electro-magnetism to the art of telegraphing or printing characters at a distance is not the subject of a patent, because it is patenting a principle, yet, as it is also true that Morse was the first who made this application successfully, as set forth in this eighth claim, I am unable to comprehend how, in the words of the statute, we can adjudge "that he has failed to sustain his action, on the ground that his specification or claim embraces more than that of which he was the first inventor." It is for this alone that the statute authorizes us to refuse costs.

4. Assuming this eighth claim to be too broad, it may well be said that the patentee has not unreasonably delayed a disclaimer, when we consider that it is not till this moment he had reason to believe it was too broad. But the bill claims, and it is sustained by proof, that the defendant has infringed the complainant's second patent for his improvement.

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Statement of the case.

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The court sustains the validity of this patent. Why, then, is the complainant not entitled to his costs? At law, a recovery on one good count is sufficient to entitle the plaintiff to recover costs; and I can see no particular equity which the defendants can claim, who are adjudged to have pirated two inventions at once.

I am of opinion, therefore, that the decree of the Circuit Court should be affirmed with costs.

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ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Kentucky, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of the said Circuit Court in this cause be, and the same is hereby, affirmed, except so much thereof as decrees that the complainants shall recover their costs in the prosecution of this suit of and from the defendants, and that that part of the said decree giving costs to the complainants be, and the same is hereby, reversed and annulled.

And it is further ordered and decreed by this court, that the parties respectively pay their own costs in this court and in the said Circuit Court.

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FRANCIS O. J. SMITH, PLAINTIFF, v. HEMAN B. ELY, HENRY O'REILLY, ROBERT W. MCCOY, THOMAS MOODIE, MICHAEL B. BATEHAM, LINCOLN GOODALE, WRAY THOMAS, ALBERT B. BUTTLES, AND ROBERT NEIL.

(15 Howard, 137.)

1. The preceding case of O'Reilly and Morse having settled the principles involved in the controversy between them, this court declines to hear an argument upon technical points of pleading in a branch of the case coming from another State.
2. The case is remanded to the Circuit Court.

THIS cause came up from the Circuit Court of the United States for the District of Ohio, upon a certificate of division in opinion between the judges thereof.

An action was brought by Smith, as the assignee of Morse and Vail, against Ely, O'Reilly, and others, for an infringement of Morse's patent-rights to the telegraph, which are particularly set forth in the report of the preceding case.

## Statement of the case.

The first count of the declaration was upon the patent of 1840, surrendered and reissued in 1846.

The second count was upon the patent for improvements in transmitting and recording intelligence by the use of the motive-power of electricity. Both of these patents were surrendered, and reissued in 1848.

The defendants filed eighteen pleas. On the second, third, fourth, fifth, and tenth, the plaintiff took issue. He demurred to the remaining pleas, and upon some of these demurrers the court were divided.

All that need be stated in explanation of the case will be to state the difference of opinion, and refer to the pleas.

And afterwards, to wit, on the twenty-third day of October, being in the year and at the time of said court last mentioned, "this cause came on to heard at the present term upon the demurrers filed by the plaintiff to the sixth, seventh, eighth, ninth, eleventh, twelfth, thirteenth, fourteenth, fifteenth, sixteenth, seventeenth, and eighteenth special pleas of the defendants. And thereupon, the arguments of counsel being heard, and due deliberation being had, the opinion of the judges of said court were divided as to the following questions, to wit:

I. Upon the demurrer to the sixth and seventh pleas respectively, whether the said letters patent to the said Morse are void, for the reason that the same do not on their face respectively express that they are to run for fourteen years from the date of the patent issued to said Morse in the kingdom of France.

II. Whether, upon the demurrer to the eighth, ninth, and eighteenth pleas, said letters patent to said Morse assume, as to the matter alleged in said eighteenth plea, to patent a principle, or a thing which is not an art, machine, manufacture, or composition of matter, or any improvement on any art, machine, manufacture, or composition of matter; and if so, whether, and to what extent, said letters patent, or any part thereof, are void in consequence thereof; and also whether said pleas are bad, respectively, for the reason that they assume to answer certain material and substantial parts of the plaintiff's claim, without averring that there are no other material and substantial parts embraced in his claim, which can be distinguished from the other parts averred to be so claimed without right, and on which he would be entitled to recover.

III. Whether, upon the demurrers to the fourteenth and fifteenth pleas, said patent, issued April 11, 1846, and reissued June 13, 1848, is void; and if so, to what extent; for the reason that it embraces, as

## Statement of the case.

a material and substantial part thereof, a material and substantial part of a former patent issued to said Morse.

IV. Whether, upon the demurrers to the eighth, ninth, fourteenth, and fifteenth pleas, said letters patent issued to said Morse are void, for the reason, as averred in said pleas, that he was not the original and first inventor of the several matters in said pleas respectively set forth; but the same had been, prior to said invention by said Morse, known and used in a foreign country.

The substance of these pleas was as follows:

6th. This plea alleges that on the 18th of August, 1838, Morse took out a patent in France for the same invention patented to him in his letters of June 20, 1840; but that the latter were made to run fourteen years from date, instead of fourteen years from the date of the French letters.

7th. This plea states the same as the sixth, and that Morse's French patent was issued more than six months next before he filed the specification and drawings annexed to the letters patent of June 20, 1840.

Upon the demurrers to these two pleas the court were divided, as mentioned in the first question of division.

8th. The plea sets out with the patents of 1840, as reissued, and then alleges that "the use of the motive-power of the electric or galvanic current, however developed, for marking or printing intelligible characters, signs, or letters, at any distances," is a substantial and material part of the thing patented; and it states that Morse was not the original and first inventor or discoverer of the thing patented, but that the same was known before to one Dr. Steinheil, of Munich, and used on a line from Munich to Bogenhausen.

The principles claimed and patented in the letters of 1840, referred to in the eighth and ninth pleas, are as follows, to wit:

"What I specially claim as my invention and improvement, is making use of the motive-power of magnetism, when developed by the action of such current or currents, substantially as set forth in the foregoing description of the first principal part of my invention, as means of operating, or giving motion to, machinery which may be used to imprint signals upon paper, or other suitable materials, or to produce sounds in any desired manner, for the purpose of telegraphic communication of any distances."

"Eighth. I do not propose to limit myself to the specific machine, or parts of machinery, described in the foregoing specification and claims; the essence of my invention being the use of the motive-power of the electric or galvanic current, which I call electro-magnetism, however developed, for marking or printing intelligible characters, signs, or

letters, at any distances, being a new application of that power, of which I claim to be the first inventor or discoverer."

9th. In this plea, the defendants allege that the mode and process of propelling and connecting currents of electricity or galvanism, through two or more metallic conductors, is a substantial and material part of the thing patented in the letters of 1840; and they aver that Morse was not the original and first inventor or discoverer thereof, but the same was known to one Edward Davy, in England.

18th. In this plea, the defendants allege that "the use of motive-power of the electro-galvanic current, however developed, for marking and printing intelligible characters, signs, or letters, at any distances," is a substantial and material part of the thing patented, and is distinctly claimed by the patentee in the specification; and he avers that the thing so patented and claimed is not any art, machine, manufacture, or composition of matter, or any improvement on them.

The demurrers to these three pleas raise the question secondly certified to this court.

14th. In this plea, the defendant sets out the patent of 1846, as re-issued to, and states that "the combination of a pen lever, pen point or points, and roller," mentioned in the patent, is a substantial and material part of the thing patented; and they aver that it was before known, and formed a part of an electro-magnetic telegraph for which Morse had taken out letters patent in 1840.

15th. In this plea, the defendants allege that "the mode of combining two or more circuits of electricity or galvanism, mentioned and described in the specification annexed to the said letters patent as an improvement, is a substantial and material part of the thing patented;" and they aver that in electro-magnetic telegraphs, before known, modes of combining, on the same principle described in the specification, two or more circuits of electricity or galvanism existed, and formed a part thereof, to wit, in one patented to Morse, June 20, 1840; to Edward Davy, of London, July 4, 1838, by the Queen of Great Britain. This plea also states that Morse, in patent of 1846, does not specify and point out the improvement in the said mode of combining two or more circuits made by him, so as to distinguish the same from the said modes before known and patented by him and by Davy.

The third question certified to this court is raised by demurrers to these two pleas.

The fourth question is raised by demurrers to pleas eight, nine, fourteen, and fifteen, above set forth.

## Opinion of the court.

Mr. Chief Justice TANEY delivered the opinion of the court.

The plaintiff in error is the assignee, within a certain tract of country, of the two patents granted to Morse for his electro-magnetic telegraph, one in 1840, and the other in 1846, and both reissued in 1848. And this action was brought in the Circuit Court for the District of Ohio, for infringements of both of these patents, within the limits assigned to the plaintiff.

The defendants did not proceed in their defense in the manner authorized by the act of Congress, but pleaded the general issue, and seventeen special pleas. Upon some of these pleas issue was joined, and others were demurred to; and upon the argument of the demurrers the judges of the court were divided in opinion on the following questions, which they have certified for decision to this court:

“I. Upon the demurrer to the sixth and seventh pleas respectively, whether the said letters patent to the said Morse are void, for the reason that the same do not on their face respectively express that they are to run for fourteen years from the date of the patent issued to said Morse in the kingdom of France.

“II. Whether, upon the demurrer to the eighth, ninth, and eighteenth pleas, said letters patent to said Morse assume, as to the matter alleged in said eighteenth plea, to patent a principle, or a thing which is not an art, machine, manufacture, or composition of matter, or any improvement on any art, machine, manufacture, or composition of matter; and if so, whether, and to what extent, said letters patent, or any part thereof, are void in consequence thereof; and also whether said pleas are bad, respectively, for the reason that they assume to answer certain material and substantial parts of the plaintiff's claim, without averring that there are no other material and substantial parts embraced in his claim, which can be distinguished from the other parts averred to be so claimed without right, and on which he would be entitled to recover.

“III. Whether, upon the demurrers to the fourteenth and fifteenth pleas, said patent, issued April 11, 1846, and reissued June 13, 1848, is void; and if so, to what extent; for the reason that it embraces, as a material and substantial part thereof, a material and substantial part of a former patent issued to said Morse.

“IV. Whether, upon the demurrers to the eighth, ninth, fourteenth, and fifteenth pleas, said letters patent issued to said Morse are void, for the reason, as averred in said pleas, that he was not the original and first inventor of the several matters in said pleas respectively set forth; but the same had been, prior to said invention by said Morse, known and used in a foreign country.”

## Order.

The questions certified, so far as they affect the merits of the case, have all been substantially decided in the case of *Morse et al.* v. *O'Reilly et al.*, at the present term. But several questions are presented, by the certificate, upon the construction of the pleas and the extent of the admissions made by the demurrers, and the legal effect of such admissions upon the plaintiff's right of action.

In relation to the questions which go to the merits, as they have been already fully heard and decided in the case above mentioned, they are not open for argument in this case; and it would be a useless and fruitless consumption of time to hear an argument upon the technical questions alone; for however the points of special pleading might be ruled by this court, they could have no material influence on the ultimate decision of the case, because, if it is found that errors in pleading have been committed by either party, injurious to his rights, an opportunity ought and would certainly be afforded him to correct them in some subsequent proceeding, so as to bring the real points in controversy fairly before the court.

For these reasons, the motion of the counsel for the defendants, for leave to argue the points certified, is overruled, and the case remanded to the Circuit Court.

Under such circumstances, we deem it proper to remand the case, without argument, to the Circuit Court for the District of Ohio, where either party may amend his pleadings, and where the defendants, if they can distinguish their case from that above mentioned, will have an opportunity of being heard.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Ohio, and on the points or questions on which the judges of the said Circuit Court were opposed in opinion, and which were certified to this court for its opinion agreeably to the acts of Congress in such case made and provided; and it appearing to this court that the said questions, so far as they affect the merits of the case, have been substantially decided by this court, at this term, in the case of *O'Reilly et al.* v. *Morse et al.*, it is thereupon now here ordered and adjudged by this court, that this cause, without argument, be, and the same is hereby, remanded to the said Circuit Court, with directions to permit either party to amend his pleadings, and also to allow the defendants an opportunity to distinguish their case, if they can, from that above referred to.



## ELIJAH PHELPS, PLAINTIFF IN ERROR, v. JACOB MAYER.

(15 Howard, 160.)

1. In order to make a bill of exceptions valid, it must appear by the transcript not only that the instructions were given or refused at the trial, but also that the party who complains of them excepted to them while the jury were at the bar.
2. The bill of exceptions need not be drawn out and signed before the jury retire; but it must be taken in open court, and must appear, by the certificate of the judge who authenticates it, to have been so taken.
3. Hence, when the verdict was rendered on the 13th of December, and on the next day the plaintiff came into court and filed his exception, it is not properly before this court. And no error being assigned or appearing in the other proceedings, the judgment of the Circuit Court must be affirmed with costs.

(Mr. Justice CURTIS did not sit in this cause, having been of counsel for the patentee.)

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Indiana.

It is not necessary to state either the facts or arguments of the case, inasmuch as it went off upon a point of practice.

It was argued by *Mr. Ewing*, for the plaintiff in error, and by *Mr. Jernegan*, for the defendant in error.

*Mr. Jernegan* thus noticed the point upon which the case went off:

A preliminary objection arises. It appears from the record that the verdict was rendered on the 13th of December, and the bill of exceptions filed on the 14th. No exceptions were taken on the trial. It is therefore too late now to object to the instructions of the court, or its refusal to give the instructions required. 11 Peters, 185; 6 Blackford, 417; *Cully v. Doe*, 11 Adolph. & Ellis, 1008, note.

Mr. Chief Justice TANEY delivered the opinion of the court.

This action was brought by the plaintiff in error against the defendant in the Circuit Court of the United States for the District of Indiana, for the infringement of the plaintiff's rights under a patent granted to him for a new and useful improvement in the application of hydraulic power. The case was submitted to a jury under certain directions from the court, and the verdict and judgment were for the defendant.

This writ of error is brought for the purpose of revising this judg-

## Order.

ment; and the case has been fully argued upon the charge given by the Circuit Court, and also upon its refusal to give sundry directions to the jury which were requested by the plaintiff.

But although it appears, by the certificate of the judge, sent up as part of the record, that these instructions were given and refused at the trial, yet it also appears that no exception was taken to them while the jury remained at bar. The verdict was rendered on the 13th of December, and the next day the plaintiff came into court and filed his exception. There is nothing in the certificate from which it can be inferred that this exception was reserved pending the trial and before the jury retired.

The defendant in error now objects that this exception was too late, and is not therefore before this court upon the writ of error. We think this objection cannot be overcome.

It has been repeatedly decided, by this court, that it must appear by the transcript, not only that the instructions were given or refused at the trial, but also that the party who complains of them excepted to them while the jury were at the bar. The statute of Westminster 2d, which provides for the proceeding by exception, requires, in explicit terms, that this should be done; and if it is not done, the charge of the court, or its refusal to charge as requested, forms no part of the record, and cannot be carried before the appellate court by writ of error. It need not be drawn out in form and signed before the jury retire; but it must be taken in open court, and must appear, by the certificate of the judge who authenticates it, to have been so taken.

Nor is this a mere formal or technical provision. It was introduced and is adhered to for purposes of justice; for if it is brought to the attention of the court that one of the parties excepts to his opinion, he has an opportunity of reconsidering or explaining it more fully to the jury. And if the exception is to evidence, the opposite party might be able to remove it by further testimony, if apprised of it in time.

This subject was fully considered in the case of *Sheppard v. Wilson*, 6 How., 275, where the cases previously decided in this court, affirming the rule above stated, are referred to.

There being, therefore, no exception before the court, and no error being assigned or appearing in the other proceedings, the judgment of the Circuit Court must be affirmed with costs.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Indiana, and was argued by counsel; on consideration whereof, it is

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Statement of the case.

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now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs.

**AFFIRMED WITH COSTS.**

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ARTEMAS L. BROOKS, IGNATIUS TYLER, WILLIAM W. WOODWORTH, (AS ADMINISTRATOR OF WILLIAM WOODWORTH, DECEASED, AND ALSO AS GRANTEE,) AND JAMES G. WILSON, APPELLANTS, v. JOHN FISKE AND NICHOLAS G. NORCROSS, DOING BUSINESS UNDER THE FIRM OF FISKE & NORCROSS.

(15 Howard, 212.)

1. A machine for planing boards and reducing them to an equal thickness throughout, which was patented by Norcross, decided not to be an infringement of Woodworth's planing-machine, for which a patent was obtained in 1828, reissued in 1845.
2. The operation of both machines explained.

(Mr. Justice CURTIS did not sit in this cause, having been of counsel for the patentee.)

THIS was an appeal from the Circuit Court of the United States for the District of Massachusetts, sitting as a court of equity.

The appellants were the owners of the Woodworth patent for a planing-machine, the documents respecting which are set forth in *extenso* in the report of the case of *Wilson v. Rousseau*, 4 Howard, 646. They filed a bill against the appellees for an injunction to restrain them from using a certain planing-machine, known as the Norcross machine, upon the ground that it was an infringement of their letters patent. Other matters were brought into the bill, which it is not material here to state.

In their answer, the appellees say that they have jointly, under the firm of Fiske & Norcross, and not otherwise, used one planing-machine, and no more, since December 25, 1849, at their mill in said Lowell, and nowhere else; but they believe, and therefore aver, that said machine is not the same in principle and mode of operation as the said Woodworth machine, but is substantially different therefrom, and contains none of the combinations claimed in the said Woodworth patent, but is a new and different invention, secured to said Norcross by letters patent, duly granted and issued to him by the United States of America, on the twelfth day of February, in the year one thousand eight hundred and fifty; to which, or a duly cer-

## Statement of the case.

tified copy thereof; they refer as an exhibit with this their answer, for the purpose of showing the substantial difference between said machines.

The answers then admit the filing of the bill of complaint charged in this bill to have been filed against them in 1844, and the making of the agreement recited in this bill; but they say that the machine referred to in that agreement, and which they were then using, was constructed according to a patent granted to one Hutchinson, on the 16th of July, 1839, but they admit that it embraced the first combination claimed in the Woodworth amended patent. The answers further contain the following averments:

“And these defendants, further answering, say that they believe, and therefore aver, that the said Woodworth patent is void in part, for want of novelty in the first claim therein, to wit, for the employment of rotating planes in combination with rollers, or any analogous device, to keep the board in place; the same thing, substantially, having been before patented in France, to wit, in 1817 and 1818, by Sir Lewis Victor, Joseph Mari Roguin, and in 1825 by Sir Leonore Thomas de Manneville, and described in the printed publication commonly called *Brevets d’Inventions*, vol. 23, pages 207 to 212, plates 27 and 28, and vol. 41, pages 111 to 116, plate 12; and these defendants refer also to the Hill machine, mentioned in the said patent of Norcross as publicly used by Joseph Hill, of Lynn, prior to the pretended invention of the said combination by the said William Woodworth, deceased.”

“And these defendants further say that they believe, and therefore aver, that the said patent issued to William W. Woodworth, July 8, 1845, is not for the same invention as the original patent issued to William Woodworth, December 27, 1828, exclusive of the part disclaimed January 2, 1843, as alleged in the plaintiffs’ bill.”

“And these defendants, further answering, say that they are informed by numerous and able experts, and they verily believe, and therefore aver, that the machine used by them, and patented by said Norcross as aforesaid, is not an infringement of the said Woodworth patent, nor of any rights of the plaintiffs under the same; and they pray that the question of infringement may be tried by a jury, under the direction of the court.”

To this answer, a general replication was filed.

Much evidence was taken, and in March, 1852, the cause came on to be heard upon the bill annexed, general replication, and the proofs taken therein before the judge of the District Court, Mr. Justice Curtis having been of counsel in the case. The court adjudged

## Opinion of the court.

that the machine made and used by the defendants, and complained of in the said bill, is not an infringement of the rights secured to the complainants under and by virtue of the letters patent reissued and granted to William W. Woodworth, administrator, on the eighth day of July, in the year one thousand eight hundred and forty-five, referred to in the said bill, and under and by virtue of the several mesne conveyances recited in the said bill; and thereupon the court doth order, adjudge, and decree that the complainants' said bill be, and the same hereby is, dismissed with costs.

The complainants appealed to this court.

It was argued by *Mr. Keller* and *Mr. G. T. Curtis*, for the appellants, and by *Mr. Whiting*, for the appellees.

The reporter finds himself unable to give an intelligible explanation of the arguments of counsel, without introducing engravings, which would be out of place in a law book. In fact, models were used in the argument before the court. He is compelled, therefore, to omit all the arguments of counsel.

Mr. Justice CATRON delivered the opinion of the court.

The bill before us was filed against Fiske & Norcross by the assignees of Woodworth's patented machine for planing boards, and of tonguing and grooving them.

It is alleged that a planing-machine patented to Norcross, and used by the defendants, was substantially, in its combination, and in the result it produced, the same as that assigned to the complainants for a district in which the defendants' machine was used; that the complainants' patent was the elder, and that the use of Norcross' machine was an infringement of that invented by William Woodworth.

The Circuit Court dismissed the bill on the hearing; and it is this decree we are called on to revise. The contest in the court below could hardly have been more stringent; and much consideration was obviously bestowed on the case by the judge who decided it, as appears from his opinion, which is laid before us, the accuracy of which opinion, and the decree founded on it, we are called on to examine. Before doing so, it is proper to state that the machine used by the defendants does not tongue and groove boards, and that this part of Woodworth's machine is not in controversy.

It is insisted that Woodworth's monopoly extends to his mode of reducing a plank to an equal thickness; and a principal question is

whether the patentee sets up any such claim. It is provided, by the sixth section of the act of 1835, that in case of any machine the inventor shall fully explain the principle, and the several modes in which he has contemplated the application of that principle, or character by which it may be distinguished from other inventions, "and shall particularly specify and point out the part, improvement, and combination which he claims as his own invention or discovery." An improvement of a machine is here claimed as having been invented, and the statute requires that such improvement shall be particularly specified; it is to be done in writing, and the applicant is to swear that he believes he is the first inventor of the improvement. This is required, so that the public may know what they are prohibited from doing during the existence of the monopoly, and what they are to have at the end of the term, as a consideration for the grant.

In the words of Lord Campbell, in *Hastings v. Brown*, 1 Ellis & Blackburn, 453, "The patentee ought to state distinctly what it is for which he claims a patent, and describe the limits of the monopoly;" or in the language of this court in *Evans v. Eaton*, 7 Wheat., 434, "It is for the purpose of warning an innocent purchaser, or other person using the machine, of his infringement, and at the same time of taking from the inventor the means of practicing upon the credulity or fears of other persons, by pretending that his invention was different from its ostensible objects."

Have these requirements been complied with by Woodworth, as respects a claim for planing boards to an equal thickness? He obtained a patent for his machine in 1828, which was surrendered by his executor, in 1845, for want of a proper specification, and a second patent issued; and on this reissued patent the case rests. For its better understanding, we give extracts from the claim and specification; they are the same that were relied on by the Circuit Court, and are as follows: "What is claimed therein as the invention of William Woodworth, deceased, is the employment of rotary planes, substantially such as herein described, in combination with rollers, or any analogous device, to prevent the boards from being drawn up by the planes, when cutting upwards, or from the reduced or planed to the unplaned surface, as described."

And afterwards, "The effect of the pressure-rollers in these operations being such as to keep the boards, &c., steady, and prevent the cutters from drawing the boards towards the center of the cutter-wheel, whilst it is moved through by machinery. In the planing operation, the tendency of the plane is to lift the boards directly up

## Opinion of the court.

against the rollers; but in the tonguing and grooving, the tendency is to overcome the friction occasioned by the pressure of the rollers."

This language, so far from claiming the new truth or the result now contended for as the invention or discovery, does not describe, or even suggest, either of them.

The claim, or summing up, however, is not to be taken alone, but in connection with the specification and drawings. The whole instrument is to be construed together. But we are to look at the others only for the purpose of enabling us correctly to interpret the claim.

The specification begins by saying, "the following is a full, clear, and exact description of the method of planing, tonguing, and grooving plank or boards, invented by William Woodworth, deceased."

Here the invention is denominated a method of planing, tonguing, and grooving, but not of reducing to a uniform thickness.

The specification then, after describing the mode of preparing the board, proceeds thus: "When the plank or boards have been thus prepared, (on a separate machine,) they may be placed on or against a suitable carriage, resting on a frame or platform, so as to be acted upon by a rotary cutting or planing and reducing wheel, which wheel may be made to revolve either horizontally or vertically, as may be preferred. The carriage which sustains the plank or board to be operated upon may be moved forwards, by means of a rack and pinion, by an endless chain or band, by geared friction-rollers, or by any of the devices well known to machinists for advancing a carriage, or materials to be acted upon, in machines for various purposes. The plank or board is to be moved on towards the cutting edges of the cutters or knives on the planing-cylinder, so that its knives or cutters, as they revolve, may meet and cut the plank or board in a direction contrary to that in which it is made to advance; the edges of the cutters are, in this method, prevented from coming first into contact with its surface, and are made to cut upwards from the reduced part of the plank towards said surface, by which means their edges are protected from injury by gritty matter, and the board or plank is more evenly and better planed than when moved in the reversed direction."

There is afterwards a reference to, and explanation of, the drawings, as follows: "In the accompanying drawings, figure 1 is a perspective representation of the principal operating parts of the machine, when arranged and combined for planing, tonguing, and grooving, and when so arranged as to be capable of planing two planks at the same time, the axis of the planing-wheel being placed vertically."

And again: "The rollers, *fff*, which stand vertically, are to be

made to press against the plank and keep it close to the carriage, and thus prevent the action of the cutters from drawing the plank up from its bed, in cutting from the planed surface upwards; they may be borne against it by means of weights or springs, in a manner well known to machinists. In a single horizontal machine, the horizontal friction-rollers may be geared, and the pressure-rollers placed above them, to feed the board, with or without the carriage, a bed-plate being used directly under the planing-cylinder."

And afterwards, in describing the process for tonguing and grooving, he says: "The edges of the plank, as its planed part passes the planing-cylinder, are brought into contact with the above-described tonguing and grooving wheels, which are so placed upon the shafts as that the tongue and groove shall be left at the proper distance from the face of the plank, the latter being sustained against the planing-cylinder by means of the carriage or bed-plate, or otherwise, so that it cannot deviate, but must be reduced to a proper thickness, and correctly tongued or grooved."

"To meet the different thicknesses of the plank or boards, the bearings of the shaft of the cylinder must be made movable, by screws or other means, to adjust it to the work; or the carriage or bed-plate may be made so as to raise the board or plank up to the planing-cylinder."

The means to produce the result of reducing the board to an equal thickness, in a horizontal machine, are the pressure-rollers, *f f*, above the plank, operating in connection with two feed-rollers; and the pressure-rollers, says the specification, "may be held down by springs or weighted levers, which it has not been necessary to show in this drawing, as such are in common use." These rollers are not claimed as new, but are here admitted to be old, and to have been in common use when the patent was granted. Nor is any intimation given in the specification or claim that the pressure-rollers were intended to be used in any combination, for the purpose of reducing a board to an equal thickness. In the description of the original machine, patented in 1828, the pressure-rollers are not mentioned at all, but they are set forth as having belonged to the original machine in the amended specification of 1845; and which last-described machine, experts declare, materially differs from the original as patented in 1828. But as it is not necessary, in this case, to go into the allegation of variance set forth in the answer, we will proceed at once to examine the question of infringement. And to do this, we must first inquire what Woodworth's claim to novelty of combination



and invention is. His rotary cutter-wheel is old, his bed-plate is old, and his pressure-rollers are old likewise.

The invention relied on is a new combination in the machine of three elements, to produce the result of planing a plank against its motion through the machine; and the claim of monopoly is the employment of rotary planes, in combination with the face of a bench, and pressure-rollers, to prevent the board from being drawn up by the planes when cutting upwards, or from the reduced or planed to the unplaned surface, as described.

As the board advances on the rotary cutters, they will strike it thirty times in a second, and violently tend to lift it into the knives; and to keep it down to the bench, a strong pressure is required. And in the next place, the cutters being over the horizontal bed, and stationary, at a fixed distance from it, and the board pressed down to it so forcibly as to crush out the winds in warped lumber, the machine will, of necessity, reduce the board to an equal thickness throughout.

Norcross' planing-machine is an improvement of Hill's, which was in use when Woodworth invented his, in 1828. Hill used the rotary cutter, which he placed on the under side of the bench, with a section cut through it, the cutters extending through the bench to the upper side, so far as to take from the board, passing over the flat surface above, the depth of wood desired. Feed-rollers were employed to forward the board, and a steel spring (made of the section of a hand-saw) was used to keep the board steady. The spring pressed a smooth metal surface on the board, and operated as a pressure-roller does. But then this spring was not used for the purpose that Woodworth used his pressure-rollers, in this: that the face of the bench above the cutters prevented the board from being drawn into them. The cutters drew it down to the bench, so that this bench is the analogous device to Woodworth's pressure-rollers, and is also in combination with the rotary cutters; hence these two elements existed, thus combined, when Woodworth got his patent.

Hill's machine had a bar immediately over the cutters, and covering the cut through the bench, where the knives revolved. Between this bar and the bench, the feed-rollers forced the board; but as the rest-bar was stationary, and the cutter-wheel also stationary, and the cutters extended to a fixed distance above the upper face of the bench, the consequence was, that the board came through the machine of an unequal thickness. To overcome this defect, Norcross made the rest-bar, (previously stationary,) the cap of a square frame, on the vertical side-pieces of which he fixed the journals of his cut-

ter-wheel, the cutters and rest-bar being stationary relatively to each other, and always the same distance apart. This frame is supported in a stationary guide-frame fastened to the bench, and so made as to allow a free vertical movement up and down of the rest-bar and cutting-cylinder. As the board passes over the face of the bench, and under the rest-bar, the whole weight of the sliding-frame rests on the board; and as the cutters strike it at a gauged distance from the bar, and as they move up and down with the bar, it follows that when the board, in its rough state, is of an unequal thickness, and the side presented to the cutters is pressed down to the bench, the thicker parts of the board will force up the movable frame, and draw up the rest-bar and cutters above the bench equal to the increased thickness of the board, which will be dressed to the thickness of the space the cutters and rest are set apart. Opposite to the outer part of the rest F, that section of the bed over which the planed surface of the board passes is a bar, horizontal to the rest. The two bars form a throat-piece, which serves to hold the board steady as it passes through the machine.

In view of this state of facts, the rule is, that if a combination has, as here, three different known parts, and the result is proposed to be accomplished by the union of all the parts, arranged with reference to each other, the use of two of these parts only, combined with a third which is substantially different in the manner of its arrangement and connection with the others, is not the same combination, and no infringement.

The combination and arrangement, as appears from the testimony of experts, and by a comparison of the models and drawings presented to us, was the only novelty in the invention of Woodworth. Bentham, in April, 1793, described a rotary cutter and an adjustable bench, which, when adjusted, became fixed, so that the board would be of a determinate thickness when passed between them.

The Hill machine cut the plank from its planed to its unplanned surface, and had feed-rollers and a spring to keep it down to the bed; while the bed served to prevent the plank from being drawn into the cutters.

The Baltimore machine, as the one witness who describes it deposed, reduced the plank to a uniform thickness, by passing it between a fixed bed and a fixed cutter, and kept it down on the bed by a pressure-roller.

The French machine of Roguin, patented and in use as early as 1818, had the rotary cutter and bench; they were stationary relatively to each other, and must have cut the board of an even thickness

had it been pressed so hard to the bed as to force out the warps; but this seems not to have been the case. The cut of the planes was with the advance of the board through the machine, and from the unplanned to the planed surface; and for this reason the lift of the cutters was very slight. The plank was kept steady by a rest-bar, as in Hill's machine.

This is all we deem necessary to describe, in regard to other machines, to the end of passing judgment on the question of infringement. As to the question of originality of the Woodworth machine, compared with the other earlier planing-machines produced in evidence, and explained by experts; and, secondly, as to the question whether the original machine, for which Woodworth obtained his patent in 1828, had or had not pressure-rollers in connection with other rollers, and which are now claimed as the main element of the machine repatented in 1845, we forbear from deciding, as we suppose these questions would be more appropriately left to a jury on issues, where the witnesses could be heard in open court. It is deemed proper to remark that the fact of procuring a patent for a new and useful machine in 1845, under the assumption of a reissue, which was not useful as patented in 1828, for want of feed and pressure rollers, now used as is alleged in defense, would present a question of fraud, committed on the public by the patentee, by giving his reissued patent of 1845 date as an original discovery, made in 1828, and thereby overreaching similar inventions made between 1828 and 1845.

There is one feature in Norcross' machine, and covered by his patent, which is not claimed to be an infringement. It is this: As the board passes under the rest-bar F, it is weighted down on the edge of that section of the bed over which the plank first passes. The rest-bar is slightly concave, and bears heavily on the planed end of the plank; the further side of that section of the bed over which the board last passes being somewhat depressed, and made lower by bevelling than the opposite section. By this means the board is bent, and struck by the cutters on a concave surface; the grain of the wood being condensed by the bend in the boards, so as to grasp the knots more firmly, and prevent them from being thrown out by the cutter, and also to prevent the fibres from eating into the planed surface. Because of the board being bent, the Norcross machine cannot be used for tonguing and grooving boards, as the edges of the board must be straight to perform these operations.

From the distance the pressure-rollers in Woodworth's machine have to be separated so as to give the cylinder room to rotate, the board tends to curve upwards, and is cut on a convex surface, thus

loosening the knots, and causing them to be thrown out, and causing the surface of the planed board to be eaten in where the wood is cross-grained or coarse, and also to be uneven, and full of small ridges.

We must, however, disregard this last improvement in Norcross' machine, and also discard the parts of Woodworth's machine which tongue and groove, and treat his invention as a single machine for planing boards on one side only; and, on this state of the facts, try the question of infringement. To infringe, Norcross must use all the parts of Woodworth's combination. 1. The use of rollers to keep the board firmly to the bed, and prevent it from being drawn into the cutters and torn to pieces, and to press out the warps, is the principal claim to invention. Norcross uses no such pressure-rollers, nor can they be employed in his machine to such purpose.

But it is insisted that the section of the bed-plate in Norcross' machine, over which the unplaned board passes before it reaches the cutter, is equivalent to the pressure-roller of Woodworth; and that the throat piece is equivalent, in its operation, to his stationary roller. 2. That Norcross uses his rest F, as an equivalent to Woodworth's bed-plate; that the front section of the bed being used for the pressure-roller, and acting in combination with the rest F, representing Woodworth's bed-plate, and the cutter operating alike in both machines, it follows that Norcross in fact used Woodworth's combination, but disguised it by turning Woodworth's machine upside down.

The remarks of Judge Sprague, (who decided this cause in the Circuit Court,) made in answer to the foregoing argument, are so distinct and satisfactory to us, that we deem proper that they should be adopted in this opinion. They are as follows:

"The plaintiff's witnesses, when asked in what part of the defendant's machine they find the plaintiff's pressure-roller, are divided in opinion. Some of them say that it is the bed, because that prevents the board from being drawn into the axis of the cutter, considering that function as the characteristic of the plaintiff's roller. Others find it in what is called the rest, because that presses the board down upon the bed. But in the Hill machine, the roller performed the same office of pressing the board down, and the bed the same office of preventing it being drawn towards the axis. If either of these sets of witnesses be correct, the Hill machine contained the plaintiff's pressure-roller, and as it had also a bed-piece and rotary cutter, it would follow that it had the plaintiff's combination. Such a combination, therefore, cannot be maintained. The truth is, that after the Hill machine, it was only left to Woodworth to make some new arrange-

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ment of the three elements, that is, some new mode of combination. Woodworth's invention may be regarded as an improvement upon Hill's. If Norcross uses this improvement, then he infringes, whatever he may add to it, or with whatever new invention he connects it. If he does not use this improvement, he does not infringe, although he may, by other means, work out the same ultimate result."

"What, then, is the improvement which Woodworth made on the Hill machine? He took the rotating-cylinder, which was in a fixed position below the bed, and placed it in a fixed position above the bed. This is the only change in the arrangement of the three elements. But it transferred to the pressure-roller a function which had before been performed by the bed. In Hill's machine, the pressure-roller only kept the board down upon the bed, the latter keeping it from being drawn into the axis of the cutter. In Woodworth's, the pressure-roller performs both these offices. The effect of this is to plane the board on the upper side instead of the lower, and the result of that is, that the board comes out of a uniform thickness, which was not accomplished by Hill. In his machine, the rotary-cylinder being placed below the bed, with the knife projecting above it, the edge of the knife was kept at a fixed distance above the upper surface of the bed, and cut from the lower side of the board, through its whole length and breadth, so much of it as was equal to that distance. Thus, if the edge of the knife was a quarter of an inch above the bed, and the board be pressed closely to it, it would take off a quarter of an inch of the under side of the board through its whole extent, and if it was of an unequal thickness before, it would remain of an unequal thickness. By placing the cylinder in a fixed position above, and keeping a certain distance between the edge of the cutter and the bed, and all of the board above that distance being taken off by cutting on the upper side, it necessarily comes out of a uniform thickness."

"Now let us look at the Norcross machine. If it has any part which is equivalent to the pressure-roller, it is the rest. Let us, then, for the sake of clearness, consider that to be a pressure-roller. What, then, has been done by Norcross? He has left the arrangement of the three elements the same as it was in Hill's. The rotary-cylinder is below the bed; the pressure-roller still keeps the board down upon the bed, and the bed keeps it from being drawn into the axis of the cutter. His improvement is this: He has made the cutting-cylinder movable vertically, which it was not before, and has connected it with his rest, that is, with the pressure-roller, so that when the latter is forced upwards by the increased thickness of the board, it draws

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the cutter upwards with it, which thereby is made to cut just as much more from the under side of the board as the roller is pressed up by the increased thickness. By this contrivance, the edge of the cutter is kept in a fixed relation to the rest, or, in other words, the pressure-roller, the space between them being always the same; whereas in Hill's, and also in Woodworth's, the edge of the knife had a fixed relation to the bed, and not to the pressure-roller. The defendant, therefore, has made a new and independent invention, and does not use the arrangement or mode of combination of the plaintiff."

For the reasons above stated, we are of opinion that the machine of the respondents did not infringe the patent of the complainants, and therefore order that the decree of the Circuit Court dismissing the bill be affirmed.

Mr. Justice McLEAN, Mr. Justice WAYNE, and Mr. Justice NELSON dissented.

Mr. Justice McLEAN.

I dissent from the opinion of the court. The defendants rest their defense on three grounds—

1. A want of novelty in Woodworth's invention.
2. That in the new patent of Woodworth, issued on the surrender of the old one, to correct the specifications, a new invention is claimed, not contained in the first patent.
3. That the defendant's machine is substantially different from the plaintiff's.

The Woodworth patent has been a subject of investigation frequently before the Circuit Courts of the United States, and of this court; and although the originality of the invention has been, I believe, uniformly sustained, still the fact of novelty depends upon proof, and may be disputed by any one against whom suit is brought. The patent is *prima facie* evidence of right in the patentee. A defense which denies the novelty of the invention must be proved.

The original patent of Woodworth is dated the 27th of December, 1828. He describes his invention to be an "improvement in the method of planing, tonguing, grooving, and cutting into mouldings, of either plank, boards, or any other material, and for reducing the same to an equal width and thickness, and also for facing and dressing brick, and cutting mouldings, or facing metallic, mineral, or other substances." He then describes the machinery by which this result is produced. And he says, in the conclusion, that he does not claim the invention of circular saws, or cutter-wheels, knowing they have

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long been in use; but he claims as his invention the improvement and application of cutter or planing wheels to planing boards, &c., as above stated, &c.

There is no claim, in his written specifications, for pressure-rollers on both sides of the cutting-cylinder, which confine the board to its place, and necessarily reduced it to an equal thickness; but in the drawings, these rollers appear at the proper places, and are so arranged as to reduce the board to a uniform thickness.

The written specifications, including the drawings, constitute a part of the patent, and must be construed as the claim of the plaintiff. In *Ryan v. Goodwin*, 3 Sumner, 514, it is said, if the court can perceive on the whole instrument the exact nature and extent of the claim made by the inventor, it is bound to adopt that interpretation, and to give it full effect. The same is held in *Wyeth v. Stone*, 1 Story, 270, 286; and in *Ames v. Howard*, 1 Sumner, 482, 485, it is said: "The drawings are to be taken in connection with the words; and if by a comparison of the words and the drawings the one would explain the other sufficiently to enable a skillful mechanic to perform the work, the specification is sufficient." *Bloxham v. Elsee*, 1 Car. & Payne, 558, is to the same effect.

Formerly, patents were construed strictly as giving monopolies; but of late years, in England, inventions are treated differently, and a liberal view is taken in favor of the right. *Blanchard v. Sprague*, 3 Sumner, 535, 539. This has been the settled doctrine in this country; and it is founded upon the highest considerations of policy and justice. The opinion delivered by my brother Curtis this morning, as the organ of the court, cites the authorities.

No patent, it is believed, which has ever been granted in this country, has been so much litigated as this one. This affords no unsatisfactory evidence of its value. Very shortly after Woodworth's machine was put in operation, a system of piracy was commenced; and although twenty-five years have elapsed, numerous suits are still pending, contesting the right. Mr. Justice Story was one of the first judges whose duties required him to scrutinize this patent in all its parts, and he sustained it in all. This was before the specifications were corrected. And this court also sustained it, in 7 Howard, 712, where it says: "The specifications accompanying the application for a patent are sufficiently full to enable a mechanic with ordinary skill to build a machine." And this is what the law requires.

In the corrected specifications, the patentee says: "Having thus fully described the parts, and combinations of parts, and operation of the machine for planing, tonguing, and grooving boards or plank,

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and shown various modes in which the same may be constructed and made to operate, without changing the principle or mode of operation of the machine, what is claimed therein as the invention of William Woodworth, deceased, is the employment of rotary planes, substantially as herein described, in combination with rollers, or any analogous device, to prevent the boards from being drawn up by the planes, when cutting upwards, or from the planed to the unplaned surface, as described; and, also, the combination of the rotating planes with the cutter-wheels for tonguing and grooving, for the purposes of planing, tonguing, and grooving boards, &c., at one operation, as described."

"And, finally, the combination of either the tonguing or grooving cutter-wheel for tonguing and grooving boards, &c., with the pressure-rollers, as described, the effect of the pressure in these operations being such as to keep the boards, &c., steady, and prevent the cutters from drawing the boards towards the center of the cutter-wheels, whilst it is moved through by machinery," &c.

L. Roguin, of France, in the years 1817 and 1818, invented a machine for planing, grooving wood, moulding, &c., it is alleged, substantially on the same principles as Woodworth's machine.

A considerable number of experts were examined, in the Circuit Court, on both sides, and their opinions, as usual in such cases, were directly in conflict. Such testimony, being written, cannot lead the court to a satisfactory result, by weighing the evidence, as might be done by a jury, where the witnesses are examined in open court. There seems to be no other mode of arriving at a correct conclusion, than to read what the experts have said, and make up an opinion on the specifications of the patents, and on an examination of the models.

The French machine was improved in 1818. The patentee says: "The parent idea of the first machine could not vary. This parent idea consisted in subjecting the wood to the action of a tool of a particular shape, and to impart to this tool a rotary movement; but the choice remained, either of making the tool stationary, and causing the wood to advance under it with a slow and progressive motion—one rotary, the other progressive. The first was adopted in the construction of the machine described in support of the petition for letters patent; the second has been adopted in the construction of the improved machine."

After describing the structure of the cylinder, he says: "It is borne by a cast-iron carriage, and to the back part of this carriage is attached an iron axletree, bearing two brass pinions, which gear into a rack, and tend to regulate the movement of the carriage. The bench moves



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itself vertically by means of screws which support it, and tend to raise it or lower it according to the thickness of the wood to be worked." "Four small graduated plates of metal, placed in the interior angles of the superstructure, act as a regulator to fix this bench in a perfectly horizontal position." "Two iron squares about the bench at both ends." "Experience," he says, "has taught that the weight of the bench was not sufficient, singly, to prevent the vibration imparted to it by the machine when in operation, and there resulted from this vibration waves on the surface of the planed board." This was obviated by the weight of the carriage. "The carriage is of cast iron, and weighs about two hundred and forty-one pounds. It is necessary that the carriage should be of sufficient weight, so as not to be raised by the strain of the tool."

"The back part of the bench carries a claw, against which the wood is rested and stopped, like a carpenter's bench. At the other extremity, the wood is stopped by movable dogs, which pass under a bar, through which passes pressure screws." And he further says: "We have seen, in the description of the first machine, that the piece called guide (because it serves effectually to guide the wood under the tool for grooving and moulding) was fixed on the superstructure of the bench. In the new machine, this piece is borne by the carriage."

From this description, it appears that the planing-cylinder is carried by an iron frame, and passes over the surface of the board, which is fastened on a bed by a claw at one end, and at the other by movable dogs. This bench, on which the board is placed, is moved vertically, so as to be adjusted by screws to the thickness of the wood to be worked.

The wood is fastened on this adjustable bed, and the iron frame which carries the cutting-cylinder is of sufficient weight to keep the cutters on the board, but this machinery cannot reduce the plank to the same thickness. When the bench rises or falls, the whole surface of the plank rises and falls, and the cutting-knives cannot so operate by pressure on so long a surface as to reduce the inequalities of the board. But this can be done by pressure-rollers, as in Woodworth's machine, on each side of the cutting-cylinder—one adjustable, so as to admit the unplanned plank; the other fixed, so as to admit the passage of the plank, when reduced to the required thickness. The French machine may present a smooth surface, but the inequalities of the board will not be removed. They will remain in the same proportion as before the planing operation.

It is argued, that the piece or bar which, in the first machine, was fastened to the bench, and which, in the improved one, was annexed

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to the carriage, operated as a pressure-roller. If this were admitted, it would not remove the difficulty, as one pressure-roller or bar could answer no valuable purpose. There must be two rollers, one adjustable, as above stated, or two fixed rollers, or bar and an adjustable bed, to reduce the plank to an equal thickness. But if L. Roguin be permitted himself to describe the function of this bar, it is "to guide the wood under the tool for grooving, tonguing, and moulding." Shall the language of the inventor be misapplied, and this bar be appropriated to a use which it would seem he never thought of, to render invalid Woodworth's patent?

Several of the witnesses on both sides gave their testimony from the description of L. Roguin's patent, published in a book called *Brevets d'Inventions*; but, as that book was not published until after Woodworth's invention, its description is evidence only so far as it agrees with the specification attached to the patent of L. Roguin. And it does appear, from the original specifications filed by him, a certified copy of which has been recently procured by M. Perpigna, that there are some material variances. We must therefore look to the authentic paper and drawings, as certified, for evidence in regard to the machine.

The organization of this machine does not seem to be on the same principle as Woodworth's, and the result is different.

The other French machine, alleged to be similar to that of Woodworth's, is De Manneville's. This machine was patented in France in 1825, and described in the printed work called *Brevets d'Inventions*. The patent embraced two machines, having for [their] object the grooving, planing, and reducing to a uniform thickness, wood intended for inlaid work, as well as all sorts of boards, whatsoever may be their dimensions. The inventor calls them a groover and planer.

The description of this machine by the inventor is confused, and scarcely intelligible. One of the defendants' witnesses describes it as having two planes, one of which is called rough, the other smooth, both of which are kept down to the face of the board by a tool-bearer, and are moved backward and forward by a crank motion. The rough plane is movable to and from the board, by being held to it by a spring; the smooth plane, or finisher, is immovable, principally, from the board, except to separate the shavings from it. The position of the board is edgewise, resting on the horizontal rollers—friction-rollers; and it is carried through by a pair of fluted cylinders or rollers, vertical, and parallel to each other; which rollers press upon each side of the board, one of which, the back one, is

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made to slide in its boxes, held up by a spring, and thus made to yield to the inequalities of the thickness of the board; another pair of rollers, holding the same vertical position, called discharging cylinders, neither of which is yielding, nor are they fluted; and to adjust the different thicknesses, the inventor suggests rollers of different diameters, and on an adjustable bed.

Any one can at once see that this is not an organization of machinery similar to Woodworth's machine. It is not the same principle, nor is it in substance like it. This remark is made in regard to the combination claimed by Woodworth, and not to all the elements of which that combination is formed. In the Manneville machine there is no combination of pressure-rollers with rotary cutters, as in Woodworth's; the cutters have a reciprocating motion, instead of a rotary one. Several of the elements in both machines are the same, but they are not so arranged as to act in the same manner or on the same principle.

Some of the witnesses for the defendants think, that from the two French patents the Woodworth machine might be constructed without invention; but these machines must be considered singly, and not together. In the defense it is alleged, in reference to Woodworth's machine, that "the same thing substantially was patented in France, in 1817 and 1818, by L. Roguin, and in 1825 by Manneville. The defense, in this respect, is not sustained, as neither of the patents is substantially the same as Woodworth's.

The next point for consideration, is whether, in the amended specifications of Woodworth's patent, in 1845, a new invention was claimed, not embraced in the original patent.

It must be admitted, that the subject-matter of the new patent is the same. The patent was surrendered, to correct defective specifications, which did not result from any fraudulent intent. This right was secured to the patentee by the thirteenth section of the Patent Act of 1836; and on an application to the Commissioner of Patents, he, finding there had been no fraud, a new patent was issued for the same invention, more accurately described, as the law authorized.

In the case of *Woodworth v. Stone*, 3 Story, 749, and *Allen v. Blunt*, Id., 742, it was held, that the action of the Commissioner, in accepting a surrender of a patent and issuing a new one, concluded the parties, unless fraud be shown. And in *Stimpson v. West Chester Railroad*, 4 Howard, 380, this court say: "In whatever manner the mistake or inadvertence may have occurred, is immaterial. The action of the government in renewing the patent must be considered

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as closing this point, and as leaving open for inquiry, before the court and jury, the question of fraud only.

The corrected specifications of the new patent, on a surrender, would necessarily be different from those that were defective. And it is the duty of the Commissioner not to permit a new invention to be claimed under the pretense of correcting defective specifications.

Some things are omitted in the new patent which were claimed in the old one. But the principal objection on this ground seems to be that pressure-rollers were claimed in the new patent, and were not claimed in the old one. This is a mistake, as has already been shown. These rollers were represented in the drawings, and in that way were more accurately described than they could have been by a written specification. These drawings are a part of the patent. It does not appear that the corrected specifications embrace a new invention not included in the original patent.

The third and last point is whether the defendants' machine is an infringement of the plaintiffs'.

In the opinion of the Circuit Court in this case, it is said: "The defect in the Hill machine was, that it did not reduce the board to a uniform thickness. This desideratum the plaintiff has obtained by an improvement for which he was entitled to a patent. The defendant has accomplished the same purpose without using the improvement of the plaintiff, but merely by a new invention of his own, and therefore does not infringe."

From these remarks, it would seem that the Circuit Court considered Woodworth as entitled to a patent "for reducing boards to a uniform thickness," but that his patent does not cover it. In this the Circuit Court was mistaken, as I shall endeavor to show, in fact and in law.

It is not controverted that Woodworth's combination of machinery does reduce boards to an equal thickness. He did not, and could not, claim a patent for reducing a board to a uniform thickness; for an exclusive right could not be given for such a result. For centuries, boards have been reduced to a uniform thickness by hand-planes, and perhaps by other means. What, under the Patent Law, could Woodworth claim? He had a right to claim, as he did claim, a combination of machinery which would produce such a result. Was it necessary, in the summing up of his claim, which is done to distinguish what he has invented from parts of his machine which he has not invented, that he should claim the combination of his machine for the purpose of reducing boards to a uniform thickness? This would have limited his invention to that purpose, when it was

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applicable, and was intended to be applied, to that and many other purposes.

By the sixth section of the Patent Law of 1836, an inventor is required to describe his invention, in every important particular, in his application for a patent, so as to enable those skilled in the art or science to which it appertains to make, construct, compound, and use the same; and if the invention be a machine, he is required to state "the several modes in which he has contemplated the application of the principle or character by which it may be distinguished from other inventions"; and "shall particularly specify and point out the part, improvement, or combination which he claims as his own invention and discovery." He is required to accompany the whole with a drawing; and if a machine, a model, &c.

Is it not clear that Woodworth has explained the principle, and the several modes in which he has contemplated the application of the principle, or character of his machine by which, in the language of the act, it may be distinguished from other inventions? The plank is planed, tongued, and grooved by an organization of machinery unknown before. This is all, in the summing up, which the act requires.

It is objected that Woodworth does not include in his claim that of reducing a plank to a uniform thickness. The invention consists in the means through which this is done. A result or an effect is not the invention. This appears to have been the turning-point in the opinion of the Circuit Court.

But Woodworth has, in the specifications of his machinery, stated that the board is necessarily reduced to a uniform thickness. He says: "The edges of the plank, as its planed part passes the planing-cylinder, are brought into contact with the above-described tonguing and grooving wheels, which are so placed upon their shafts as that the tongue and groove shall be left at the proper distance from the face of the plank, the latter being sustained against the planing-cylinder by means of the carriage or bed-plate, or otherwise, so that it cannot deviate, but must be reduced to a proper thickness, and correctly tongued and grooved." Here Woodworth describes the combined operation of planing, tonguing, and grooving; and by which the plank is reduced to a proper thickness, that is, the required thickness; "and correctly tongued and grooved," &c. This is the effect of his machine in planing boards, clearly described.

He says the board is kept against the planing-cutters by means of the carriage or bed-plate, or otherwise. The pressure-rollers are claimed in his specification written, and also in his drawings, which

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show how they are to be applied. He also says: "Fig. 7 represents the same machine with the axis of the planing-cylinder placed horizontally, and intended to operate on one plank only at the same time; A A is the frame; B B the heads of the planing-cylinder; C C the knives or cutters attached to said heads, to meet the different thicknesses of the plank. The bearings of the shaft of the cylinder may be made movable, by screws or other means, to adjust it to the work, or the carriage of the bed-plate may be made so as to raise the plank up to the planing-cylinder."

The patent of the defendants was issued February 12, 1850. It is alleged to be an improvement upon Hill's machine. That machine, from the description, consisted of a planing-cylinder, a platform bench, with an aperture in it, through which the planing-cutters operated, so as to cut away any required thickness from the surface of the plank subjected to its action; the relation of the cylinder to the bench was permanent; a spring plate bore upon the plank nearly opposite to the cylinder, and forced it towards the cylinder and bench; feeding-rollers carried the plank forward, the same as in Woodworth's machine.

By this operation a stratum of equal thickness was cut from the plank, leaving a smooth surface, but not removing the inequalities of the board. The combination of machinery was different in principle from Woodworth's, and consequently the result was different.

Norcross says his invention is an improvement of Hill's machine, and "renders it capable of reducing or planing a board to an equal thickness throughout its length." He says: "Hill's machine was capable of planing or reducing a board on one side, or removing from such side a stratum or layer of wood of an equal thickness," but this did not make the board of uniform thickness.

The amended machine contains rotatory planes, which cut from the planed to the unplaned surface of the plank; an adjustable bar and rest is at a fixed distance from the cutting action of the planes; the rotating planes and this rest-bar were so connected together in a separate frame as to move vertically with the frame, and is borne downwards by their weight; two bars, one before and the other behind the rotating planes, and on the face of the plank cut by them, to cause its opposite face, in its progress through the machine, of whatever thickness and however warped, to pass in contact with the rest-bar, F. One of the said bars is termed a platform, B, and the distance between this and the rest-bar, F, is variable and self-adjusting to the varying thickness of the plank before it is planed, and the other, called a horizontal-bar or throat-piece, G, placed at the same

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Dissenting opinion.

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distance from the rest-bar, F, as the line of the cutting action of the rotating planes, to act on the face of the plank which has been planed, and insure the contact of the opposite and unplaned face with the rest-bar, F.

Norcross says: "What I claim as my invention is the combination of the rotatory planing-cylinder, E, and the rest, F, with mechanism by which the two can be freely moved up or down, simultaneously and independently of the bed or platform, B B, or any analogous device, substantially in the manner and for the purpose of reducing a board to an equal thickness throughout its length, all as hereinbefore specified."

"I also claim the above-described improvement of making the under side of the rest concave, in combination with so extending the part B under the rest, F, and applying it to the concave part thereof, as to cause the board, as it passes across the rest, to be bent, and presented with a concave surface to the operation of the rotatory cutter planing-cylinder, substantially as specified."

This organization of machinery seems to be the same in principle as that of Woodworth's, and produces the same result. If the concave surface of the board on which the cutters operate be an improvement, or any other slight change has been made, which may be an improvement on Woodworth's machine, that would give the defendants no right to use it without a license.

The difference between the machines appears to be this: The rotating planes and the plate or bed of Woodworth's are stationary in the main frame, and the roller or analogous device on that face of the plank to be planed is movable toward and from the plate or bed, to suit the varying thickness of the plank; while in the Norcross machine two bars are substituted for the pressure-rollers, and instead of making the one which acts on the plank before it is planed movable, to suit the varying thickness of the plank, it is fixed permanently in the main frame; and the rotating planes and the plate or bed, termed by him the rest-bar, F, are connected together in a separate frame, and together move up and down, to adapt themselves to the inequalities in the thickness of the plank.

Norcross has made that part of his machinery movable, which in the Woodworth machine is fixed; and that which is movable in the Woodworth machine, he has made permanent. These changes, and the reversal of Woodworth's machine, is the difference in their structure. A cast of the eye on the models will satisfy a machinist of the truth of this representation.

Whether the cutting-cylinder operates above or below the bench

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Statement of the case.

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on which the plank is laid, can be of no importance; nor is the difference material, whether a pressure-roller varies to suit the variable thickness of the plank, or the planing-cylinder, connected permanently with the bench, shall be elevated or depressed to accomplish the same object. These devices, though different in form, are the same in principle, and produce the same effect.

I think there is an infringement, and that the decree of the Circuit Court should be reversed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Massachusetts, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

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ERASTUS CORNING AND JOHN F. WINSLOW, PLAINTIFFS IN ERROR, v.  
PETER A. BURDEN.

(15 Howard, 252.)

1. In a suit brought for an infringement of a patent-right, the defendant ought to be allowed to give in evidence the patent under which he claims, although junior to the plaintiff's patent.
2. Burden's patent for "a new and useful machine for rolling puddlers' balls and other masses of iron, in the manufacture of iron," was a patent for a machine, and not a process, although the language of the claim was equivocal.
3. The difference explained between a process and a machine.
4. Hence, it was erroneous for the Circuit Court to exclude evidence offered to show that the practical manner of giving effect to the principle embodied in the machine of the defendants was different from that of Burden, the plaintiff; that the machine of the defendants produced a different mechanical result from the other, and that the mechanical structure and mechanical action of the two machines were different.
5. Evidence offered as to the opinion of the witness upon the construction of the patent, whether it was for a process or a machine, was properly rejected.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Northern District of New York.

Peter A. Burden, as assignee of Henry Burden, brought his action against Corning and Winslow for a violation of a patent granted to Henry, as the original and first inventor and discoverer of a new and useful machine for rolling puddle balls, or other masses of iron, in the manufacture of iron.



## Argument for the plaintiffs in error.

What took place at the trial is set forth in the opinion of the court. Under the instructions of the Circuit Court, the jury found a verdict for the plaintiffs, with one hundred dollars damages; upon which the defendants brought the case up to this court by a writ of error.

It was argued by *Mr. Seymour* and *Mr. Keller*, for the plaintiffs in error, and by *Mr. Fitzgerald* and *Mr. Stevens*, for the defendants in error.

Each one of the four counsel filed a separate brief. The points presented on the part of the plaintiffs in error are taken from the brief of *Mr. Seymour*, and those on the part of the defendant in error from the brief of *Mr. Stevens*.

*Points and Authorities submitted on the part of the Plaintiffs in Error.*

*First Exception to the Charge.*—The court erred in charging the jury that “the letters patent which have been given in evidence by the plaintiff are for a new process, mode, or method of converting puddlers’ balls into blooms by continuous pressure and rotation of the balls between converging surfaces, thereby dispensing with the hammer, alligator-jaws, and rollers, accompanied by manual labor, previously in use to accomplish the same purpose; and the said letters patent secure to the patentee the exclusive right to construct, use, and vend any machine adapted to accomplish the objects of his invention, as above specified, by the process, mode, or method above mentioned.”

I. The court erred in charging the jury that Burden’s patent was for a new process, mode, or method.

A process or mode may be patented. *Curtis*, pp. 65, 66, 67, 68, 69, 70, 71, 73, and cases there cited, from section 77 to 83.

1. Burden did not patent a process, but a machine.

What he designed to cover by his patent is to be gathered from the patent itself, the specification, and its summing up. Webster on Subject-Matter, p. 18, and note Z; *Davoll v. Brown*, 1 Wood. & Min., 59; *Russell v. Crowley et al.*, 1 Crompt. Mees. & Rosc., 864; *Moody v. Fiske*, 2 Mason, 112; *Rex v. Culler*, 1 Starkie, 283; *Le Roy v. Tatham*, 14 How., 156, 171; *Wyeth v. Stone*, 1 Story, 285; *Gray v. James*, Peters, 394–400; Mr. Justice Nelson’s opinion in Appendix A, annexed.

2. Burden’s patent claims that he has invented a new and useful machine, &c., not a process.

3. The specification, which purports to be a part of the letters patent, states the invention to consist in a “machine,” not in a process.

4. The summing up of the specification or the claim is substantially for a "machine."

And he specifies three modes of applying the principle of his invention; thus complying with the requisition of the sixth section of the act of 1836, in reference to all patents for machines, and for machines only.

The preparing of puddlers' balls is not claimed as an invention, nor could it be, for it is as old as the art of making iron by the process of puddling. See *Encyclopædia Americana*, vol 7, art. Iron, p. 72. The preparing puddlers' balls by pressure is not claimed, for that, too, is old. *Id.* But the claim is for the invention of the new mechanism for preparing puddlers' balls.

II. An invention, such as Burden's is described to be in the patent and specification, is, upon the authority of elementary works and the decisions of our courts, a machine, and not a process.

The distinction between a patent for a machine and a patent for a process is well known.

1. A patent for a machine is defined by Curtis, section 93, as follows: "If the subject of the invention or discovery is not a mere function, but a function embodied in some particular mechanism, whose mode of operation and general structure are pointed out, and which is designed to accomplish a particular purpose, function, or effect, it will be a machine in the sense of the Patent Law."

If the specification describes "not a mere function, but a machine of a particular structure, whose modes of operation are pointed out to accomplish a particular purpose or end, the patent is for a machine, and not for a principle or function detached from machinery." *Blanchard v. Sprague*, 3 Sumn., 540.

A method or process may be the subject of a patent. See Phillips, pp. 93, 94; Curtis, secs. 80, 81.

Among the cases cited (see Curtis, sec. 79) of patents for a method, or, as the writer expresses it, "for the practical application of a known thing to produce a particular effect," are—

Hartley's invention to protect buildings from fire, by the application of plates of metal. See, also, Webster's Patent Cases, pp. 54, 55, 56, and note, pp. 55 and 56.

Forsyth's patent for the application of detonating powder, which he did not invent, to the discharge of artillery, mines, &c.

In this case the patentee succeeded in an action against the party using a lock of different construction from any shown in the drawing annexed to his specification; and, as Curtis says, "thus established his right to the exclusive use and application of detonating powder

## Argument for the plaintiffs in error.

as priming, whatever the construction of the lock by which it was discharged." Webster's Patent Cases, pp. 95, 97, note.

Hall's patent, for the application of the flame of gas to singe off the superfluous fibres of lace and other goods, is another of this class. Webster's Patent Cases, p. 99.

The plaintiff had a verdict, founded on his sole right to use gas-flame for the clearing of fibres from lace. Curtis, p. 67, note; Webster's Patent Cases, pp. 100, 103; *Neilson v. Harford*, Id., 191, &c.; *Neilson v. Thompson*, Id., 275; *The Househill Co. v. Neilson*, Id., 673; *Boulton v. Bull*, 2 H. Blackst., 492; Clegg's Patent, Web. Pat. Cases, 103; Morse's Patents; *Mc Clurg v. Kingsland*, 1 How., 202; *Russell v. Cowley*, Web. Pat. Cases, 459.

2. The preparing a puddler's ball is reducing and compacting it by pressure into the form of a bloom. See *Encyclopædia Americana*, vol. 7, art. Iron, p. 72; *Nicholson's Op. Mechanic*, pp. 334-335; *Ure's Dic. of Arts and Manufactures*, p. 703.

If Burden's claim, then, is for the reducing and compacting the ball by pressure into the form of a bloom, it is a claim for a process long before known in the manufacture of iron, and would, therefore, be void, for want of novelty.

To avoid this difficulty, the statement of the claim goes on to say that he claims the preparing these balls by causing them to pass between curved or plane surfaces, in the manner described in his drawings and in the specification of the several parts of the machine.

If the words, "the particular method of the application," were correctly held, in *Wyeth v. Stone*, before cited, to mean the particular apparatus and machinery described in the specification, is not the claim for preparing puddlers' balls, by causing them to pass through a certain machine, as clearly a claim for the invention of the machine?

*Wyeth* claimed not only the art or principle of cutting ice of a uniform size, but "the particular method of the application of the principle"; and this last part of the claim was held to be the only valid part of it, and to be a claim of the particular apparatus and machinery described in the specification to effect the purpose of cutting ice.

So Burden's patent, if it be sustained at all, must be held to be a patent for the particular apparatus and machinery described in the specification to effect the "preparing the puddlers' balls." See, also, the case of *Blanchard v. Sprague*, 3 Sumn., 535.

It was objected, on the trial in this last case, "that the plaintiff's specification was defective; that he claimed the functions of the machine, and not the machine itself."

.Argument for the plaintiffs in error.

Mr. Justice Story (at page 540) says: "Looking at the present specification, and construing all its terms together, I am clearly of opinion that it is not a patent claimed for a function, but it is claimed for the machine specially described in the specification; that it is not for a mere function, but for a function as embodied in a particular machine, whose mode of operation and general structure are pointed out."

If to claim a "method" or mode of operation in the abstract, explained in the description of certain machinery, be a claim for a machine, as was adjudged in *Blanchard v. Sprague*, is not the claim of preparing puddlers' balls by the operation of certain machinery, much more a claim of a machine? In other words, is the claim of a particular result before known, from the operation of a machine claimed to be new, anything else than a claim for the peculiar construction of the machine itself, by which that result is effected?

3. Again, the result claimed by Burden is to produce a bloom from a puddle ball by pressure, welding together the particles of iron, and expressing in part the impurities, and partly shaping the mass for the after operation of converting it into bars, also by pressure.

It cannot be pretended that Burden invented this, or any part of it. This was all done, before his invention, under the hammer and the alligator-jaws. But it may be said that he invented an improvement in this process. This cannot be; for he only compresses the mass to cement the particles, express the impurities, and give shape. All this was done before by the hammer and the jaws, and, in the opinion of many, better done than he does it.

4. Again, it may be said that he made an improvement in the operation by making it continuous. This brings the matter to a true test, and shows that it is the invention of a machine to render the operation continuous, which before had been intermittent.

5. It may be claimed that he has invented or introduced the element of self-action. This establishes the defendant's proposition, that Burden's patent is only for a machine; for the meaning of this is, as the term self-action must be predicated of material substances, that he has substituted an organization of machinery to perform automatically what was before performed partly by hand and partly by machinery. Machines for nail cutting, making hook-head spikes, carding and spinning, weaving, felting, are self-acting machines, which have been invented to carry on known processes; all have the element of self-action, and yet all of them have been recognized as machines, and not processes.

III. The plaintiff, in his declaration, counts upon his patent as a

patent for a machine only, and not for a process. He ought to be permitted to recover only *secundum allegata et probata*.

IV. But suppose the patent be for a process and not for a machine; then we submit that the court erred in sustaining the patent as a patent for a new process of preparing puddlers' balls, by continuous pressure and rotation of the balls between converging surfaces.

1. For this process itself is a well-known and common process in the arts, and, therefore, could not be patented at the time of the alleged invention.

The operation to which the puddlers' ball is subjected, that is, the process, produces common results, necessarily arising from pressure on all soft and porous substances, to wit, condensation, expression of matter, and change of form.

2. All the experts testify that Burden's invention consists in carrying on the old process of reducing a puddler's ball to a bloom by pressure, created and continued by his machinery.

That the machinery by which such pressure may be applied is patentable, is obvious. But aside from the peculiar construction of Burden's machinery, there is nothing new in its application. It is merely the application of a known mode of operation in the arts to produce a known result—that is, mechanical pressure, to produce a bloom out of a puddler's ball. See Curtis, p. 78, sec. 88.

That this form of applying mechanical pressure is not new, was proved-by, &c.

3. Notwithstanding the condition embodied in the second proposition contained in the charge of the court,—as follows, “The machines for milling buttons, milling coin, and rolling shot, which have been given in evidence by the defendants, do not show a want of novelty in the invention of the said patentee, as already described, if the processes used in them, the purposes for which they were used, and the objects accomplished by them were substantially different from those of the said letters patent,”—yet, taken in connection with the construction given by the court to the patent in the first proposition contained in the charge, the defendants were deprived of the defense to which they were entitled, to wit, that the reducing puddlers' balls to blooms, by their rotation and pressure between converging and continually-approximating surfaces, was but a double use of a process or machine long before used in milling buttons, milling coins, and rolling shot.

For the court had decided, in the first proposition of the charge, that Burden's patent was “for a new process of converting puddlers'

balls into blooms, by continuous pressure and rotation of the ball between converging surfaces."

In other words, that the application by the plaintiff's machine to the puddler's ball, of the old method of reducing and compacting metals by the continuous pressure of converging surfaces, constituted such a novel process in the manufacture of iron that (its utility not being questioned) the plaintiff's patent was good, notwithstanding the previous use of the milling-machine on copper, silver, and gold, and of the shot-machine on lead, in compacting and reducing those metals by the rotation of the metals and the continuous pressure of converging surfaces.

4. Burden's patent is clearly a case of double use. See Curtis on Patents, sec. 85 to 89, and notes and cases therein cited; *Losh v. Hague*, Webster's Patent Cases, 207; *Howe v. Abbott*, 2 Story, 190-193.

To this defense the defendants were clearly entitled. The processes of milling the coin, finishing the edges of the buttons, making the shot or balls, and making the blooms are strictly identical.

V. The court erred in charging the jury as they did in the latter clause of the first proposition contained in the charge, to wit: "And the said letters patent secure to the patentee the exclusive right to construct, use, and vend any machine adapted to accomplish the objects of his invention, as above specified, by the process, mode, or method above mentioned."

Also in laying down the third proposition in his charge, to wit: "That the machine used by the defendants is an infringement of the said letters patent, if it converts puddlers' balls into blooms by the continuous pressure and rotation of the balls between converging surfaces, although its mechanical construction and action may be different from that of the machines described in the said letters patent."

Also in excluding the testimony offered by the following question, to wit: "By changing the form of the rolling surfaces in Mr. Winslow's machine, can it be made to roll a sphere?"

Also the testimony offered as follows: "The counsel for the defendants then offered to prove by this witness that the machine used by the defendants differed, in point of mechanical construction and mechanical action, from the machines described in Burden's specification."

All these propositions were thus erroneously adjudged against the defendants, as a sequence or corollary following from the first main proposition which the court had laid down against the defendants, to wit, that the plaintiff's patent was for a process, and not for a

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Argument for the plaintiffs in error.

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machine. The court in substance held, that, although the mechanical construction and action of the defendant's machine might be different from that of the plaintiff's, it was still an infringement if it reduced the balls to blooms by continuous pressure and rotation.

This was an erroneous position; for one thing was certain: we had the right to reduce puddlers' balls to blooms by any machine having a different action from that of the plaintiff's. *Curtis*, sec. 96, n. 2; *Whittemore v. Cutter*, 1 Gallison, 478-491; *Barrett v. Hall*, 1 Mason, 470.

In the light of these authorities, proof of different mechanical construction and different action was competent and highly pertinent to establish "a peculiar structure," and the production of a new effect.

VI. The court erred in excluding the evidence offered to be given by the witness Hibbard, to wit: "That the practical manner of giving effect to the principle embodied in the machine used by the defendants was entirely different from the practical manner of giving effect to the principle embodied in Mr. Burden's machine; that the principle of the two machines, as well as the practical manner of carrying out those principles, was different; and that the machine used by the defendant produced by its action on the iron a different mechanical result, on a different mechanical principle, from that produced in Burden's machine."

The witness was an *expert*, and no objection was urged on that score, or to the form of the question. *Silsby v. Foote*, 14 How., 218, 225.

This offer embraced legitimate proof tending to establish a general proposition material to the issue, to wit:

That the defendant's machine was constructed on a different principle, or had a different mode of operation from the plaintiff's.

Proof that the principle of one machine was different from that of the other was tantamount to proof that their mode of operation was different; for two machines, different in principle, cannot well have the same mode of operation, although they may produce the same result.

But the defendant not only offered to prove that the machines were different, but also that they produced on the iron a different mechanical result. See *Curtis on Patents*, p. 264, sec. 222; also, p. 285; also, p. 286, sec. 241.

In conclusion, the court, in this case, should have held that the plaintiff's patent was for a machine. And on the question of novelty, the court should have left it to the jury as a question of fact, to find upon the testimony whether the plaintiff's machine was the same

## Argument for the defendant in error.

in its principle or *modus operandi* as the milling, button, or shot machine. And on the question of infringement, the court should have left it to the jury, upon the testimony, to find whether the defendant's machine was the same in its distinctive character or principle as the plaintiff's.

*Brief on the part of Defendant in Error.*

*First.* The whole question in this cause depends upon the correctness of the construction contended for by the counsel for the defendant in error, and which the judge gave to the patent on the trial. If this construction be correct, the other two instructions given by the learned judge to the jury are also correct, and follow as necessary corollaries. Curtis on Patents, secs. 146, 147, 148.

*Second.* The construction of the patent given by the court on the trial, by the first instruction to the jury, was correct.

I. The *patent* (that is, the parchment) made out at the Patent Office, by the proper officer in that department, does not in any case, according to the Patent Law of this country, describe the thing patented. To ascertain the thing patented, the specification, which is filed before the patent is issued, is the test in all cases as to what the patent secures to the patentee; and to ascertain that, the whole specification must be consulted; and the modern decisions have declared that a liberal construction must be given to it in favor of the patentee. Patent Act of 1836, sec. 5; Curtis on Patents, sec. 122, 123, 126, 127; *Ames v. Howard*, 1 Sumn., 482, 485; *Hogg v. Emerson*, 6 How., 437, 482; *Davoll v. Brown*, 1 Wood. & Min., 53, 57.

It is undoubtedly true, if the description or title of the invention, as stated in the patent, is irreconcilably repugnant to the description of the invention contained in the specification, as if the description in the patent be a machine for making nails, and the invention described in the specification is of a machine for carding wool, the patent would be void, upon the ground that the government had not given to the patentee a legal exclusive title to his invention. But nothing can be deduced from this principle of law to sustain the position that the invention is only what it is stated to be in the title stated in the patent; but, on the contrary, the very reverse of that position is what renders the patent void in such cases.

In this case there is no such repugnancy. True, the patent states the invention to be of a new and useful machine for rolling puddle balls, &c., but this is not so repugnant to the description of the invention contained in the specification as would preclude the court from adjudging that the government intended to and did grant the patent



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Argument for the defendant in error.

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for the invention described in the specification, to wit, for an improvement in the process, &c. Unless the title of the invention described in the patent is clearly repugnant to the description of the invention in the specification, the patent will be deemed to be a grant of the exclusive right to the invention described in the specification, but it cannot diminish the extent of the invention described and claimed in the specification.

In short, the description of the invention in the specification is the act of the inventor, for which, if it be new and useful, the government is bound to grant him a patent. The granting of the patent is the act of the government, and if the description in that grant be not clearly repugnant to that which the inventor claimed and was entitled to, it will be deemed to be a grant of the thing to which he was entitled.

II. By any just or legal construction of the specification forming a part of the patent in question, and giving the only description of the invention for which the patent issued, said patent is for a new process, mode, or method of converting puddlers' balls into blooms by continuous pressure and rotation of the ball between converging surfaces, thereby dispensing with the hammer, alligator-jaws, and rollers, accompanied with manual labor, previously in use to accomplish the same purpose, and is not confined to the particular machines described in the specifications and drawings.

The specification commences in these words: "To all to whom it may concern: Be it known, that I, Henry Burden, of the city of Troy, in the county of Rensselaer, and State of New York, have invented an improvement in the process of manufacturing iron." Now, let us here pause for an instant, to inquire, if the patentee really intended to represent his invention as one consisting in a new or improved machine, to be used in the manufacture of iron, why, with his thoughts upon the subject, did he not say so, instead of calling it an "improvement in the process of manufacturing iron"? I confess my utter inability to divine any reasonable answer to this question. The improbability of such a willful misnomer is greatly enhanced by the conceded and well-known fact that a new or improved process is patentable, no less than a new or improved machine. Process or method, which in the Patent Law are said to be synonymous, are among the few words in familiar use, machine being another of these words, expressive of the few proper subjects of a patent; so that to hold this to be a patent for a machine, is to impute to the patentee the absurdity not only of omitting to call his invention by its proper name, but of substituting at the outset another name of well-known

signification in law, expressly appropriated to another and widely different subject of a patent.

But the specifications contain other expressions which are in strict accordance with the language already quoted, and require the same interpretation. After particularly and clearly describing the process in question, and the means by which it is accomplished, the patentee proceeds as follows: "It will be readily perceived also, by the skillful machinist, that the principle upon which I proceed may be carried out under various modifications, of which I have given two examples; and these might be easily multiplied, but this is not necessary, as I believe that those which have been given must suffice to show, in the clearest manner, the nature of my invention, and point out fully what I desire to have secured to me under letters patent of the United States." Does this look like only claiming to be the inventor of a specific machine? On the contrary, the patentee refers to the descriptions he has given of the mechanical contrivances by which his process may be carried on, as illustrative only of the "principle" on which he "proceeds"; and, referring to the two machines thus described, he adds, "and these might be easily multiplied." Does this language import an intention to limit his claim to them? But an equally decisive test of the patentee's claim remains yet to be considered. His specification concludes with a summary. "In order to ascertain the true construction of the specification in this respect, we must look to the summing up of the invention, and the claim thereof asserted in the specification; for it is the duty of the patentee to sum up his invention in clear and determined terms; and his summing up is conclusive upon his right and title." *Wyeth v. Stone*, 1 Story, 273, 285.

The patentee's summary is as follows: "Having thus fully made known the nature of my said improvement, and explained and exemplified the manner in which I construct the machinery for carrying the same into operation, what I claim as constituting my invention, and desire to secure by letters patent, is the preparing of the puddlers' balls as they are delivered from the puddling furnace, or of other similar masses of iron, by causing them to pass between a revolving-cylinder and a curved segmental trough adapted thereto, constructed and operating substantially in the manner of that herein described and represented in figures 2 and 3 of the accompanying drawings, or by causing the said balls to pass between vibratory or reciprocating curved surfaces, operating upon the same principle, and producing a like result by analogous means."

Now, by his "improvement," mentioned at the commencement of

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Argument for the defendant in error.

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this summary, it is indisputable that the patentee means his invention; and this he describes as being carried into operation by means of machinery constructed for the purpose. With what propriety, then, can it be said that the invention claimed is of the machinery itself? "What I claim," he adds, "as constituting my invention, is the preparing of the puddlers' balls," &c. Is the process of preparing puddlers' balls a machine? If not, is it not a flat contradiction of the language of the patentee to say that he claims to be the inventor of a machine, and not of a process? And what is there in the other parts of the specification to neutralize this explicit and unequivocal language? It is said that the patentee describes and has furnished drawings representing two several machines used by him, the one in his first essays, and the other subsequently. This is true; and it is also true that the two are wholly different, not only in form, but in mechanical construction, having in fact nothing in common, except their mutual adaptation to a like process and effect.

Besides, the court will please to observe that the specification claims no particular form of apparatus for carrying his mode or method of converting puddlers' balls into blooms into effect. The patent cannot, therefore, be construed as confining the invention to the two particular machines which he has described that would accomplish that mode, method, or process. Curtis on Patents, secs. 80, 81; *Minter v. Wells*, Webster's Patent Cases, 130.

The specification should be so construed as to make the claim co-extensive with the actual discovery, if the fair import of the language used will admit of it. Curtis on Patents, sec. 132.

III. The patent is not for a principle merely, but for a mode, method, or process, giving two practical means for accomplishing it.

The patentee shows, by his specification, that he had succeeded in embodying the principle, by inventing some mode of carrying it into effect, and thus converting it into a process. "You cannot," said Alderson, B., in *Jupe v. Pratt*, Webster's Patent Cases, 146, "you cannot take out a patent for a principle. You may take out a patent for a principle coupled with a mode of carrying the principle into effect. If you have done that, you are entitled to protect yourself from all other modes of carrying the same principle into effect, that being treated by the jury as a piracy of your original invention."

"A mere principle," says Mr. Curtis, "is an abstract discovery; but a principle so far embodied and connected with corporeal substances as to be in a condition to act and produce effects in any art, trade, mystery, or manual occupation, becomes the practical manner of doing a practical thing. It is no longer a principle, but a pro-

cess." Curtis on Patents, sec. 72; see, also, secs. 77, 78, and notes, pp. 59, 66.

With the requirements of the law in this respect, the patentee has complied in a manner perfectly unexceptionable, and perfectly consistent with the construction of his patent insisted on by the plaintiff. There is not, in the specification, a single expression indicative of an intention to limit his claim, as an inventor, to one or both of the machines described by him; while, on the contrary, the language plainly infers a fixed purpose to guard against such an interpretation. Curtis on Patents, sec. 148, and note 1.

IV. If this construction of the patent is correct, it necessarily follows that the patent protects the patentee from all other modes of carrying the same mode, process, or method into effect, which is in substance and effect the principle held by the judge in the last clause of his first instruction to the jury. *Jupe v. Pratt*, Webs. Pat. Cases, 146; Curtis on Patents, sec. 148, and note 1.

*Third.* The rejection of the evidence offered on page 84 of the record constitutes no ground of error.

I. The decision, if wrong, was cured by the evidence of the same facts afterwards elicited from the witnesses.

II. If the construction of the patent contended for by plaintiff below, and held by the court, is correct, the testimony was properly excluded. *Jupe v. Pratt*, Webs. Pat. Cases, 146, *supra*; Curtis on Patents, sec. 148, and note 1.

*Fourth.* The decision excluding the evidence of Winslow's patents was clearly right.

If the machine used by defendant was an infringement of plaintiff's patent, the fact that Winslow had obtained a patent for it would be no defense; and if it was not an infringement of plaintiff's patent, it was not material in this suit whether it had or had not been patented.

*Fifth.* In the argument in the court below, on the motion for a new trial on this bill of exceptions, the counsel for the defendants objected that there was a variance between the declaration and the patent given in evidence, unless the court held the patent was for a particular machine or machines. That objection was, however, justly and legally disregarded by both members of the court in their decision of the motion.

The objection is technical; and it is entirely settled by the practice of the State of New York that such objection cannot avail the party, unless taken when the evidence is offered.

No such objection was taken on the trial of this cause, nor was there

any decision of the court, or any exception on any such question, raised on the trial. *Watson's Executors v. McLarien*, 19 Wend., 563.

Many other authorities might be cited, but it is unnecessary. The member of this court from the State of New York knows this to be the rule, and both the judges of the court below disregarded the objection.

Besides, if the objection had been made at the trial that the patent given in evidence varied from that described in the declaration, the court would have directed the declaration to be amended, by substituting the word process in the place of machine. The defendants could not have been misled or prejudiced by such inaccuracy of description. 2d Revised Statutes of New York, 3d ed., p. 504, sec. 98, p. 520, sec. 7, subdivision 14, and sec. 8; 2d Revised Statutes of New York, 4th ed., p. 510, secs. 169, 170.

*Sixth.* No question as to the novelty of the invention for which this patent was issued is presented by the record in this cause, except that contained in the second instruction of the judge to the jury. That instruction was right in point of law, and the jury found the fact with the plaintiff below (defendant in error).

Mr. Justice GRIER delivered the opinion of the court.

Peter A. Burden, who is assignee of a patent granted to Henry Burden, brought this suit against the plaintiffs in error for infringement of his patent. The declaration avers that Henry Burden was "the first inventor of a new and useful machine for rolling puddle balls," for which a patent was granted to him in 1840, and that the defendants, Corning and Winslow, "made, used, &c., this said new and useful machine, in violation and infringement of the exclusive right so secured to plaintiffs."

The defendants below, under plea of the general issue, gave notice that they would prove, on the trial, that Henry Burden was not the first and original inventor of the supposed new and useful machine for rolling puddle balls," &c.; that the machine of the plaintiff, and the principle of its operation, was not new, and that the common and well-known machines called nobbling-rolls, which were in use long before the application of Burden for a patent, embraced the same invention and improvements used for substantially the same purpose; and after setting forth many other matters to be given in evidence, affecting the novelty of plaintiff's machine, the notice denies that the machine used by the defendants was an infringement of that patented by plaintiff, and avers that the machine used by them was described in a patent issued to the defendant Winslow, in December, 1847,

“for rolling and compressing puddlers’ balls,” differing in principle and mode of operation from that described in the plaintiff’s patent.

To support the issue in his behalf, the plaintiff gave in evidence a patent to Henry Burden, dated 10th of December, 1840, for “a new and useful machine for rolling puddlers’ balls and other masses of iron, in the manufacture of iron,” and followed it by testimony tending to show the novelty and utility of his machine, and that the machine used by the defendants was constructed on the same principles, and there rested his case.

The defendants then offered to read in evidence the patent of Winslow for his “new and useful improvement in rolling and compressing puddlers’ balls.” The plaintiff objected to this evidence as irrelevant, and the court sustained the objection and overruled the evidence. This ruling of the court forms the subject of defendant’s first bill of exceptions.

The defendants then proceeded to introduce testimony tending to show want of originality in the plaintiff’s machine; and, also, that the principle and mode of operation of the defendants’ machine was different from that described in the plaintiff’s patent; and finally called a witness named Hibbard. This witness gave a history of the various processes and machines used in the art of converting cast iron into blooms or malleable iron. He spoke of the processes of puddling, shingling, and rolling, and attempted to define the difference between a process and a machine. The introduction of this philological discussion seems at once to have changed the whole course of investigation, to the entire neglect of the allegations of the declaration and of the issues set forth in the pleadings, in support of which all the previous testimony had been submitted to the jury. The defendants’ counsel then proposed the following question to the witness: “Do you consider the invention of Mr. Burden, as set forth in his specification, to be for a process or a machine?” This question was objected to, overruled by the court, and a bill of exceptions sealed.

The counsel for the defendants then offered to prove, by this witness, “that the practical manner of giving effect to the principle embodied in the machine used by the defendants, was entirely different from the practical manner of giving effect to the principle embodied in Mr. Burden’s machine; that the principles of the two machines, as well as the practical manner of carrying out those principles, were different; and that the machine used by the defendants produced, by its action on the iron, a different mechanical result, on a different mechanical principle, from that produced in Mr. Burden’s machine.” To the introduction of this testimony the plaintiff’s counsel objected,

## Opinion of the court.

and it was overruled by the court, and, at the defendants' instance, a bill of exceptions sealed.

The defendants' counsel then proposed to prove "that the machine used by the defendants differed in point of mechanical structure and mechanical action from the machines described in the plaintiff's specification." This testimony was also overruled, and exceptions taken.

After some further examination of witnesses, the learned judge announced his intention of instructing the jury in the three following propositions, upon which the defendants' counsel declined to give further testimony, and excepted to his instructions:

"1. The letters patent to Henry Burden, which have been given in evidence by the plaintiff, are for a new process, mode, or method of converting puddlers' balls into blooms, by continuous pressure and rotation of the ball between converging surfaces, thereby dispensing with the hammer, alligator-jaws, and rollers, accompanied with manual labor, previously in use to accomplish the same purpose; and the said letters patent secure to the patentee the exclusive right to construct, use, and vend any machine adapted to accomplish the objects of his invention as above specified, by the process, mode, or method above mentioned."

"2. The machines for milling buttons, milling coin, and rolling shot, which have been given in evidence by the defendants, do not show a want of novelty in the invention of the said patentee, as already described, if the processes used in them, the purposes for which they were used, and the objects accomplished by them were substantially different from those of the said letters patent."

"3. That the machine used by the defendants is an infringement of the said letters patent, if it converts puddlers' balls into blooms by the continuous pressure and rotation of the balls between converging surfaces, although its mechanical construction and action may be different from those of the machines described in the said letters patent."

As the first instruction of the court contains the most important point in the case, and a decision of it will dispose of most of the others, we shall consider it first in order.

Is the plaintiff's patent for a process or a machine?

A process, *eo nomine*, is not made the subject of a patent in our act of Congress. It is included under the general term "useful art." An art may require one or more processes or machines in order to produce a certain result or manufacture. The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or re-

sult. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods, or operations are called processes. A new process is usually the result of discovery; a machine, of invention. The arts of tanning, dyeing, making water-proof cloth, vulcanizing India-rubber, smelting ores, and numerous others, are usually carried on by processes, as distinguished from machines. One may discover a new and useful improvement in the process of tanning, dyeing, &c., irrespective of any particular form of machinery or mechanical device; and another may invent a labor-saving machine, by which this operation or process may be performed, and each may be entitled to his patent. As, for instance, A has discovered that by exposing India-rubber to a certain degree of heat, in mixture or connection with certain metallic salts, he can produce a valuable product or manufacture. He is entitled to a patent for his discovery, as a process or improvement in the art, irrespective of any machine or mechanical device. B, on the contrary, may invent a new furnace, or stove, or steam apparatus, by which this process may be carried on with much saving of labor and expense of fuel, and he will be entitled to a patent for his machine, as an improvement in the art. Yet A could not have a patent for a machine, or B for a process; but each would have a patent for the means or method of producing a certain result or effect, and not for the result or effect produced. It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect that a patent is granted, and not for the result or effect itself. It is when the term process is used to represent the means or method of producing a result, that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.

But the term process is often used in a more vague sense, in which it cannot be the subject of a patent. Thus we say, that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively, as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means, or the use of a machine, as distinguished from a process.

In this use of the term it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine. But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it.

It is by not distinguishing between the primary and secondary



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sense of the term "process" that the learned judge below appears to have fallen into an error. It is clear that Burden does not pretend to have discovered any new process by which cast iron is converted into malleable iron; but a new machine or combination of mechanical devices, by which the slag or impurities of the cast iron may be expelled or pressed out of the metal when reduced to the shape of puddlers' balls. The machines used before to effect this compression were tilt-hammers and alligator-jaws, acting by percussion and pressure, and by nobbling-rolls with eccentric grooves, which compressed the metal by use of the inclined plane, in the shape of a cyclovolute or snail-cam. In subjecting the metal to this operation, by the action of these machines, more time and manual labor is required than when the same function is performed by the machine of Burden. It saved labor, and thus produced the result in a cheaper, if not a better, manner, and was therefore the proper subject of a patent.

In either case the iron may be said, in the secondary sense of the term, to undergo a process, in order to change its qualities, by pressing out its impurities; but the agent which effects the pressure is a machine or combination of mechanical devices.

The patent of Burden alleges no discovery of a new process, but only that he has invented a machine, and therefore correctly states the nature of his invention.

The Patent Law requires that "every patent shall contain a short description or title of the invention or discovery, indicating its nature and design," &c. The patent in question recites, that "Whereas Henry Burden, of Troy, New York, has alleged that he has invented a new and useful machine for rolling puddle balls, or other masses of iron, in the manufacture of iron, which he states has not been known or used before his application; has made oath that he is a citizen of the United States; that he does verily believe that he is the original and first inventor or discoverer of the said machine," &c.

The specification declares that his improvement consists in "the employment of a new and useful machine for rolling of puddlers' balls"; again, he calls it "my rolling-machine," and describes his "machine as consisting of a cast-iron cylinder," &c. In fine, his specification sets forth the "particulars" of his invention, in exact accordance with its title in the patent, and in clear, distinct, unequivocal, and proper phraseology.

It is true that the patentee, after describing his machine, has set forth his claim in rather ambiguous and equivocal terms, which might be construed to mean either a process or machine. In such case, the construction should be that which is most favorable to the

## Opinion of the court.

patentee, "*ut res magis valeat quam pereat.*" His patent having a title which claims a machine, and his specification describing a machine, to construe his claim as for the function, effect, or result of his machine, would certainly endanger, if not destroy, its validity. His claim cannot change or nullify his previous specification with safety to his patent. He cannot describe a machine which will perform a certain function, and then claim the function itself, and all other machines that may be invented to perform the same function.

We are of opinion, therefore, that the learned judge of the court below erred in the construction of the patent, and in his first proposition or instruction to the jury; and as the second and third instructions are based on the first, they must fall with it. Taking the bills of exception to rejection of evidence in the inverse order, it is clear that the last two rulings, being founded on the erroneous construction of the patent, are, of course, erroneous. The testimony offered was directly relevant to the issues trying, and should have been received.

The refusal of the court to hear the opinion of experts, as to the construction of the patent, was proper. Experts may be examined as to the meaning of terms of art, on the principle of "*cuique in sua arte credendum,*" but not as to the construction of written instruments.

It remains only to notice the first bill of exceptions, which was to the rejection of the defendants' patent.

This is a question on which there may be some difference of opinion. In some circuits, it has been the practice, when the defendant has a patent for his invention, to read it to the jury without objection. In others, it is not received, on the ground that it is irrelevant to the issue, which is a contest between the machine of the defendant and the patent of the plaintiff, and that a posterior patent could not justify an infringement of a prior one for the same invention.

By the Patent Act of 1793, any person desirous of obtaining a patent for an alleged invention, made application to the Secretary of State, and received his patent on payment of the fees, and on a certificate of the Attorney-General that his application "was conformable to the act." No examination was made by persons qualified to judge whether the alleged invention was new or useful, or had been patented before. That rested wholly on the oath of the applicant. The Patent Act of 1790 had made a patent *primâ facie* evidence; but this act was repealed by that of 1793, and this provision was not reenacted in it. Hence a patent was not received in courts

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of justice as even *prima facie* evidence that the invention patented was new or useful; and the plaintiff was bound to prove these facts, in order to make out his case. But the act of 4th of July, 1836, introduced a new system and an entire change in the mode of granting patents. It provided for a new officer, styled a Commissioner of Patents, to "superintend, execute, and perform all acts and things touching and respecting the granting and issuing of patents," &c. The Commissioner was authorized to appoint a chief clerk and three examining clerks, machinist, and other officers.

On the filing of an application, the Commissioner is required to make, or cause to be made, an examination of the alleged invention, in order to ascertain whether the same had been invented or discovered by any other person in this country prior to the application, or whether it had been patented in this or any foreign country, or had been on public use or sale, with the applicant's consent, prior to his application; and if the Commissioner shall find that the invention is new and useful, or important, he is authorized to grant a patent for the same. In case the decision of the Commissioner and his examiner is against the applicant, and he shall persist in his claim, he may have an appeal to a board of examiners, to consist of three persons appointed for that purpose by the Secretary of State, who, after a hearing, may reverse the decision of the Commissioner, in whole or in part. By the act of 1839, the Chief Justice of the District of Columbia was substituted to the board of examiners.

It is evident that a patent thus issued, after an inquisition or examination made by skillful and sworn public officers, appointed for the purpose of protecting the public against false claims or useless inventions, is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently, such a patent may be, and generally is, received as *prima facie* evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right; and if so, it is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor, arising from a like investigation of the originality of his invention, and the judgment of the public officers that his machine is new, and not an infringement of the patent previously granted to the plaintiff. It shows, at least, that the defendant has acted in good faith, and is not a wanton infringer of the plaintiff's rights, and ought not therefore to be subjected to the same stringent and harsh rule of damages which might be justly inflicted on a mere pirate. It is

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Syllabus.

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true, the mere question of originality or infringement generally turns on the testimony of the witnesses produced on the trial; but if the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his: *valeat quantum valeat*. The parties should contend on an equal field, and be allowed to use the same weapons.

We are of opinion, therefore, that the court erred in refusing to permit the defendant's patent to be read to the jury.

The judgment of the Circuit Court is, therefore, reversed, and a *venire de novo* awarded.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

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ROSS WINANS, PLAINTIFF IN ERROR, v. EDWARD, ADAM, AND TALBOT  
DENMEAD.

(15 Howard, 330.)

1. A patent was taken out for making the body of a burden railroad-car of sheet iron, the upper part being cylindrical, and the lower part in the form of a frustum of a cone, the under edge of which has a flange secured upon it, to which flange a movable bottom is attached.
2. The claim was this: "What I claim as my invention, and desire to secure by letters patent, is making the body of a car for the transportation of coal, &c., in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, and by which also the lower part is so reduced as to pass down within the truck-frame and between the axles, to lower the center of gravity of the load without diminishing the capacity of the car, as described. I also claim extending the body of the car below the connecting pieces of the truck-frame and the line of draught, by passing the connecting-bars of the truck-frame and the draught-bar through the body of the car, substantially as described."
3. This patent was not for merely changing the form of a machine, but by means of such change to introduce and employ other mechanical principles

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Argument for the plaintiff in error.

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or natural powers, or a new mode of operation, and thus attain a new and useful result.

4. Hence, where, in a suit brought by the patentee against persons who had constructed octagonal and pyramidal cars, the district judge ruled that the patent was good for conical bodies, but not for rectilinear bodies, this ruling was erroneous.
5. The structure, the mode of operation, and the result attained were the same in both, and the specification claimed in the patent covered the rectilinear cars. With this explanation of the patent, it should have been left to the jury to decide the question of infringement as a question of fact.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Maryland.

It was an action brought by Ross Winans for the infringement of a patent-right. The jury, under the instruction of the district judge, the late Judge Glenn, then sitting alone, found a verdict for the defendants; and the plaintiff brought the case to this court by a writ of error.

The nature of the case is set forth in the explanatory statement prefixed to the argument of the counsel for the plaintiff in error.

It was argued by *Mr. Latrobe*, for the plaintiff in error, and by *Mr. Campbell*, for the defendant in error.

*Statement and Points of Plaintiff in Error.*

On the 26th of June, 1847, Ross Winans, the plaintiff in error, obtained letters patent of the United States for a new and useful improvement in cars for transportation of coal, &c.

The occasion for the invention thus patented, and the principle of it, are well set forth in the specification, thus :

“The transportation of coal, and all other heavy articles in lumps, has been attended with great injury to the cars, requiring the bodies to be constructed with great strength, to resist the outward pressure on the sides, as well as the vertical pressure on the bottom, due not only to the weight of the mass, but the mobility of the lumps amongst each other tending to ‘pack,’ as it is technically termed. Experience has shown that cars on the old mode of construction cannot be made to carry a load greater than their own weight; but by my improvement I am enabled to make cars of greater durability than those heretofore made, which will transport double their weight of coal.

“The principle of my invention, by which I am enabled to obtain this important end, consists in making the body, or a portion thereof, conical, by which the area of the bottom is reduced, and the load ex-

erts an equal strain on all parts, and which does not tend to change the form, but to exert an equal strain in the direction of the circle; at the same time this form presents the important advantage, by the reduced size of the lower part thereof, to extend down within the truck and between the axles, thereby lowering the center of gravity of the load."

The specification then gives a detailed description of the mode of constructing the cars in question, and proceeds thus:

"What I claim as my invention, and desire to secure by letters patent, is making the body of a car for the transportation of coal, &c., in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, and by which also the lower part is so reduced as to pass down within the truck-frame and between the axles, to lower the center of gravity of the load, without diminishing the capacity of the car, as described."

And the specification concludes with a claim for a portion of the construction not important in this connection.

From the testimony, it appears that cars constructed by the plaintiff, in accordance with the specification, while they weighed but 5,750 pounds each, carried 18,550 pounds of coal, making the weight of the load, in proportion to the weight of the car, as 3.3 to 1; that the thickness of the sheet iron used in the construction of the bodies was but three-thirty-seconds of an inch, and that the dimensions of the band around the top were one-fourth of an inch by two inches; and it is further shown, in illustration of the importance of the invention, that the plaintiff had constructed a model car, which, weighing but two and one-half tons, carried, nevertheless, nine and one-half tons of coal, "in perfect safety, and satisfactorily, from Cumberland to Baltimore." The proportion of the weight of the car, in this instance, to the weight of coal carried in it, was as one to four, nearly. It appears further, from the testimony generally, that the cars referred to were used in the transportation of coal from the mines near Cumberland to Baltimore.

It then appears that the defendants, "in view for a call for cars from the mining roads near Cumberland," in 1849-'50, required their draftsman, Cochrane, to get up a car that would suit their purposes; that he went to the Reading road, and, "finding nothing there, returned to Baltimore and went to the plaintiff's shops, where he saw a car nearly finished, which he examined and measured"; that it first occurred to him to make a square car, but that, as this would interfere with the wheels, he made an octagonal one.

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Argument for the plaintiff in error.

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Another witness proves that the iron used in the car thus built by the defendants was of the same thickness as that used by the plaintiff, to wit, three-thirty-seconds of an inch, while the band around the top was of the same thickness, to wit, one-fourth of an inch, and one and one-half inches in width.

It thus appears that a patent was granted in 1847 to Ross Winans for a car for carrying coal, whose merits may be summed up thus: that it carried more coal, in proportion to its own weight, than any car previously in use, and that the load, instead of distorting it, preserved it in shape, acting as a framing.

These eminent advantages, which increased the available power of the locomotive engine, looking to revenue on coal as a freight, from fifty to one hundred per cent., were to be attributed to the peculiar shape of the car body, consisting of a frustum of a cone, which permitted the use of iron as thin as has been described, lessening in proportion the weight of the car, or the weight the transportation of which by the locomotive gave no return in revenue; and it appears that, in view of obtaining the best results from his invention, the plaintiff, in 1849-'50, at the instance of the witness Pratt, perfected a model car for certain mining roads near Cumberland; that this model car was examined and measured by the defendants' draftsman, to aid him in getting up coal-cars for other mining companies, in 1849 and 1850; and subsequently cars of the same weight of material in the bodies, which differed from the plaintiff's in this only, that while the latter were cylindrical and conical, the others were octagonal and pyramidal, were built by the defendants, to the number of twenty-four.

Believing that the cars thus built by the defendants were built in palpable violation of his patent, the plaintiff brought the present suit.

It will be seen, by examining the record, that the main question before the jury was whether the cars so built by the defendants were substantially the same in principle and mode of operation with the car described and claimed by the plaintiff in his specification, and experts were examined on both sides on this point.

On the part of the defendants, it was contended that the cars of the defendants were octagonal in shape, while the plaintiff's were cylindrical.

On the part of the plaintiff, it was insisted that this was immaterial, provided the octagonal car obtained the same useful results, through the operation of the same principles in its construction; and it was suggested that, if the original construction of the body in right

## Argument for the plaintiff in error.

lines saved the infringement, an hundred-sided polygon would be without the patent; and also that, in point of fact, even the conical car was oftener a polygon than a true curve, owing to the character of the material from which it was built; and that if, by accident, it came from the shops a true theoretical cone, a day or two's use made a polygon of it; and that the immediate tendency of the load of coal, when put into an octagon car, was to bulge out its size and convert it into a conical one; all of which was urged for the purpose of showing that the question was necessarily a question as to whether the change of form was colorable or substantial,—a question of fact which it belonged to the jury to determine.

It is not necessary, in this statement, and in view of the questions arising on this appeal, to go into evidence in regard to the merely colorable difference of construction in detail. All the witnesses on both sides proved that the advantages which Winans proposed to obtain were substantially obtained in the defendants' cars, the plaintiff's witnesses swearing to the fact directly, and the defendants' witnesses admitting it on cross-examination; and the only testimony quoted now is that of the defendants' own and leading witness:

"That the advantage of a reduced bottom of the car was obtained, whether the car was conical or octagonal; that the strengthening of the bottom, due to the adoption of the conical form, was the same when the octagonal form was adopted or the circular; that the circular form was the best to resist the pressure, as, for instance, in a steam-boiler, and an octagonal one better than the square form. that the octagonal car was not better than the conical car; that for practical purposes one was as good as the other; that a polygon of many sides would be equivalent to a circle; that the octagon car practically, was as good as the conical one; and that, substantially, witness saw no difference between the two."

The testimony must, indeed, be all one way, where the plaintiff is willing to rest his case on the defendants' own showing.

In the view of the plaintiff below, there were two questions: the first for the court, being the construction of the patent; the second for the jury, being the substantial or only colorable difference between the cars in principle and mode of operation.

The plaintiff prayed the Circuit Court (his honor, the late Judge Glenn, sitting alone) accordingly.

In framing the prayer for the court's construction of the specification, the language of the specification was adopted in describing the object of the invention; and the court were asked to say to the jury, "that what they had to look at was not simply whether, in form and



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Argument for the plaintiff in error.

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circumstances, which may be more or less immaterial, that which had been done by the defendants varied from the specification of the plaintiff's patent, but to see whether, in substance and effect, the defendants, having the same object in view as that set forth in the plaintiff's specification, had, since the date thereof, constructed cars which, substantially, on the same principle and on the same mode of operation, accomplished the same result." And to give more certainty to the prayer, the plaintiff added the instruction as prayed for by him, "that to entitle the plaintiff to a verdict, it was not necessary that the body of the defendants' cars should be conical, in the exact definition of the term, provided the jury should believe that the form adopted by the defendants accomplished the same result, substantially, with that in view of the plaintiff, and upon substantially the same principle and in the same mode of operation."

The language of the first part of the prayer here quoted was taken *verbatim*, nearly, from the charge of Sir N. C. Tindall to the jury in the case of *Walton v. Potter & Horsfall*, Webster's Patent Cases, 587.

This was a case where the plaintiff's patent was for the substitution of sheets of India-rubber for leather for the insertion of the teeth, in the manufacture of cards for carding wool; and the infringement lay in the use of cloth saturated with a solution of India-rubber for the same purpose; and the court, after determining the construction of the specification, gave substantially the same instruction that the plaintiff prayed for here. It is in this case that C. J. Tindall says: "That if a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give the public, without reference to the former one, or borrowing from the former one, a new and superior mode of arriving at the same end, there can be no objection to his taking out a patent for that purpose. But he has no right whatever to take, if I may so say, a leaf out of his neighbor's book," &c.

It would be hard, indeed, to find a case where the court's decision, applied to the facts in this cause, more completely negated the right set up by the defendants to build the cars which they did build; for here the taking of the leaf out of the book is not left to inference, but day and date are given for the act.

To the same point is the case of *Huddart v. Grimshaw*, also cited in the court below. Webster's Patent Cases, 95.

Here a patent had been obtained for making rope, a part of the process being the passage of the strands, while being twisted, through a tube; and it appeared that they had formerly passed through a hole in a plate. If the tube and the plate were the same substantially, the difference being colorably only, then the patent was void, other-

wise it was good; and the question was left to the jury, who found for the plaintiff.

To the same point is the case of *Russell v. Cowley & Dixon*, Webster's Patent Cases, 463.

This was the case of a patent for welding iron tubes, by drawing them, at a welding heat, through a conical hole. The infringement was the passing them between rollers; and the question of colorable or substantial difference was referred to the jury.

So in the case of *Morgan v. Seaward*, Webster's Patent Cases, 170, which was upon Gallaway's patent for paddle-wheels of steam vessels, and where the question of infringement having arisen, the court, Alderson, B., told the jury "that the question would be simply whether the defendant's machine was only colorably different; that is, whether it differed merely in the substitution of mechanical equivalents for the contrivances which were resorted to by the patentee." And after referring to points of construction, the court continues: "Therefore the two machines were alike in principle. One man was the first inventor of the principle, and the other has adopted it; and though he may have carried it into effect by substituting one mechanical equivalent for another, still you (the jury) are to look to the substance, and not the mere form; and if it is in substance an infringement, you ought to find so."

So, too, in the case of *Crossley v. Beverly*, growing out of Clegg's patent for a gas meter, and referred to by Alderson, B., in the case of *Jupe v. Pratt et al.*, Webster's Patent Cases, 144, as follows: "There never was a more instructive case than that. I remember very well the argument put by the lord chief baron, who led on that case, and succeeded. There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent-right. The plaintiff's invention was different in form, different in construction; it agreed with it only in one thing, and that was by moving in the water. A certain point was made to open either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve it. The scientific men, all of them, said: "The moment a practical scientific man has got that principle in his head, he can multiply, without end, the forms in which that principle can be made to operate."

As in the case under discussion, the moment a practical scientific man is furnished with the idea of giving to the car a shape which will, by dispensing with the framing ordinarily used, enable him to make it lighter, in proportion to its load, than it has ever been made

## Argument for the plaintiff in error.

before, he can multiply, without end, the forms in which this principle can be made to operate. He can make the car a polygon of an hundred sides, of twenty sides, or of eight sides. He can vary the angle of the cone or pyramid, through which the coal is discharged, *ad infinitum*. He can make the opening at the bottom larger or smaller, to please his fancy. He can avail himself or not of the advantage of lowering the car in position, so as to lower the center of gravity. Still, the question must always be, whether, whatever the shape he adopts, he is not availing himself of the principle first suggested by the patentee,—a question which, in a court of law, is at all times a question not for the court, but for the jury, after the former shall have given to the specification that construction which is to govern the latter in determining whether the infringement complained of falls, substantially, in principle and mode of operation, within the plaintiff's patent.

The authorities here cited, and which were relied on in the court below, are held to sustain the prayer of the plaintiff: that, having pronounced upon the construction of the specification, the question of infringement should be left to the jury.

The court below thought differently, however, and, rejecting the prayers of both plaintiff and defendants, instructed the jury: "That while the patent is good for what is described therein, a conical body, in whole or in part, supported in any of the modes indicated for a mode of sustaining a conical body on a carriage or truck, and drawing the same, and for those principles which are due alone to conical vehicles, and not to rectilinear bodies, and it being admitted that the defendants' car was entirely rectilinear, that there was no infringement of the plaintiff's patent." See Record, pp. 16, 17.

Upon this instruction nothing was left for the jury but to render a verdict for the defendant. The court had not only settled the construction, but the infringement also.

The present appeal is from this decision of the late district judge.

The points of the plaintiff in error are—

1. That the court below erred in the construction which it gave to the specification, should it be held that this construction limited the plaintiff to the strictly conical form.

And upon this point the authority relied on is the patent itself.

2. That the court below erred, even supposing that its construction of the specification was correct, in excluding the inquiry whether the cars of the defendants were not substantially the same in principle and mode of operation with those of the plaintiff, admitting that these last were rectilinear in their sections, and not curvilinear.

Argument for the defendant in error.

And upon this point the authorities relied on are *Walton v. Potter*, Webster's Patent Cases, 587; *Huddart v. Grimshaw*, Id., 95; *Jupe v. Pratt*, citing *Crossley v. Beverly*, Id., 144; *Morgan v. Seaward*, Id., 170; *Russell v. Crowley*, Id., 463; Phillips on Patents, 125-27.

\* Infringement. Curtis on Patents, 263-268, citing *Wyeth v. Stone*, 1 Story, 273; *Odiorne v. Winkley*, 2 Gall., 51; *Gray v. James*, Peters, 394; *Bovill v. Moore*, Dav. Pat. Cases, 361.

3. That the court below erred in taking the question of fact from the jury.

Upon which point the authorities already cited are relied on.

*Defendant's Points.*

The defendant in error submits that the court below was right in refusing the prayer on the other side, and giving the instruction which it did.

1. As to the rejected prayer of the plaintiff.

This prayer asserted the essence of the invention to consist in the conical form adopted by the patentee, and rightly so asserted, but the conclusion thence drawn was a *non sequitur*. It was that any other form was a violation. Had the patent claimed the application of a principle operating through the form of a cone, and more or less through other forms, and claimed the principle or mode of operation through whatever shape permitted it, there would have been some ground for the deduction. But the claim is confined to a single form, and only through and by that form to the principles which it embodies; and if, out of many forms embodying more or less perfectly the same mode of operation, the plaintiff in error has made his choice of the best, he is confined to that choice and the rejection which it involves of all other forms less felicitous. It may be admitted, without hesitation, that the substitution of mechanical or chemical equivalents, as they are called, will not affect the rights of a patentee; but the cases in which this principle holds are where the *modus operandi* embraces more than a single way to reach the desired end. Where the invention consists of a principle embodied in a single form, the form is the principle and the principle the form, and there can be no violation of the principle without the use of the form. *Davis v. Palmer*, 2 Brock., 309.

2. As to the court's instruction.

The construction of the patent was exclusively for the judge. He construed it correctly as embracing only a curvilinear form. It necessarily followed, that, as the infringements relied on consisted only in the construction of rectilinear forms, there was no evidence

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to go to the jury of any violation of the patent, and it was proper in him so to instruct them. *Greenleaf v. Birth*, 9 Peters, 292.

Mr. Justice CURTIS delivered the opinion of the court.

This is a writ of error to the Circuit Court of the United States for the District of Maryland. The plaintiff in error brought his action in that court for an infringement of the exclusive right to make, use, and sell "an improvement in cars for the transportation of coal," &c., granted to him by letters patent, bearing date on the 26th day of June, 1847; and the judgment of that court being for the defendants, he has brought the record here by this writ of error.

It appears by the bill of exceptions that the letters patent declared on were duly issued, and that their validity was not questioned; but the defendants denied that they had infringed upon the exclusive right of the plaintiff.

On such a trial two questions arise. The first is, what is the thing patented? The second, has that thing been constructed, used, or sold by the defendants?

The first is a question of law, to be determined by the court, construing the letters patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury.

In this case, it is alleged the court construed the specification of claim erroneously, and thereby withdrew from the jury questions which it was their province to decide. This renders it necessary to examine the letters patent and the schedule annexed to them, to see whether their construction by the Circuit Court was correct.

In this, as in most patent cases founded on alleged improvements in machines, in order to determine what is the thing patented, it is necessary to inquire—

1. What is the structure or device described by the patentee as embodying his invention?
2. What mode of operation is introduced and employed by this structure or device?
3. What result is attained by means of this mode of operation?
4. Does the specification of claim cover the described mode of operation by which the result is attained?

Without going into unnecessary details, or referring to drawings, it may be stated that the structure described by this patent is the body of a burden railroad-car, made of sheet iron, the upper part being cylindrical, and the lower part in the form of a frustum of a cone, the under edge of which has a flange secured upon it, to which flange

a movable bottom is attached. This bottom is made movable, in order to discharge the load through the aperture left by removing it.

To understand the mode of operation introduced and employed by means of this form of the car body, it is only necessary to state, what appears on the face of the specification, and was testified to by experts at the trial as correct, that, by reason of the circular form of the car body, the pressure of the load outwards was equal in every direction, and thus the load supported itself, in a great degree; that by making the lower part conical, this principle of action operated throughout the car, with the exception of the small space to which the movable bottom was attached; that, being conical, the lower part of the car could be carried down below the truck, between the wheels, thus lowering the center of gravity of the load; that the pressure outwards upon all parts of the circle being equal, the tensile strength of the iron was used to a much greater degree than in a car of a square form; and finally, that this form of the lower part of the car facilitated the complete discharge of the load through the aperture, when the bottom was removed.

It thus appears, that, by means of this change of form, the patentee has introduced a mode of operation not before employed in burden cars; that is to say, nearly equal pressure in all directions by the entire load, save that small part which rests on the movable bottom; the effects of which are, that the load, in a great degree, supports itself, and the tensile strength of the iron is used, while at the same time, by reason of the same form, the center of gravity of the load is depressed, and its discharge facilitated.

The practical result attained by this mode of operation is correctly described by the patentee; for the uncontradicted evidence at the trial showed that he had not exaggerated the practical advantage of his invention. The specification states:

"The transportation of coal, and all other heavy articles in lumps, has been attended with great injury to the cars, requiring the bodies to be constructed with great strength, to resist the outward pressure on the sides, as well as the vertical pressure on the bottom, due not only to the weight of the mass, but the mobility of the lumps among each other tending to 'pack,' as it is technically termed. Experience has shown that cars on the old mode of construction cannot be made to carry a load greater than their own weight; but by my improvement I am enabled to make cars of greater durability than those heretofore made, which will transport double their own weight of coal," &c.

Having thus ascertained what is the structure described, the mode of operation it embodies, and the practical result attained, the next

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inquiry is, does the specification of claim cover this mode of operation, by which this result is effected?

It was upon this question the case turned at the trial in the Circuit Court.

The testimony showed that the defendants had made cars similar to the plaintiff's, except that the form was octagonal instead of circular. There was evidence tending to prove that, considered in reference to the practical uses of such a car, the octagonal car was substantially the same as the circular. Amongst other witnesses upon this point was James Millholland, who was called by the defendants. He testified:

"That the advantage of a reduced bottom of the car was obtained, whether the car was conical or octagonal; that the strengthening of the bottom, due to the adoption of a conical form, was the same when the octagonal form was adopted or the circular; that the circular form was the best to resist the pressure, as, for instance, in a steam-boiler, and an octagonal one better than the square form; that the octagonal car was not better than the conical car; that for practical purposes one was as good as another; that a polygon of many sides would be equivalent to a circle; that the octagon car, practically, was as good as the conical one; and that, substantially, the witness saw no difference between the two."

The district judge who presided at the trial ruled—

"That while the patent is good for what [is] described therein, a conical body, in whole or in part, supported in any of the modes indicated for a mode of sustaining a conical body on a carriage or truck, and drawing the same, and to those principles which were due alone to conical vehicles, and not to rectilinear bodies, and it being admitted that the defendants' car was entirely rectilinear, that there was no infringement of the plaintiff's patent."

The substance of this ruling was, that the claim was limited to the particular geometrical form mentioned in the specification; and as the defendants had not made cars in that particular form, there could be no infringement, even if the cars made by the defendants attained the same result, by employing what was in fact the same mode of operation, as that described by the patentee. We think this ruling was erroneous.

Under our law a patent cannot be granted merely for a change of form. The act of February 21, 1793, sec. 2, so declared in express terms; and though this declaratory law was not reenacted in the Patent Act of 1836, it is a principle which necessarily makes part of every system of law granting patents for new inventions. Merely to

change the form of a machine is the work of a constructor, not of an inventor. Such a change cannot be deemed an invention. Nor does the plaintiff's patent rest upon such a change. To change the form of an existing machine, and by means of such change to introduce and employ other mechanical principles or natural powers, or, as it is termed, a new mode of operation, and thus attain a new and useful result, is the subject of a patent. Such is the basis on which the plaintiff's patent rests.

Its substance is a new mode of operation, by means of which a new result is obtained.

It is this new mode of operation which gives it the character of an invention, and entitles the inventor to a patent; and this new mode of operation is, in view of the Patent Law, the thing entitled to protection. The patentee may, and should, so frame his specification of claim as to cover this new mode of operation which he has invented; and the only question in this case is whether he has done so, or whether he has restricted his claim to one particular geometrical form.

There being evidence in the case tending to show that other forms do in fact embody the plaintiff's mode of operation, and by means of it produce the same new and useful result, the question is whether the patentee has limited his claim to one out of the several forms which thus embody his invention.

Now, while it is undoubtedly true that the patentee may so restrict his claim as to cover less than what he invented, or may limit it to one particular form of machine, excluding all other forms, though they also embody his invention, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise; and this for two reasons:

1st. Because the reasonable presumption is, that, having a just right to cover and protect his whole invention, he intended to do so. *Haworth v. Hurdcastle*, Web. Patent Cases, 484.

2d. Because specifications are to be construed liberally, in accordance with the design of the Constitution and the Patent Laws of the United States, to promote the progress of the useful arts, and allow inventors to retain to their own use, not anything which is matter of common right, but what they themselves have created. *Grant v. Raymond*, 6 Peters, 218; *Ames v. Howard*, 1 Sumner, 482, 485; *Blanchard v. Sprague*, 3 Id., 535, 539; *Davoll v. Brown*, 1 Wood. & Min., 53, 57; *Parker v. Haworth*, 4 McLean, 372; *Le Roy v. Tutham*, 14 How., 181, and opinion of Baron Parke, there quoted; *Nelson v. Harford*, Web. Patent Cases, 341; *Russell v. Cowley*, Id., 470; *Burden v. Winslow*, (decided at the present term,) 15 How.



The claim of the plaintiff is in the following words:

“What I claim as my own invention, and desire to secure by letters patent, is making the body of a car for the transportation of coal, &c., in the form of a frustum of a cone, substantially as herein described, whereby the force exerted by the weight of the load presses equally in all directions, and does not tend to change the form thereof, so that every part resists its equal proportion, and by which, also, the lower part is so reduced as to pass down within the truck-frame and between the axles, to lower the center of gravity of the load, without diminishing the capacity of the car, as described.

“I also claim extending the body of the car below the connecting pieces of the truck-frame and the line of draught, by passing the connecting-bars of the truck-frame and the draught-bar through the body of the car, substantially as described.”

It is generally true, when a patentee describes a machine, and then claims it as described, that he is understood to intend to claim, and does by law actually cover, not only the precise forms he has described, but all other forms which embody his invention; it being a familiar rule, that to copy the principle or mode of operation described is an infringement, although such copy should be totally unlike the original in form or proportions.

Why should not this rule be applied to this case?

It is not sufficient to distinguish this case to say that here the invention consists in a change of form, and the patentee has claimed one form only.

Patentable improvements in machinery are almost always made by changing some one or more forms of one or more parts, and thereby introducing some mechanical principle or mode of action not previously existing in the machine, and so securing a new or improved result. And in the numerous cases in which it has been held that to copy the patentee's mode of operation was an infringement, the infringer had got forms and proportions not described, and not in terms claimed. If it were not so, no question of infringement could arise. If the machine complained of were a copy, in form, of the machine described in the specification, of course it would be at once seen to be an infringement. It could be nothing else. It is only ingenious diversities of form and proportion, presenting the appearance of something unlike the thing patented, which give rise to questions; and the property of inventors would be valueless, if it were enough for the defendant to say, your improvement consisted in a change of form; you describe and claim but one form; I have not taken that, and so have not infringed.

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The answer is, my improvement did not consist in a change of form, but in the new employment of principles or powers, in a new mode of operation, embodied in a form by means of which a new or better result is produced; it was this which constituted my invention; this you have copied, changing only the form. And that answer is justly applicable to this patent.

Undoubtedly there may be cases in which the letters patent do include only the particular form described and claimed. *Davis v. Palmer*, 2 Brock., 309, seems to have been one of those cases. But they are in entire accordance with what is above stated.

The reason why such a patent covers only one geometrical form, is not that the patentee has described and claimed that form only; it is because that form only is capable of embodying his invention; and, consequently, if the form is not copied, the invention is not used.

Where form and substance are inseparable, it is enough to look at the form only. Where they are separable; where the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for the substance of the invention—for that which entitled the inventor to his patent, and which the patent was designed to secure. Where that is found, there is an infringement; and it is not a defense, that it is embodied in a form not described and in terms claimed by the patentee.

Patentees sometimes add to their claims an express declaration, to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words. The exclusive right to the thing patented is not secured, if the public are at liberty to make substantial copies of it, varying its form or proportions. And, therefore, the patentee, having described his invention, and shown its principles, and claimed it in that form which most perfectly embodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, unless he manifests an intention to disclaim some of those forms.

Indeed, it is difficult to perceive how any other rule could be applied practicably to cases like this. How is a question of infringement of this patent to be tried? It may safely be assumed, that neither the patentee nor any other constructor has made, or will make, a car exactly circular. In practice, deviations from a true circle will always occur. How near to a circle, then, must a car be in order to infringe? May it be slightly elliptical, or otherwise depart from a true circle? And if so, how far?

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In our judgment, the only answer that can be given to these questions, is that it must be so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention. It is not necessary that the defendants' cars should employ the plaintiff's invention to as good advantage as he employed it, or that the result should be precisely the same in degree. It must be the same in kind, and effected by the employment of his mode of operation in substance. Whether, in point of fact, the defendants' cars did copy the plaintiff's invention, in the sense above explained, is a question for the jury, and the court below erred in not leaving that question to them upon the evidence in the case, which tended to prove the affirmative.

The judgment of the court below must be reversed. \*

Mr. Chief Justice TANEY, Mr. Justice CATRON, Mr. Justice DANIEL, and Mr. Justice CAMPBELL dissented.

Mr. Justice CAMPBELL.

I dissent from the opinion of the court in this case.

The plaintiff claims to have designed and constructed a car for the transportation of coal on railroads, which shall carry the heaviest load, in proportion to its own weight.

His design consists in the adoption of the "conical form" "for the body of the car," "whereby the weight of the load presses equally in all directions;" does not "tend to change the form of the car;" permits it "to extend down within the truck," lowering "the center of gravity of the load," and by its reduced size at the bottom adding to its strength and durability. He claims as his invention, and it is the whole of the change which he has made in the manufacture of cars, "the making of the body of the car in the form of the frustum of a cone."

It is agreed that a circle contains a greater area than any figure of the same perimeter; that the conical form is best suited to resist pressure from within, and that the reduced size at the bottom of the car is favorable to its strength. The introduction of the cars of the plaintiff upon the railroad, for the transportation of coal, was attended by a great increase of the loads in proportion to the weight of the car. The merits of the design are frankly conceded. Nevertheless, it is notorious that there does exist a very great variety of vessels in common domestic use "of a conical form," or "of the form of the frustum of a cone," for the reception and transportation of articles of prime

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necessity and constant demand, such as water, coal, food, clothing, &c. It is also true that the properties of the circle, and of circular forms alluded to in the patent of the plaintiff, are understood and appreciated, and have been applied in every department of mechanic art. One cannot doubt that a requisition from the transportation companies for cars of a diminished weight and an increased capacity, upon the machinists and engineers connected with the business, would have been answered promptly by a suggestion of a change in the form of the car. The merit of the plaintiff seems to consist in the perfection of his design, and his clear statement of the scientific principle it contains.

There arises in my mind a strong, if not insuperable objection to the admission of the claim in the patent for "the conical form," or "the form of the frustum of a cone," as an invention; or that any machinist or engineer can appropriate by patent a form whose properties are universally understood, and which form is in very common use, in consequence of those properties, for purposes strictly analogous. The authority of adjudged cases seems to me strongly opposed to the claim. *Hotchkiss v. Greenwood*, 11 How., 249; *Losh v. Hague*, Web. Pat. Cases, 207; *Winans v. Providence Railroad Company*, 2 Story, 412; 2 Id., 190; 2 Car. & Kir., 1022; 3 W. H. & Gord., 427.

Conceding, however, that the invention was patentable, and this seems to have been conceded in the Circuit Court, the inquiry is, what is the extent of the claim? The plaintiff professes to have made an improvement in the form of a vehicle which has been a long time in use, and exists in a variety of forms. He professes to have discovered the precise form most fitted for the objects in view. He describes this form as the matter of his invention, and the principle he develops applies to no other form. For this he claims his patent. We are authorized to conclude that his precise and definite specification and claim were designed to ascertain exactly the limits of his invention. *Davis v. Palmer*, 2 Brock., 298.

The car of the defendants is of an octagonal form, with an octagonal pyramidal base. There was no contradiction in the evidence given at the trial in reference to its description, nor as to the substantial effects of its use and operation. In the size, thickness of the metal employed in its construction, weight, and substantial and profitable results, the one car does not materially vary from the other. The difference consists in the form, and in that it is visible and palpable.

The Circuit Court, acting upon these facts, of which there was no dispute, instructed the jury that an infringement of the plaintiff's pat-

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ent had not taken place. I do not find the question before the court a compound question of law and fact. The facts were all ascertained, and upon no construction of those facts was the plaintiff, in my opinion, entitled to a judgment.

In theory the plaintiff's car is superior to all others. His car displays the qualities which his specification distinguishes. The equal pressure of the load in all directions; the tendency to preserve the form, notwithstanding the pressure of the load; the absence of the cross strain; the lowering of the center of the gravity of the load, are advantages which it possesses in a superior degree to that of the defendants'. Yet the experts say that there is no appreciable difference in the substantial results afforded by the two.

The cause for this must be looked for in a source extrinsic to the mere form of the vehicles. Nor is it difficult to detect the cause for this identity in the results in such a source.

The coarse, heavy, cumbrous operations of coal transportation do not admit of the manufacture of cars upon nice mathematical formulas, nor can the loads be adjusted with much reference to exactness. There is a liability to violent percussions and extraordinary strains, which must be provided for by an excess in the weight and thickness of the material used. Then, unless the difference in the weight of the load is great, there will be no correspondent difference in the receipts of the transportation companies.

The patentee, not exaggerating the theoretical superiority of the form of his car, overlooked those facts which reduced its practical value to the level of cars of a form widely variant from his own. The object of this suit is to repair that defect of observation. It is that this court shall extend, by construction, the scope and operation of his patent to embrace every form which, in practice, will yield a result substantially equal or approximate to his own.

In the instruction asked for by the plaintiff, "form and circumstances" are treated as more or less immaterial; but the verdict is claimed, if the defendants have constructed cars "which, substantially on the same principle and in the same mode of operation, accomplish the same result."

The principle stated in the patent applies only to circular forms.

The modes of operation in coal transportation have experienced no change from the skill of the plaintiff, except by the change from the rectilinear figure to the circular.

The defendant adheres to the rectilinear form. The result accomplished by the use of the two cars is the same—a more economical transportation of coal. This result it is that the plaintiff desires to

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appropriate; but this cannot be permitted. Curtis on Patents, secs. 4, 26, 27, 86, 87, 88; 2 Story, 408, 411.

In the case of *Aiken v. Bemis*, 3 Wood. & M., 349, the learned judge said: "When a patentee chooses to cover with his patent the material of which a part of his machine is composed, he entirely endangers his right to prosecute when a different and inferior material is employed, and one which he himself, after repeated experiment, had rejected."

The plaintiff confines his claim to the use of the conical form, and excludes from his specification any allusion to any other. He must have done so advisedly. He might have been unwilling to expose the validity of his patent by the assertion of a right to any other. Can he abandon the ground of his patent, and ask now for the exclusive use of all cars which, by experiment, shall be found to yield the advantages which he anticipated for conical cars only?

The claim of to-day is that an octagonal car is an infringement of this patent. Will this be the limit to that claim? Who can tell the bounds within which the mechanical industry of the country may freely exert itself? What restraints does this patent impose in this branch of mechanical art?

To escape the incessant and intense competition which exists in every department of industry, it is not strange that persons should seek the cover of the Patent Act for any happy effort of contrivance or construction, nor that patents should be very frequently employed to obstruct invention and to deter from legitimate operations of skill and ingenuity. This danger was foreseen, and provided for in the Patent Act. The patentee is obliged by law to describe his invention in such full, clear, and exact terms that, from the description, the invention may be constructed and used. Its principle and modes of operation must be explained; and the invention shall particularly "specify and point" out what he claims as his invention. Fullness, clearness, exactness, preciseness, and particularity in the description of the invention, its principle, and of the matter claimed to be invented, will alone fulfill the demands of Congress or the wants of the country. Nothing in the administration of this law will be more mischievous, more productive of oppressive and costly litigation, of exorbitant and unjust pretensions and vexatious demands, more injurious to labor, than a relaxation of these wise and salutary requisitions of the act of Congress. In my judgment, the principles of legal interpretation, as well as the public interest, require that this language of this statute shall have its full significance and import.

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Statement of the case.

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In this case the language of the patent is full, clear, and exact. The claim is particular and specific.

Neither the specification nor the claim, in my opinion, embraces the workmanship of the defendants. I therefore respectfully dissent from the judgment of the court, which implies the contrary.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Maryland, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de novo*.

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ERASTUS CORNING, JOHN F. WINSLOW, AND JAMES HORNER, APPELLANTS, v. THE TROY IRON AND NAIL FACTORY.

(15 Howard, 451.)

1. Where the respondent, in a chancery suit in the Circuit Court, took two grounds of defense, and the judge, in giving his reasons for a decree dismissing the bill, upon one of the two grounds expressed his opinion that the respondent had not established the other ground, he cannot appeal from this as a part of the decree.
2. The decree was in the respondent's favor, dismissing the bill with costs, and no appeal lies from an opinion expressed by the judge upon the facts of the case not affecting the decree.
3. Moreover, the decree complained of has already been argued before this court upon the appeal of the other party, and both grounds of defense decided to be insufficient, and the decree reversed. There is, therefore, no such decree as that appealed from.
4. Besides, the court below has not acted upon the mandate and entered a final decree; therefore there is no final decree to appeal from.

THIS was an appeal from the Circuit Court of the United States for the Northern District of New York, sitting as a court of equity.

It was a branch of the case of the *Troy Iron and Nail Factory v. Corning et al.*, reported in 14 Howard, 193. The decree of the Circuit Court now appealed from is given at page 194. The bill was originally filed by the *Troy Iron and Nail Factory v. Corning et al.*, and the Circuit Court dismissed the bill; but this court reversed that decree. By reference to 14 Howard, 194, it will be seen that the Circuit Court, in its decree, used the following language, viz.: "And

## Statement of the case.

it appearing to the said court that the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued," &c.

Corning *et al.* being defendants in that suit, and succeeding in having the bill dismissed, did not appeal from the decree; but when the appeal was decided against them by this court, as reported in 14 Howard, they entered an appeal from that part of the decree which was as follows:

"And that so much or such parts of said decree as declares, orders, adjudges, and decrees as follows,—to wit: 'And it appearing to the said court that the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued to the said Henry Burden, bearing date the 2d of September, 1840, as in said bill of complaint set forth, and that said complainants have full and perfect title to the said patent for said improvements, by assignment from the said Henry Burden, as is stated and set forth in the said bill of complaint,'—may be reversed, and that the appellants may be restored to all things which they have lost by reason thereof.

This was the appeal now pending, which *Mr. Stevens* moved to dismiss, filing the following motion:

*Supreme Court of the United States.*

THE TROY IRON AND NAIL FACTORY, appellees,	}	In Equity.
<i>v.</i>		
ERASTUS CORNING, JOHN F. WINSLOW, AND		
JAMES HORNER, appellants.		

*State of New York, Northern District, city and county of Albany, ss:*

Samuel Stevens, of Albany, being duly sworn, says that he is of counsel and solicitor for the Troy Iron and Nail Factory, appellees in this court, and one of the solicitors and counsel in the Circuit Court of the United States for the Northern District of New York for the complainant.

That upon the hearing of the said cause in the Circuit Court of the United States for the Northern District of New York, upon pleadings and proofs, a decree therein was pronounced by the said court, which was duly entered by the clerk of the said court on the fourth (4th) day of September, 1850, which is in the words and figures following:

At a special term of the Circuit Court of the United States for the Northern District of New York, in equity, held at the city of Utica,



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in said district, on the fourth day of September, one thousand eight hundred and fifty—

Present: Hon. Samuel Nelson, Justice.

THE TROY IRON AND NAIL FACTORY

v.

ERASTUS CORNING, J. F. WINSLOW, AND JAMES HORNER.

} In Equity.

This cause having been heretofore brought to a hearing upon the pleadings and proofs, and counsel for the respective parties having been heard, and due deliberation thereupon had, and it appearing to the said court that the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued to the said Henry Burden, bearing date the 2d of September, 1840, as in said bill of complaint set forth, and that the said complainants have a full and perfect title to the said patents for said improvements, by assignment from the said Henry Burden, as is stated and set forth in the said bill of complaint:

But it also further appearing to the court, on the pleadings and proofs, that the instrument in writing bearing date the 14th of October, 1845, stated and set forth in the said bill of complaint, and also in the answer of the said defendants thereto, entered into upon a settlement and compromise of certain conflicting claims between the said parties, and, among others, of mutual conflicting claims to the improvements in the spike-machine in said bill mentioned, and when said instrument was executed by the said Henry Burden of the one part and the said defendants of the other, the said Henry Burden at the time being the patentee and legal owner of the said improvements, and fully authorized to settle and adjust the said conflicting claims, did, in legal effect and by just construction, impart, and authorize, and convey a right to the defendants to use the said improvements in the manufacture of the hook-headed spike, without limitation as to the number of machines so by them to be used, or as to the place or district in which to be used:

Therefore it is ordered, adjudged, and decreed that the said bill of complaint be, and the same is hereby, dismissed, with costs to be taxed, and that the defendants have execution therefor.

That on the twenty-second day of October, 1850, the said complainant appealed from the said decree to this court, which appeal was duly allowed by Mr. Justice Nelson, one of the justices of said court; and that afterwards, to wit, in the December Term of this court, 1852, the said cause, upon the said appeal, and upon the record returned to this court by the said clerk of the said Circuit Court

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of the United States for said Northern District, came on to be heard, and was argued; whereupon this court pronounced a decree in the words and figures following, to wit:

*United States of America, ss:*

The President of the United States of America to the Honorable the Judges of the Circuit Court of the United States for the Northern District of New York, Greeting: Whereas, lately, in the Circuit Court of the United States for the Northern District of New York, before you, or some of you, in a cause between the Troy Iron and Nail Factory, complainants, and Erastus Corning, John F. Winslow, and James Horner, defendants, in chancery, the decree of the said Circuit Court was in the following words, to wit:

Therefore it is ordered, adjudged, and decreed that the said bill of complaint be, and the same is hereby, dismissed, with costs to be taxed, and that the defendants have execution therefor, as by the inspection of the transcript of the record of the said Circuit Court, which was brought into the Supreme Court of the United States by virtue of an appeal, agreeably to an act of Congress in such case made and provided, fully and at large appear.

And whereas, in the present term of December, in the year of our Lord one thousand eight hundred and fifty-two, the said cause came on to be heard before the said Supreme Court, on the said transcript of the record, and was argued by counsel; on consideration whereof, it is now here, ordered, adjudged, and decreed by this court that the decree of the said Circuit Court in the cause be, and the same is hereby, reversed with costs, and that the said complainants recover against the said defendants three hundred and sixty dollars and forty-two cents, for their costs herein expended, and have execution therefor.

And it is further ordered that this cause be, and the same is hereby, remanded to the said Circuit Court, with instructions to enjoin the defendants perpetually from using the improved machinery with the bending lever for making hook and brad headed spike, patented to Henry Burden the 2d of September, 1840, and assigned to the complainants, as set forth in complainants' bill, and to enter a decree in favor of the complainants for the use and profits thereof, upon an account to be stated by a master, under the direction of the said Circuit Court, as is prayed for by the complainants, and for such further proceedings to be had therein, in conformity to the opinion of this court, as to law and justice may appertain. January 18.

You therefore are hereby commanded that such execution and further proceedings be had in said cause, in conformity to the opinion and

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decree of this court, as according to right and justice and the laws of the United States ought to be had, the said appeal notwithstanding.

Witness, the Hon. ROGER B. TANEY, Chief Justice of said Supreme Court, the first Monday of December, in the year of our Lord one thousand eight hundred and fifty-two. [L. s.]

And deponent further says, that afterwards, and on the 28th day of June, 1853, the said decree of this court was, by the said Circuit Court for said Northern District New York, made the decree of said Circuit Court, which last-mentioned decree is in the words and figures following, to wit:

At a term of the Circuit Court of the United States for the Northern District of New York, held at the court-house in the village of Canandaigua, on the 28th day of June, 1853—

Present: Hons. Samuel Nelson and Nathan K. Hall, Judges.

THE TROY IRON AND NAIL FACTORY

v.

ERASTUS CORNING, JAMES HORNER, AND J. F. WINSLOW.

} In Equity.

The above named, the Troy Iron and Nail Factory, the complainants in the above-entitled suit, having duly appealed to the Supreme Court of the United States from that part of the decree made in this suit which dismissed the bill of complaint herein with cost to be taxed, and the said Supreme Court of the United States having duly heard the said appeal at the December Term, 1852, upon the transcript of the record, and having reversed the said decree of the Circuit Court of the United States for the Northern District of New York, with costs, and having ordered, adjudged, and decreed that the said complainants recover against the said defendants three hundred and sixty dollars and forty-two cents for their cost in said Supreme Court, and that they have execution therefor: the said Supreme Court having remanded the said cause to the said Circuit Court, with instructions to enjoin the defendants perpetually from using the improved machinery with the bending lever for making hook or brad headed spikes, patented to Henry Burden the 2d of September, 1840, and assigned or transferred to the complainants, as set forth in complainants' bill, and to enter a decree in favor of the complainants for the use and profits thereof, upon an account to be stated by a master under the direction of the said Circuit Court, as is prayed for by the said complainants in their bill of complaint, and for such further proceedings to be had thereon, in conformity to the opinion and decree of the said Supreme Court, as to law and justice may

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appertain, which order, decree, and instructions appear to this court by the mandate of the said Supreme Court:

Now, therefore, on filing the said mandate, and in pursuance thereof, and after hearing *Mr. Stevens*, for the said complainants, and *Messrs. Seymour and Seward*, for the defendants, it is ordered, adjudged, and decreed, and this court, by virtue of the power and authority therein vested, and in obedience to the said mandate, doth order, adjudge, and decree that the instrument in writing, bearing date the 14th day of October, 1845, stated and set forth in the pleadings in this cause, executed by the said Henry Burden and the said defendants, did not, in legal effect or otherwise, or by just construction, license, impart, authorize, or convey a right to the said defendants to use the said improvements in the manufacture of the hook-headed spikes by the machinery mentioned in the said bill of complaint, or any rights secured to the said Henry Burden by the said letters patent, and assigned or transferred to the said complainants as aforesaid.

And it is further adjudged and decreed, that the said defendants have infringed and violated the said patent so granted to the said Henry Burden as aforesaid, by making and vending the said hook-headed spikes by the said machinery patented to the said Burden on 2d of September as aforesaid.

And it is further adjudged and decreed, that the said defendants do account to the said complainants for the damages, or use and profits, in consequence of the said infringements by the said defendants.

And it is further adjudged and decreed, that an account of the damages, or use and profits, be taken and stated by Marcus T. Reynolds, Esq., counsellor at law, as master of this court *pro hac vice*, and that the defendants attend before the said master, from time to time, under the direction of the said master, and that the said complainants may examine the said defendants, under oath, as to the several matters pending on the said reference, and that the said defendants produce before the said master, upon oath, all such deeds, books, papers, and writings as the said master shall direct, in their custody or under their control, relating to said matters which shall be pending before said master.

And it is further ordered and decreed, that a perpetual injunction issue out of and under the seal of this court against the said defendants, commanding them, their attorneys, agents, and workmen, to desist and refrain from making, using, or vending any machine containing the new and useful improvement for which letters patent were granted to the said Henry Burden on the 2d day of September,

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1840, and from in any manner infringing or violating any of the rights or privileges granted or secured by said patent.

And it is further ordered, that the said complainants recover of the said defendants the damages, or use and profits, which shall be reported by the said master, and that upon the confirmation of his report or decree, be entered against the defendants therefor, and also for the costs of the complainants in this suit in this court, and that the said complainants have execution therefor and for the costs in the said Supreme Court.

And it is further ordered and decreed, that such other proceedings be had herein, in conformity to the opinion of the said Supreme Court, as to law and justice may appertain; and that the parties and master may apply, upon due notice to this court, upon the foot of this decree, for such other and further orders, instructions, and directions as may be necessary.

(A copy.)

A. A. BOYCE, *Clerk.*

And deponent further says, that on the 5th day of October, 1853, the solicitor for the defendants served upon Henry Burden, the president of the said complainants, a petition of appeal and a citation thereon, in the words and figures following:

*To the Supreme Court of the United States of America:*

The petition of Erastus Corning, John F. Winslow, and James Horner respectfully represents that a decree was lately made in the Circuit Court of the United States for the Northern District of New York, in equity, bearing date the 4th day of September, 1850, in a certain cause pending in said court, wherein the Troy Iron and Nail Factory were complainants and your petitioners were defendants, certain parts of which decree, as hereinafter specified, are, as your petitioners are advised, erroneous, and ought to be reversed.

And your petitioners further show, that the matters in dispute in said cause, exclusive of costs, exceed the sum of two thousand dollars.

Whereupon your petitioners pray that the said decree, together with the pleadings, depositions, and all other proceedings in said cause, may be sent to the said Supreme Court of the United States, and filed therein on the first Monday of December next, and that so much or such parts of said decree as declares, orders, adjudges, and decrees as follows—to wit: “And it appearing to the said court that the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued to the said Henry Burden, bearing date the 2d September, 1840, as in said bill of complaint set

## Statement of the case.

forth, and that the said complainants have a full and perfect title to the said patent for said improvements, by assignment from the said Henry Burden, as is stated and set forth in the said bill of complaint"—may be reversed, and that the appellants may be restored to all things which they have lost by reason thereof.

DANIEL L. SEYMOUR,  
*Solicitor for the Appellants.*

Dated Troy, September 8, 1853.

*By the Hon. Samuel Nelson, one of the judges of the Circuit Court of the United States for the Northern District of New York.*

Whereas, Erastus Corning, John F. Winslow, and James Horner lately filed in the Circuit Court of the United States for the Northern District of New York a petition of appeal directed to the Supreme Court of the United States of America, stating that a decree was lately made in the Circuit Court of the United States for the Northern District of New York, in equity, bearing date the 4th day of September, 1850, in a certain cause therein pending, wherein the Troy Iron and Nail Factory were complainants, and Erastus Corning, John F. Winslow, and James Horner were defendants, certain parts of which said decree are alleged to be erroneous and ought to be reversed; and further stating that the matters in dispute in said cause, exclusive of costs, exceeded in value the sum of two thousand dollars:

And whereas the said Erastus Corning, John F. Winslow, and James Horner, by their said petition, prayed that the said decree, together with the pleadings, depositions, and all other proceedings in said cause, may be sent to the said Supreme Court of the United States and filed therein on the first Monday of December next, and that the said parts of said decree may be reversed and the said appellants restored to all things which they have lost by reason thereof:

You are therefore hereby cited to appear before the said Supreme Court of the United States, at the city of Washington, on the first Monday of December next, to do and receive what may appertain to justice to be done in the premises.

Given under my hand, in the Circuit Court of the United States for the Northern District of New York, the 23d day of September, 1853.

S. NELSON.

And deponent further says, that he has been informed and believes that the record and proceedings in said appeal have been duly filed with the clerk of this court.

SAMUEL STEVENS.

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Argument for the motion to dismiss.

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Sworn before me this 16th day of November, 1853.

LEONARD KIP,

*Master and Examiner in the Circuit Court of the  
Northern District of New York.*

*Supreme Court of the United States.*

THE TROY IRON AND NAIL FACTORY

vs.

ERASTUS CORNING ET AL.

} In Equity.

SIR: Be pleased to take notice that upon the pleadings, papers, and proceedings in this cause in the Circuit Court of the United States for the Northern District of New York, and upon the record and proceedings returned to this court by the clerk of said Circuit Court on the appeal by the complainant to this court, and upon the affidavit hereto annexed, and copy of which is herewith served upon you, this honorable court will be moved, at the next term thereof, to be held at the Capitol, at the city of Washington, District of Columbia, on the first Monday of December next, at the opening of the court on that day, or as soon thereafter as counsel can be heard, for a rule or order dismissing the appeal of the defendants to this court, or for such other and further rule or order as may be agreeable to equity.

Albany, November 9, 1853.

SAMUEL STEVENS,

*Solicitor for Complainants.*

To D. L. SEYMOUR, *Defendants' Attorney.*

Upon this motion to dismiss the appeal, the cause was taken up.

It was argued by *Mr. Stevens* and *Mr. Johnson*, for the motion, and by *Mr. Seymour* and *Mr. Seward* against it.

*Mr. Stevens*, in support of the motion to dismiss, made the following points:

The only ordering part of the decree—the only judgment pronounced by the court below—was a decree dismissing the complainants' bill, with costs. From that decree the complainants duly appealed to this court, which decree was reversed and a decree ordered according to the prayer of the bill, which was duly entered in the Circuit Court before the defendants made the present appeal.

Preceding the ordering part of the decree, certain recitals were made by the Circuit Court, showing the reasons or grounds upon which that court pronounced the ordering part of the decree.

It is from the recitals preceding the decree in this cause, and not from the decree, that this appeal has been made.

The complainants, the respondents to this appeal, now move to quash or dismiss it, upon the following grounds:

*First.* This court has appellate jurisdiction only upon appeals from final judgments or decrees of the Circuit Court. 1 United States Statutes at Large, p. 84, sec. 22.

The ordering part of a decree is the only final decree or judgment of the court.

The preliminary recitals preceding the ordering part of the decree are no part of the decree or judgment of the court.

Such recitals are simply the reasons or grounds of the decree.

Those reasons or grounds of the decree cannot be appealed from. A party might as well claim to appeal from the opinion of the court, as from the synopsis of the opinion, which constitutes the recitals upon which the ordering part of the decree is based.

The only decree in this case was a decree dismissing the complainants' bill, with costs. Seaton's Forms of Decrees, pp. 8, 9.

From the whole of that decree the complainant appealed, the whole of which decree was reversed by this court at its last term, and the Circuit Court was ordered by the mandate of this court to enter a decree in said cause, according to the prayer of complainants' bill, and such decree was entered by the said Circuit Court, at the June Term thereof, 1853, in compliance with said mandate of this court.

The defendants cannot have that decree of this court reviewed or altered by an attempt to appeal from the reasons upon which the Circuit Court pronounced its decree.

*Second.* But if the recitals preceding the ordering part of the decree of the Circuit Court could be appealed from, the defendants should have brought a cross-appeal, which would be heard by this court with, and at the same time of, the original appeal, and one decree only would be pronounced by the appellate court. 1 Barbour's Ch. Prac., 397; Uguart's Prac. in House of Lords on Appeals and Writs of Error, 37-40; Palmer's Prac. in House of Lords on Appeals and Writs of Error, p. 33; *Howley v. James*, 16 Wend., 85-274; *Mapes v. Coffin*, 5 Paige, 296.

A party cannot have a decree of the Circuit Court reviewed by this court two, three, or more times, by appealing from different parts of the decree at different times. Every ground which he might have urged on the hearing of the first appeal will be deemed to have been made by him, or, if not made, to have been abandoned. *The Santa Maria*, 10 Wheat., 443, 444; *Ex-parte Sibbald*, 12 Peters, 488.



This attempt at an appeal by the defendants from the reasons of the decree is analogous to an application to this court for a rehearing upon the original appeal, which is never granted after the cause has been remitted to the Circuit Court. *McArthur v. Browder*, 4 Wheat., 488.

*Third.* The decree of the Circuit Court entered in this cause on the 4th of September, 1850, was reversed by this court at its December Term, 1852, and the proceedings were remitted to the Circuit Court, and that court, at its June Term, 1853, entered a new decree, in pursuance of, and in compliance with, the mandate of this court. Therefore, on the 5th of October, 1853, the date of defendants' present appeal, there was no such decree of the Circuit Court as that entered by said court of the 4th of September, 1850, from parts of which the defendants claim to appeal.

*Fourth.* The only decree existing in the Circuit Court in this cause since its June Term, 1853, is an interlocutory and not a final decree, and cannot be appealed from. *Kane v. Whittick*, 8 Wend., 219; 9 Peters, 1; 15 Id., 287.

Appeals from the Circuit Court to this court can only be from final decrees or judgments. 1 United States Statutes at Large, p. 84, sec. 22.

*Mr. Seymour* and *Mr. Seward* opposed the motion to dismiss the appeal, upon the following grounds:

I. The decree of the Circuit Court, made on the 4th of September, 1850, disposed of the whole cause on the merits, and was, therefore, a final decree, and an appeal may be taken from it. See act of Congress March 3, 1803. By this act an appeal to the Supreme Court is given "from all final judgments or decrees rendered, or to be rendered, in any Circuit Court." See, also, act 24th of February, 1789; *The San Pedro*, 2 Wheat., 132; see act of 1819, 3 United States Statutes at Large, p. 481, chap. 19; see Patent Act of 1836, sec. 17, 5 United States Statutes at Large, p. 124; Laws United States Courts, 117-119. This last act enlarges the right of appeal in patent cases. It gives the court a discretion to allow the appeal in cases other than those already provided for by law. The appeals authorized by this law are only allowed from a final decree in United States courts. *Patterson v. Gaines et al.*, 6 How., 585.

A decree dismissing a bill is a final decree. 2 Daniell's Chancery Pleading and Practice, Perkins' ed., pp. 1199, 1200; *McCollum v. Eager*, 2 How., 64.

The decree, therefore, of the Circuit Court in this cause may be appealed from under the acts of Congress aforesaid.

II. This decree consists of three parts: the introductory part; the part declaring the rights of the parties, as this does of the complainant; and another part, ordering or directing a thing or things to be done. See 2 Daniell's Chancery Pleading and Practice, Perkins' ed., pp. 1210–1214, as to the forms of decrees. The rules of this court do not allow of recital. See Rule 85; so, too, Statute 3 and 4 William IV, cited in 2 Daniell's Practice, 1212; Seaton's Decrees, 159. It declares the right of complainants to the patent-right, and the right of the defendants to use the patented machinery under the agreement of October 14, 1845.

This decree proceeds and adjudges and determines two important matters of defense which had been distinctly set up in the pleadings, and upon which much testimony had been given, to wit:

*First.* "That the said Henry Burden was the first and original inventor of the improvement on the spike-machine in the bill of complaint mentioned, and for which a patent was issued to the said Henry Burden, bearing date the 2d day of September, 1840, as is in said bill of complaint set forth."

*Second.* "That the said complainants have a full and perfect title to the said patents for said improvements, by assignment from the said Henry Burden, as is stated and set forth in the said bill of complaint."

These portions of the decree are final decisions on the merits of the case, giving to the complainants the full and complete title to the machinery; a vital point, which, if decided for the defendants, decides the whole case for them, no matter what may be the decision as to the agreement of October 14, 1845.

An appeal will lie from the decision of the court upon either or both of these contested points. 3 Daniell's Chancery Practice, 1606.

III. Even if the adjudication contained in the decree of the originality of the invention in question, and of the complainants' title to the patent, need not have been inserted in the decree, yet they were inserted by the Circuit Court, upon the special motion of the complainants, and against the opposition of the defendants, who should, therefore, not be prejudiced by it. See affidavits read on this motion by the defendants.

IV. The appeal by the complainants brought up only the questions decided to their prejudice. *Buckingham v. McLean*, 13 How., 150, 151.

The equity practice of the Supreme Court of the United States is regulated by the laws of the United States, the rules of the court, and, in the absence of any provision in them applicable to a given case, by the practice of the English High Court of Chancery. Rule 90,

## Argument against the motion to dismiss.

Supreme Court. *The State of Rhode Island v. The State of Massachusetts*, 14 Peters, 210; *Bein v. Heath*, 12 How., 168; *Dorsey v. Packwood*, Id., 126.

By the practice, both of the American and English courts of chancery, this is a proper case for a cross-appeal to be brought by defendants. 1 Turner and Venable's Chancery Practice, 733, ed. 1835; 2 Smith's Chancery Practice, p. 31, ed. 1837; 3 Daniell's Chancery Practice, 1606, 1685, 1688; *Blackburn v. Jepson*, 2 Vesey & B., 359; *Hawley v. James*, 16 Wend., 61-85; *Mapes v. Coffin*, 5 Paige, 296; *Clowes v. Dickinson*, 8 Cow., 330.

V. The present is the proper time to bring it.

1. The decree of the Circuit Court being final, the laws of March 3, 1803, and of 1819 and 1836, give an unrestricted and unqualified right of appeal to either party for five years.

2. Because an appeal now taken from the latter decree would bring up for review only the proceedings subsequent to the mandate. *The Santa Maria*, 10 Wheat., 31; *Ex-parte Sibbald*, 12 Peters, 488.

There is no rule of the Supreme Court adopting the rules of the House of Lords.

VI. The decision of this court, on the appeal of the complainants, affects only the part of the decree complained of by them, to wit, the construction of the agreement of October 14, 1845; and while the declaratory parts of the decree of the Circuit Court in favor of the complainants remain unreversed, the right to sustain their bill for a perpetual injunction, and to recover damages, followed as a consequence from the construction given by this court to the agreement of October 14, 1845.

VII. The defendants are entitled to an appeal at some time within five years from the decision of the Circuit Court against them, on the validity of the patent in question. Now, if the complainants' position is true, that nothing is appealed from but the order directing the bill to be dismissed, these defendants have not now, and never have had, an opportunity to appeal at all, because that decree was in their favor, and a party cannot appeal from a decree in his own favor.

It is a mere subtlety to say, that because the decree deciding the validity of the patent and the title of the complainants in their favor ordered no relief, but, on the contrary, for a different reason, directed their bill to be dismissed, that therefore the decision of the validity of the patent and the title of the complainants is mere recital, and not a substantial part of the decree, and proper subject of an appeal. The test is this: Are the validity of the patent and the

## Opinion of the court.

title of the complainants now open to dispute by the defendants in the Circuit Court? Certainly they are not. But, according to the complainants, those points are not open to appeal; so that a decision on a vital point against the defendants is not the subject of appeal at all.

Again, if what the complainants allege is correct, that there is no decree now remaining in the court below but the decree which is entered on the mandate, and, also, that on appeal from that decree so entered on the mandate the party aggrieved can review only the proceedings subsequent to that decree, then it results that the defendants can have no appeal at all from a decree in which the material issue upon the invention is found against them by the court below.

Again, in answer to this, it is said that, on the appeal brought by the complainants upon the issue as to a license found against them, the defendants were at liberty to fall back and contest the issue of the invention found against them; but, in reply, we say, that, by the rules of courts of equity, as well as by statute, it is optional to the defendants whether they will so fall back and contest the issue found against them on the hearing of the appeal of the complainants, or whether they will bring their own distinct appeal.

VIII. The respondents' motion should be denied.

Mr. Justice GRIER delivered the opinion of the court.

The Troy Iron and Nail Factory filed their bill in the court below, claiming to be assignees of a patent granted to Henry Burden for a "new and useful improvement in the machinery for manufacturing wrought nails or spikes." The bill charges that the appellants, Corning & Co., have infringed their patent, and prays for an injunction and an account of profits, &c. The answer of the respondents below took defense on two grounds: first, that Burden was not the first and original inventor of the machine patented; and secondly, that the respondents used their machine under a license from the patentee. The court below sustained the defense on the latter ground, and entered the following decree: "Therefore it is ordered, adjudged, and decreed that the said bill of complaint is hereby dismissed, with costs to be taxed, and that the defendant have execution therefor."

The case is now before us on a motion to dismiss the appeal. Looking at the case as exhibited to us by the record, it appears to be an appeal by respondents from a decree dismissing the complainants' bill with costs.

It often happens that a court may decree in favor of a complainant, but not to the extent prayed for in his bill, and he may have

## Opinion of the court.

just cause of appeal on that account. But the prayer of the respondent's answer is that "he be hence dismissed, with his reasonable costs and charges, on this behalf most wrongfully sustained." And having such a decree on the present case, he cannot have a more favorable one.

It is true that the petition for the appeal in this case prays only "that so much of such parts of said decree as declares, orders, adjudges, and decrees as follows, to wit, 'and it appearing to the said court that the said Henry Burden was the first inventor of the improvement, &c.,' may be reversed, and that the appellants may be restored to all things which they have lost by reason thereof."

But the matter complained of forms no part of the decree of the court below.

It shows only that the judge, in reciting the inducement or reasons for entering a decree in favor of the respondents below, was of opinion that they were entitled to such decree, because they had succeeded in establishing one only of the two defenses alleged in their answer. It is the opinion of the court on a question of fact involved in the case, but not affecting the decree. If the decree be correct, the party in whose favor it is given has no right to complain; yet his appeal prays that it "may be reversed, and the appellants restored to all things which they have lost by reason thereof"; and the record shows they have lost nothing.

If the decree be reversed, according to the prayer of the appellants, the court must necessarily enter a decree for the complainants below. This would probably not meet the views of the appellants. They have put themselves in the anomalous position either of asking for the affirmance of the decree from which they have appealed, or of requesting this court to reverse a decree in their favor, and send back the record to the court below, with directions to enter the very same decree, but to assign other reasons for it. The court were not bound to give any reasons for their decree. The law gives the party aggrieved an appeal from a final decree of an inferior court; but it does not give the party who is not aggrieved an appeal from a decree in his favor because the judge has given no reasons, or recited insufficient ones, for a judgment admitted by the appellant to be correct.

There is a part of the history of this case which does not appear on the record, but being known to the court, and assumed by counsel on both sides to make part of the case, it will be necessary to notice the case under that aspect.

The decree in favor of the appellants, which is now appealed from, has already been before this court on an appeal by the complainant

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below. The parties were then fully heard, the decree of the Circuit Court reversed, and the case remanded for further proceedings. It is reported in 14 Howard, 194. It appears, therefore, that there is no such decree as that which is now complained of. The decree of the Circuit Court has been entirely annulled, reversed, and set aside by this court. Before that was done, the appellants had a full hearing on every point of defense set up in their answer. The court below had decided that the defendant had a good defense under his plea of license, but not under the plea that Burden was not the first inventor of the patented machine. This court has decided that the appellants' defense was insufficient on both pleas. The language of the court is, (14 How., 208,) "That the defendants have failed to prove that Burden was not such first inventor; and, in our opinion, the evidence given by them on that point rather serves to establish the originality of the invention than to impair it. The appellants stand upon the patent as the first which was granted for the bending lever; and they may well do so, until other evidence than that in this record shall be given to disprove its originality."

It is plain, therefore, that, under the guise of an appeal from the decree of the Circuit Court, this is an appeal in fact from the decision of this court; for there is no other decree existing in the case, except the decree of this court. There must be an end of litigation some time. To allow a second appeal to a court of last resort, on the same questions which were open to dispute on the first, would lead to endless litigation. It is said by this court, in *Martin v. Hunter*, 1 Wheaton, 355, "a final judgment of the court is conclusive upon the rights which it decides, and no statute has provided any process by which this court can revise its judgment." See, also, *Sibbald v. United States*, 12 Pet., 488. It follows, therefore, that when a complainant has a decree in his favor, but not to the extent prayed for in his bill, and the respondent appeals, if the complainant desires a more favorable decree, he must enter a cross-appeal, that, when the decree comes before the appellate court, he may be heard. For when the decree is either affirmed or reversed by the appellate court, it becomes the decree of that court, and cannot be the subject of another appeal. But in this case, where the decree of the court below dismissed the bill, no appeal by the respondent was necessary. He had a full opportunity to urge every defense set up in his answer. The printed arguments show that the defense, for want of originality in the patent, was relied upon as a ground for affirming the decree of the court below, and, as we have already shown, was distinctly passed upon and overruled by this court.

## Syllabus.

A second appeal lies only when the court below, in carrying out the mandate of this court, is alleged to have committed an error. But on an appeal from the mandate, it is well settled that nothing is before the court but the proceedings subsequent to the mandate. Whatever was formerly before the court, and was disposed of by its decree, is considered as finally disposed of. See *Himely v. Rose*, 5 Cranch, 313; *Canter v. The Ocean Insurance Company*, 1 Peters, 511; *The Santa Maria*, 10 Wheat., 431; *Rice v. Wheatly*, 9 Dana, 272.

Moreover, as it is admitted that the court below have not yet acted upon the mandate of this court, and entered a final decree in pursuance thereof, there is no final decree, from which only an appeal can be taken. See *The Palmyra*, 10 Wheat., 502; *Chace v. Vasquez*, 11 Id., 429.

There are, therefore, three conclusive reasons for dismissing the present appeal: 1. The appellants have already been heard in this court on a former appeal. 2. There is no such decree as that from which the appeal purports to be taken. 3. There is no final decree in the case, from which an appeal can be taken.

The appeal is therefore dismissed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District New York, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court that this cause be, and the same is hereby,

DISMISSED WITH COSTS.

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WILLIAM LIVINGSTON AND EBENEZER N. CALEF, APPELLANTS, v. WILLIAM W. WOODWORTH, ADMINISTRATOR OF WILLIAM WOODWORTH, DECEASED, JAMES G. WILSON, ARTEMAS L. BROOKS, AND IGNATIUS TYLER, APPELLEES.

(15 Howard, 546.)

1. Where the assignors of a patent-right were joined with the assignee for a particular locality, in a bill for an injunction to restrain a defendant from the use of the machine patented, and the defendant raised in this court, and after a final decree, an objection arising from a misjoinder of parties, the objection comes too late.
2. Moreover, in the present case, the parties consented to the decree under which the account in controversy was adjusted.
3. That consent having been given, however, to a decree by which an account

## Argument for the appellants.

should be taken of gains and profits, according to the prayer of the bill, the defendant was not precluded from objecting to the account upon the ground that it went beyond the order.

4. The report having been recommitted to the master, with instructions to ascertain the amount of profits which might have been realized with due diligence, and the master having framed his report upon the theory of awarding damages, this report and the order of the court confirming it were both erroneous.
5. Under the circumstances of this case, the decree should have been for only the actual gains and profits during the time when the machine was in operation, and during no other period.

THIS was an appeal from the Circuit Court of the United States for the District of Massachusetts.

All the facts of the case are stated in the opinion of the court, to which the reader is referred.

It was argued by *Mr. Schley*, for the appellants, and by *George T. Curtis*, for the appellees.

*Mr. Schley* made the following points:

1. The account ought not to have been taken from the date of the patent. The title of the complainant Tyler was not complete until 1st of July, 1848, nor the title of Brooks until the 10th of May, 1848. At the furthest, the account ought not to have been taken from a period prior to the latter day.

2. The account ought not to have been continued beyond the time of the filing of the bill. There are cases, undoubtedly, in which the account is continued to the date of the report; but this is not such a case.

3. It was clearly erroneous to allow interest from the day of filing the bill on the whole amount, as part of the amount accrued after that date.

4. Upon the case as it stood in court, actual "gains and profits," and nothing more, ought to have been charged against the defendants. If damages beyond actual gains and profits were asked, the complainants should have sought another forum. *Curtis on Patents*, sec. 348; *Hindmarch on Patents*, 361-365; *Crossley v. The Derby Gas-Light Company*, 3 Mylne & Craig, 428, 433; *Bacon v. Spotswood*, 1 Beav., 387; *Colborn v. Simms*, 2 Hare, 560; 2 *Eden on Injunctions*, 251; *Phillips on Patents*, 457; *Webster on Patents*, 119, 168, 238; *Lee v. Alston*, 1 Ves. Jr., 82.

5. The allowance of one dollar per thousand was not warranted by the evidence in the cause, even if in other respects the decree was right. The allowance was excessive, upon the merits, as disclosed in evidence.



The points made by *Mr. Curtis*, for the appellees, were the following:

I. The first point that will be submitted, on behalf of the appellees, will be, that this being a bill for an injunction and an account, and a decree having been entered by consent of parties, (Record, p. 68,) that the complainants were entitled to the injunction and account prayed for in the bill; an appeal does not lie from the final decree, which merely ascertains the items of the account which the appellants consented should be taken.

That an appeal cannot be taken from a decree entered by consent, counsel will cite 2 Daniell's Ch. Pr., 1179, 1180; *Bradish v. Gee*, Amb., 229; *Harrison v. Rumsey*, 2 Ves., 488; *Atkinson v. Marks*, 1 Cow., 693; *Corning v. Cooper*, 7 Paige, 587.

There is a case in Ohio which is otherwise, founded on the peculiar provisions of the statute allowing appeals. *Brewer v. The State of Connecticut et al.*, 9 Ohio, 189.

But there is nothing in the provisions of the Judiciary Act of 1789, or in the act of March 3, 1803, section 2, allowing and regulating appeals in equity, to prevent the application by this court of the rule, that when a decree has been taken by consent it cannot be disturbed by an appeal or a rehearing.

The object of the act of 1803 is stated in the case of *The San Pedro*, 2 Wheaton, 141, 142. The only question in this case is whether the consent decree, entered May Term, 1849, (p. 18,) does not render the final decree (pp. 51, 52) a decree by consent also. It will be contended that it does—

1. Because, by the first decree, the appellants consented that the appellees were entitled to the perpetual injunction, and "the account prayed for in the bill"; and all that remained to be done was to ascertain what account was prayed for in the bill.

2. Because, by the first decree, it was expressly declared that the parties consented to have the account commence at such a time as should be found by the master and be confirmed by the court—a stipulation as binding on both parties as if they had made the same point the subject of arbitration.

But if the appeal was rightly taken, counsel for the appellees will contend—

II. That the second decretal order to the master, by which he was directed to ascertain "the amount of profits which may have been, or with due diligence and prudence might have been, realized by the defendants for the work done by them" with the machine complained of, taken in connection with the principles laid down by the court in

their opinion, (see appendix to this brief,) stated the true rule for this case.

1. It appears, by an account filed with the master at the first hearing, that the appellants had been using the machine complained of from July, 1845, to July, 1848, and had planed therewith 3,962,760 feet of boards during that time.

It also appears that they had received an average of two dollars per thousand feet for this work; and in their answer they state that this work was done at an average expense of one dollar and fifty cents per thousand feet, leaving fifty cents only as the net profit actually realized on a thousand feet. But they do not profess to do this with entire accuracy, but as an "approximate estimate."

In this state of the facts, the master, assuming that he was to find only the actual net profits realized, heard evidence on the part of the complainants which tended to show that a thousand feet of boards could be planed for a less cost; and, also, evidence on the part of the respondents tending to show that it would cost as much as they had stated in their answer; but he held that the result of the whole evidence did not authorize the conclusion that the respondents had not truly stated the actual cost, and accordingly he reported one dollar and fifty cents as the cost per thousand, leaving an actual profit of fifty cents only.

As it stood on the master's first report, therefore, there was evidence tending to show that, in charging one dollar and fifty cents per thousand as the cost of planing, the respondents had conducted the business with less skill and prudence than it might have been conducted. The master's conclusion was based wholly on the idea that the actual net profits furnished the rule, and that the evidence did not control the statement of the answer as to the amount of such actual profits.

An exception being taken and argued, it appeared to the court that here was a state of facts which required the application of a different rule, and the cause was recommitted to the master by the second decretal order, and the accompanying instructions.

The rule announced was, that the master was to report the profits which the respondents might have made with due diligence and prudence; and the principle adopted by the court was, that the respondents were to be charged as involuntary trustees, accountable, like mortgagees in possession and other similar trustees, for the profits which might have been received with due care and prudence.

To apply this rule, rendered it necessary to hear evidence on both sides, and to take the average given by all the testimony of what it

## Argument for the appellees.

would cost to plane one thousand feet. The result of the whole evidence given to the master at both hearings may be thus stated:

(The counsel then went into some long calculations respecting the cost of planing.)

2. There is no technical difficulty in a court of equity in adopting and applying such a rule as that directed by the second decretal order to the master.

Where the court has jurisdiction to give the principal relief sought, it will make a complete decree, and give compensation for the past injury,—as in bills for specific performance. *Newham v. May*, 13 Price, 749; *Nelson v. Bridges*, 2 Beavan, 239; *Phillips v. Thompson*, 1 Johns. Ch. R., 150; *Parkhurst v. Van Cortlandt*, Id., 273; *Pratt v. Law & Campbell*, 9 Cranch, 406; *Cathcart v. Robinson*, 5 Peters, 269; 2 Story's Eq. Jur., sec. 796. So, also, in injunction bills for waste. *Jesus College v. Bloom*, 3 Atk., 262; *Garth v. Cotton*, Id., 751; *Lee v. Alston*, 1 Bro. Ch. R., 194.

The jurisdiction in equity conferred upon the Circuit Courts, in patent causes, by statute, contemplates full power to give the plaintiff as ample redress as he could have at law, except that the damages cannot be trebled. Patent Act of July 4, 1836, secs. 17, 14.

3. There being no technical difficulty in applying a rule that involves elements of computation and gives an approximate compensation to the party injured, the question is simply one of principle, viz., what rate of profits shall a party who has long infringed a patent be required to account for in equity?

The court below did not direct the master to find damages, nor did he go into that inquiry. He inquired, as he was directed to do, whether the profits actually made by the respondents were as large as they might have been with the exercise of due care and prudence.

a. Any other rule, in a case of this kind, would put the patentee entirely in the power of the trespasser, and enable the latter to fix the rate at which he should account for the use of the machine.

b. The rule applied in this case by the court below was correct in principle. It was to hold the party accountable, as an involuntary trustee, for what the patentee might have realized by the same exercise of the right, the evidence showing that he had made the cost of the work excessive. The principle is well settled, that a court of inquiry sometimes forces the character of a trustee upon an intruder or wrong-doer, or one who is in possession under color of right, and who takes rents or profits which belong to another, or might have taken them.

The particular class of trustees referred to in the opinion of the

court below are mortgagees. The following authorities show the application of the rule: *Anonymous*, 1 Vernon, 45; *Chapman v. Tanner*, Id., 267; *Coppring v. Cooke*, Id., 270; *Jenkins v. Eldredge*, 3 Story, 325-331; *Dexter v. Arnold*, 2 Sumner, 108-130.

c. This is a case of first impression. All the authorities and precedents which declare that the infringer is to account in equity for the "profits" made by the unlawful use of the invention, contemplate a case where the actual profits are all that could have been made, or else that question has not been raised. This is a case where the evidence shows that the respondents so conducted their business that the actual profits were less than half what might have been realized by the patentee from the same business.

III. The objection that the account ought not to have been taken from the date of the (reissued) patent, viz., July 8, 1845, but should have commenced May 20, 1848, (the date of Wilson's deed of confirmation to Brooks, one of the complainants,) is now too late. By consent of parties, the account was to commence at such time as should be found by the master and confirmed by the court. Page 18. The master found the facts, and the court directed the account to commence at the date of the reissued patent. No appeal lies from the decree thus consented to.

Besides, the bill was brought in the name of the original owner of the reissued patent, Woodworth's administrator, Wilson, his assignee, and Brooks and Tyler, the sub-assignees; and, by consent, the respondents admitted the right to the injunction and account prayed for.

IV. If the appeal can open this question, it is submitted that the decree was right.

The first patent to Woodworth, the inventor, was granted December 27, 1828. November 16, 1842, Woodworth's administrator obtained from the Commissioner, under the statute of 1836, sec. 18, an extension for seven years from December 27, 1842. December 7, 1842, the administrator granted to Brooks an exclusive territorial right for the residue of the extended term, viz., to December 27, 1849.

January 11, 1844, the administrator conveyed all his interest to Wilson.

July 8, 1845, the administrator surrendered the renewed patent granted to him by the Commissioner, and obtained a reissue under the act of 1836, sec. 13, on account of a defective specification.

July 20, 1847, Brooks assigned to Tyler one-half of his territorial right.

May 20, 1848, Wilson, by his deed, confirmed Brooks' title, and

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Brooks, by his deed dated July 1, 1848, confirmed his previous grant to Tyler.

The bill was filed July 10, 1848, in the name of the administrator, Wilson, Brooks, and Tyler, to obtain an account for infringements commenced at least at the date of the surrender and reissue, and steadily continued to the time of filing the bill. The court directed the account to commence with the date of the reissued patent.

Three positions will be maintained :

1. That the complainants, who sought this redress, jointly represented the whole legal and equitable title, and were jointly entitled to the relief from the date of the reissued patent. Even if it were true that a reissue does not give a legal title to the assignee whose grant was taken before the reissue, (which is not admitted,) it still leaves his equitable title, as against strangers and trespassers, as valid as it was before.

2. An assignee of the whole existing interest under a patent has the same legal title in the reissued patent, granted under the act of 1836, sec. 13, for a defective specification, which he had before the reissue, without any confirmatory grant from the patentee. *Woodworth v. Stone*, 3 Story, 749; *Woodworth v. Hall*, 1 Wood. & Min., 248.

The two cases of *Wilson v. Rousseau*, 4 How., 646, and *Bloomer v. McQuewan*, 14 How., 539, deny to previous assignees a legal title under an extension, and recognize only their right to continue the use of the specific machines purchased.

They admit, therefore, that the extension is a grant of a new estate to the patentees. A reissue under the thirteenth section of the statute is not a new grant in any sense, but merely the correction of errors or omissions in the specifications; and the statute merely restricts the right of recovery to infringements committed after the correction has been made.

3. If the complainants, Brooks and Tyler, needed any confirmation of their title, they had it before the bill was filed, and it relates back to the earliest period when the statute will permit recovery for infringements under a reissued patent.

V. The objection that the account ought not to have been taken beyond the time of filing the bill, covers the work done in the course of fifteen days. The bill was filed July 10, 1848, and the account covers the work done to July 25. It appears that the injunction was served on the last-mentioned day. Record, pp. 13, 14. The amount planed in the month of July was 73,821 feet. So that, at the rate of 4,200 feet per day, the respondents must have worked their machine more than seventeen days in the month of July; that is to say,

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they did more than seven days' work after the bill was filed. Record, p. 19. It does not appear precisely why the master took the account to the 25th of July, but probably it was because the respondents rendered it to that time, they not having stopped before. After the bill was filed, they had notice of the complainants' rights, and on their own admission they were infringers, and bound to account. To allow the present objection to prevail, would be to say, that, in a suit for an injunction and account, the right being admitted, the respondent may go on working after the bill is filed, and the complainant must file another bill to recover for what is done after the first bill is filed, and before the account is taken. There is no technical necessity for this, and it would be most onerous, as leading to endless litigation.

VI. The objection as to the interest allowed on the items which accrued after the filing of the bill, assumes that work was done by the respondents after the bill was filed. By their own admission they had no right to use the machine. The master brought the account down to the time when the respondents rendered it, July 25; and if a part of the items thus covered accrued after the respondents were notified, those items must, in contemplation of law, be treated as if they had already accrued when the bill was filed, in taking a continuing account.

Mr. Justice DANIEL delivered the opinion of the court.

The appellees, on the 24th of July, 1848, obtained from the court above mentioned an injunction to restrain the appellants from using or vending one or more planing-machines, substantially the same in construction and mode of operation as the machine which had been patented to William Woodworth, deceased.

In their bill they allege the originality of the invention of the patentee, the extension of the patent after his death for the space of seven years beyond its original limitation to the appellee William W. Woodworth, as administrator of the inventor, and the grant by said administrator to the appellee Brooks of the exclusive right to construct and use the invention within certain specified limits for the entire period of that extension. The bill further alleges a second extension by act of Congress of the patent to the said administrator for the term of seven years from the 27th day of December, 1849; but states that in consequence of doubts entertained as to the correctness of the specification, and of the fact of said letters patent having been found to be inoperative, they were duly surrendered, and new letters patent, bearing date on the 8th day of July, 1845, were issued to the appellee William W. Woodworth, and his assigns, for the

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residue of the term of twenty-eight years from the 27th of December, 1828. That subsequently to this last renewal the appellee William W. Woodworth had granted to the appellee Wilson, and to his assigns, all the right and title acquired by him by the issue of the last letters patent with the amended specification. That the appellee Brooks, by his deed of the 20th of July, 1847, had granted and assigned to the appellee Tyler one-half of Brooks' right in the patent to Woodworth for the term ending on the 27th of December, 1849, to be used within the town of Lowell, and not elsewhere. That the appellee Wilson, by deed of the 20th of May, 1848, assigned and confirmed to Brooks and his assigns the exclusive right of constructing and using twenty planing-machines, according to the letters patent with the amended specification, and gave authority to Brooks, in Wilson's name, to execute all such deeds of confirmation to the assignees of any rights and privileges within the county of Middlesex as he should deem fit, and that in virtue of this power and authority, he (Brooks) did, by his deed of July 1, 1848, grant and confirm to the appellee Tyler, in the name and behalf of the said Wilson, as well as in his own name, all the rights and privileges described in the deed from Brooks to Tyler of the 20th of July, 1847. The bill further alleges that the appellants were then using, and for some time had used, within the city of Lowell, one of the machines, substantially the same in construction and mode of operation as the planing-machine in the said last-mentioned letters patent described, the exclusive right to make, use, and vend which is by law vested in the appellees. The bill also charges, that theretofore two actions at law had been instituted in that court, the one against a certain James Gould, and the other against Rodolphus and James, Edwards and Cyrus Smith, for violation of the exclusive privileges granted to the plaintiffs in those actions under patent last aforesaid, by using a machine substantially the same with the said planing-machine invented by the said William Woodworth, and that, upon issues made up in both these actions, the jury found that the defendants had infringed the patent, and subjected them to the payment of damages. It avers the use, as before stated, by the appellants of their machine, to be an infringement of the Woodworth patent, and a violation of the exclusive rights and privileges of the appellees; and concludes with a prayer that the appellants may be decreed to account for and pay over to the appellees all gains and profits which have accrued from using their said machines since the expiration of the said original patent; that they may be restrained by injunction from using or vending any one or more of said machines; that the machine or machines in the possession or

under the control of the appellants may be destroyed or delivered over to the appellees, who ask also for general relief.

The appellants, by their answer, state that during a part of the time which has elapsed between the autumn of 1841 and April 1, 1844, they have used in their mill at Lowell a single planing-machine, constructed according to a patent granted to James H. Hutchinson on the 16th of July, 1839, which machine, in some of its combinations, substantially resembles the machine specified in the patent granted to Woodworth in 1845, but is unlike any machine specified in the patent to Woodworth in 1828. They aver, also, that the planing business had been carried on as aforesaid, in virtue of the Hutchinson machine, at Lowell, with the full knowledge of the appellee Brooks, and without objection from him, until within a short time previously, and that they had no knowledge or belief of any infringement by them of the patent to Woodworth until after the decision in Gould's case, after which decision they were informed that the patent to Woodworth had been surrendered and reissued with a new specification, the validity of which reissued patent had not, within their knowledge or belief, been established, until the decision of the suit against the said Edwards and Smith. The answer denies the originality of Woodworth's claim, by averring that James, Joseph, Aaron, and Daniel Hill, and Leonard Gilson, in the District of Massachusetts, as early as 1827, and John Hale, of Bloomfield, in the State of New York, in the year 1828, had knowledge of, and had made and used, planing-machines essentially the same, and prior to the pretended invention of William Woodworth, deceased.

At the May Term of the court, 1849, this cause coming on to be heard upon the bill, the answers, replications, and exhibits, by the consent of the parties it was decreed by the court that the appellees (the complainants below) were entitled to the perpetual injunction and to the account prayed for by the bill, said account to commence at such time as shall be found by the master and be confirmed by the court. The decree proceeds, that the master, in taking said account, shall have power to require the parties to produce before him, on oath, all books and papers relating thereto, and to hear such oral evidence as either party may produce, and on the motion of either of the parties, to examine either of the other parties upon interrogatories; and all further directions are reserved until the coming in of the master's report.

In pursuance of this decretal order, upon the examination of the parties on oath, and upon evidence produced *aliunde*, the master reported that the amount of gains and profits received by the defend-



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ants below upon 3,962,700 feet of plank, the number of feet planed by them, was at the rate of fifty cents per thousand feet, no exception being taken to the amount of the work stated to have been done by the said defendants, or to the gross amount at which the work was charged by them per thousand; but exception being taken to the report of the master, upon the ground that the rate of profit charged to the defendants below should have been one dollar instead of fifty cents per thousand, the court, by a further decretal order, re-committed the report to the master, with instructions to ascertain the amount of profits which may have been, or with due diligence and prudence might have been, realized by the defendants for the work done by them or their servants by the machines described in the complainants' bill, and that the account of profits should commence from the date of the letters patent issued with the amended specifications. In obedience to the decretal order last mentioned, the master made a second report, by which he charged the defendants for profits on the work done by their machine, at the rate of one dollar per thousand feet, instead of fifty cents, as in his former report, from the 8th day of July, 1845, the date of the reissued patent. He says it is true that the rate of profit adopted by him is conjectural, "but that he does not think he has infused into the case any element too unfavorable to the defendants; that by the decision of the court they were trespassers and wrong-doers, in the legal sense of the words, and were consequently in a position which might make them liable to be mulcted in damages greater than the profits they have actually received, the rule being not what benefit they have received, but what injury the plaintiffs have sustained." To this second report of the master exceptions were filed by the appellees, (the plaintiffs below,) founded upon the departure of the master from the safe and just rule of actual profits, as prayed for by the bill, and the adoption of a rule of proceeding which was vague and conjectural, and unsustained by the evidence in the cause. At the May Term, 1851, the Circuit Court decreed that this report of the master, except so far as interest is thereby disallowed, should be confirmed, and that the appellants should, within ten days, pay to the appellees the sum of \$3,962.96, with interest thereon from the day of filing the bill, with costs. It is this decree, founded upon the antecedent proceedings herein adverted to, that we are to review; and it may here be remarked, that the statement of those proceedings has been unavoidably protracted, from the necessity for considering two questions of a preliminary character raised in the argument, and which it is proper to dispose of before deciding upon and before reaching the merits of this cause.

1st. It has been insisted, on behalf of the appellants, that the appellee Tyler, claiming as assignee under Woodworth, Wilson, and Brooks, and asserting a title complete in himself, within a certain locality, could not regularly unite in his bill those persons whom he had shown had no title within the same locality, and who could not, therefore, be embraced in a decree in his favor,—a decree which, in its terms and effect, must exclude every kind of interest in those co-plaintiffs within the same limits. It is true, as a rule of equity pleading, that none should be made parties, either as complainants or defendants, who have no interest in the matters in controversy or which can be affected by the decree of the court. *Vide* Story's Eq. Plead., ch. 4, sec. 231. So, too, in section 232 of the same work it is said: "In cases where the want of interest applies, it is equally fatal when applicable to one of several plaintiffs as it is when applicable to one of several defendants. Indeed, the objection in the former case is fatal to the whole suit, whereas, in the latter case, it is fatal (if taken in due time) only as against the defendant improperly joined." In the same work, section 544, it is said, that "In cases of misjoinder of plaintiffs the objection ought to be taken by demurrer; for if not so taken, and the court proceeds to a hearing on the merits, it will be disregarded, at least if it does not materially affect the propriety of the decree." The language of Lord Langdale, in the case of *Raffity v. King*, as reported in the Law Journal, vol. 6, p. 93, is very clear upon this question, where he says: "As to the objection to John Raffity being made a plaintiff, I am not satisfied it would, under any circumstances, be considered of such importance as to deprive the other plaintiffs of the relief they are entitled to. There have been cases in which the court, with a view to special justice, has overcome the difficulty occasioned by a misjoinder of plaintiffs." And in the case of *Morley v. Lord Hawke*, cited in 2 Y. & J., 520, before Sir William Grant, the rule is thus stated as to the misjoinder of plaintiffs: "The defendant objected to any relief being granted in that state of the record; and without determining the effect of the objection, if brought forward earlier, I think it is now too late. If the objection had been stated in the answer, the plaintiffs might have obtained leave to amend their bill, and might have made John Raffity a defendant instead of a plaintiff, for which there is an authority in the case of *Aylwin v. Bray*, 2 Y. & J., 518; note; and in such a case as this, where the objection is reserved to the last moment, I think it ought not to prevail."

In the case before us, the objection of misjoinder of the plaintiffs nowhere appears upon the pleadings, nor, for aught that is disclosed, was it insisted upon even at the hearing. It is urged for the first

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time after the hearing and after a final decree; and to allow this objection at so late a stage of the proceedings, would be a surprise upon the appellees, and might operate the most serious mischiefs. In this case, and at this time, the allowance of such an objection would be peculiarly improper; for here the objection cannot be viewed as having been merely waived by reasonable and ordinary implication, but the defendants have expressly consented to a decree between the parties as they were then arrayed upon the record. As to this objection, therefore, we think it comes too late to be of any avail, and should not affect the cognizance of the court, either as to the parties or the subject-matter of the controversy.

2d. On the part of the appellees, (the complainants in the Circuit Court,) it has been insisted that the decretal order, made in this cause by consent, covered and ratified in advance all the subsequent proceedings on the part of the court, rendering those proceedings, inclusive of the final decree, a matter of consent, which the appellants could have no right to retract, and from which, therefore, they could not legally appeal. In order to try the accuracy of this argument, and of the conclusions sought to be deduced therefrom, it is proper to examine the order which is alleged in support of them. The words of that order are as follows:

"This cause came on, &c., and by consent of parties it is declared by the court,"—what? "That the complainants are entitled to the perpetual injunction and the account prayed for by the bill." It seems to us incomprehensible, that by this consent of the defendant below, he had consented to anything precise and unchangeable beyond the perpetual injunction; much more so that he had thereby bound himself to acquiescence in any shape, or to any extent of demand which might be made against him under the guise of an account. Indeed, the complainants below, and the Circuit Court itself, have shown, by their own interpretation of this decretal order, that they did not understand it to mean—as, in truth, by no just acceptance it could mean—anything fixed, definite, and immutable; for the complainants below excepted to the report of the master, and the court recommitted that report, with a view to its alteration. Nor can we regard the reference to the master as in the nature of an arbitration; for if so deemed, the award of that officer must have been binding, unless it could be assailed for fraud, misbehavior, or gross mistake of fact. In truth, the account consented to was the account prayed for by the bill, and in the plain words of the bill, viz., "that the defendants may be decreed to account for and pay over all such gains and profits as have accrued to them from using the said ma-

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chine since the expiration of said original letters patent." This language is particularly clear and significant: such gain and profits, and such only, as have actually accrued to the defendants; and we are unable to perceive how, by such an assent, the appellants (the defendants below) could have been concluded against exceptions to anything and everything which might have been evolved by that report, however illegal or oppressive.

Considering next the decretal order for the recommitment of the first report, the second report made in obedience to that order, and final decree founded upon the second report, we are constrained to regard them all as alike irreconcilable with the prayer of the bill, with the just import of the consent decree, and with those principles which control the action of courts of equity. In the instructions to the master, it will be seen that he is ordered "to ascertain and report the amount of profits which may have been, or with due diligence and prudence might have been, realized by the defendants for the work done by them or by their servants by means of the machines described in the complainants' bill, computing the same upon the principles set forth in the opinion of the court, and that the account of such profits commence from the date of the letters patent issued with the amended specification." The master, in this report, made in pursuance of the instructions just adverted to, admits that the account is not constructed upon the basis of actual gains and profits acquired by the defendants by the use of the inhibited machine, but upon the theory of awarding damages to the complainants for an infringement of their monopoly. He admits, too, that the rate of profits assumed by him was conjectural, and not governed by the evidence; but he attempts to vindicate the rule he had acted upon by the declaration that he was not aware that he had "infused into the case any element too unfavorable to the defendants; that by the decision of the court they were trespassers and wrong-doers, in the legal sense of these words, and consequently in a position to be mulcted in damages greater than the profits they have actually received, the rule being not what benefit they have received, but what injury the plaintiffs have sustained." To what rule the master has reference in thus stating the grounds on which his calculations have been based, we do not know. We are aware of no rule which converts a court of equity into an instrument for the punishment of simple torts; but upon this principle of chastisement the master admits that he has been led, in contravention of his original view of the testimony, and upon conjecture as to the reality of the facts, and not upon facts themselves, to double the amount which he had stated to be a compensation to the

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plaintiffs below, and the compensation prayed for by them, and the Circuit Court has, by its decree, pushed this principle to the extreme, by adding to this amount the penalty of interest thereon from the time of filing the bill to the date of the final decree.

We think that the second report of the master, and the final decree of the Circuit Court, are warranted neither by the prayer of the bill, by the justice of this case, nor by the well-established rules of equity jurisprudence. \*

If the appellees (the plaintiffs below) had sustained an injury to their legal rights, the courts of law were open to them for redress, and in those courts they might, according to a practice which, however doubtful in point of essential right, is now too inveterate to be called in question, have claimed not compensation merely, but vengeance, for such injury as they could show that they had sustained. But before a tribunal which refuses to listen even to any save those whose acts and motives are perfectly fair and liberal, they cannot be permitted to contravene the highest and most benignant principle of the being and constitution of that tribunal.

There they will be allowed to claim that which, *ex æquo et bono*, is theirs; and nothing beyond this.

In the present case it would be peculiarly harsh and oppressive, were it consistent with equity practice, to visit upon the appellants any consequences in the nature of a penalty. It is clearly shown that the appellants, in working their machine, were proceeding under an authority equal to that (the same, indeed) which bestowed on Woodworth and his assignees the right to their monopoly. The appellants were using a machine patented by the United States to Hutchinson, and might well have supposed that the right derived to them from such a source was regular and legitimate. They were, then, in no correct sense, wanton infringers upon the rights of Woodworth, or of those claiming under him. So soon as the originality and priority of the Woodworth patent was ascertained by law, the appellants consented to be perpetually enjoined from the use of their machine; (the Hutchinson machine,) and to account for whatever gains and profits they had received from its use. Under these circumstances, were the infliction of damages, by way of penalty, ever consistent with the practice of courts of equity; there can be perceived in this case no ground whatever for the exercise of such a power.

On the contrary, those circumstances exhibit in a clearer light the propriety of restricting the account, in accordance with the prayer of the bill, to the actual gains and profits of the appellants (the defendants below) during the time their machine was in operation, and dur-

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ing no other period. We are therefore of the opinion that the decree of the Circuit Court is erroneous, and should be, as it is hereby, reversed with costs, and that this cause be remanded to the Circuit Court, with instructions to proceed therein in conformity with the principles ruled in this opinion.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Massachusetts, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court that the decree of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, for further proceedings to be had therein, in conformity to the opinion of this court.

GEORGE W. AND HENRY SIZER, PLAINTIFFS IN ERROR, v. WILLIAM V. MANY.

•(16 Howard, 98.)

1. Where a judgment in a patent case was affirmed by this court with a blank in the record for costs, and the Circuit Court afterwards taxed these costs at a sum less than two thousand dollars, and allowed a writ of error to this court, this writ must be dismissed on motion.
2. The writ of error brings up only the proceedings subsequent to the mandate; and there is no jurisdiction where the amount is less than two thousand dollars, either under the general law or the discretion allowed by the Patent Law. The latter only relates to cases which involve the construction of the Patent Laws, and the claims and rights of patentees under them.
3. As a matter of practice, this court decides that it is proper for Circuit Courts to allow costs to be taxed *nunc pro tunc* after the receipt of the mandate from this court.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Massachusetts.

Mr. George T. Curtis, on behalf of the defendant in error, moved to dismiss the writ of error for the want of jurisdiction.

The circumstances were these:

At the October Term, in the year 1848, of the Circuit Court of the United States for Massachusetts District, Many, the defendant in error, recovered a judgment against the plaintiffs in error, in an action for the infringement of letters patent, which was entered and recorded in the words following: "It is thereupon considered by the

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court that the said William V. Many recover against the said George W. and Henry Sizer the sum of seventeen hundred and thirty-three dollars and seventy-five cents damages, and costs of suit, taxed at \_\_\_\_."

The said Sizers thereupon, at the same term of the Circuit Court, sued out a writ of error to this court, for the purpose of having the said judgment revised. This writ of error was duly entered and prosecuted in this court, and at the December Term, 1851, the judgment of the Circuit Court was affirmed by a divided court; and therefore it is not reported in Howard.

The mandate which went down recited the judgment of the Circuit Court as above given, and then proceeded thus:

"You therefore are hereby commanded that such execution and proceedings be had in said cause as, according to right and justice and the laws of the United States, ought to be had, the said writ of error notwithstanding."

On the receipt of this mandate, the attorney for the defendant in error (the original plaintiff below) presented the same to the Circuit Court, held by the district judge, and applied for leave to have the costs in the action taxed and inserted in the blank left in the original record of the judgment. This motion was refused by the district judge.

The defendant in error thereupon, at the December Term of this court, in the year 1852, applied to this court for a mandamus to direct the court below to tax and allow his costs in the original action, amounting to \$1,811.59. The court refused the application, for reasons which appear in the case. *Ex-parte Many*, 14 How., 24.

In May, 1853, *Mr. Curtis*, counsel for Many, renewed his motion to the district judge, setting out in writing the mandate of this court in the original cause, and the amount of the costs, and praying the court to make an order allowing of their taxation an insertion in the original judgment, and praying for execution as directed by the mandate of this court.

Opposition was made to this motion by *Sizer et al.*, but the motion was granted, as appears by the following extract from the record. It is proper to remark that the court was held by the district judge alone, *Mr. Justice Curtis* having been of counsel and not sitting. The costs in the Circuit Court amounted to \$1,811.59.

And the said *Sizer et al.*, by their counsel, objected to the granting of the said motion for an *allocatur* as to the said costs, or to their being inserted in the judgment, and claimed and requested that if the court should allow the said costs, and direct the clerk to insert the

amount in the record of said judgment, then the defendants should have a right to sue out a writ of error, and for that purpose that the court here should either certify that it is reasonable that there should be such writ of error, or should add interest upon the amount of said costs from the time of the rendition of the original judgment to the present time, so as to make the amount more than two thousand dollars, and that no execution should issue if within ten days a writ of error should be sued out, and security given according to law; to which claims and requests, made by the defendants, the plaintiffs objected, and insisted upon the said motion.

And now, the court having considered the said motion filed by the plaintiff, and the objections, claims, and requests made by the defendants, and deeming it to be the legal right of the plaintiff to have the said costs allowed, and the amount thereof inserted in the original judgment in this cause, and that it is not within the discretion of the court to allow or disallow the same, it is ordered by the court that the said costs, as taxed in said motion, be allowed, and that the amount thereof be inserted in the original judgment in this cause.

And the court here doth deem it reasonable that the said defendants should be allowed to bring a writ of error to the Supreme Court; and it is further ordered by the court, that execution, as prayed for in said motion of the plaintiff, shall issue after the expiration of ten days, Sundays exclusive, from the making of the order, unless the said defendant shall within said ten days give security according to law, and serve a writ of error, by leaving a copy thereof for the plaintiff in the office of the clerk of this court; and if such security should be given, and such service made within ten days, then that execution should not issue until the further order of the court.

By the court.

H. W. FULLER, *Clerk.*

The writ of error was sued out, and brought all these proceedings up to this court.

The motion to dismiss was argued by *Mr. Curtis*, in favor of it, and by *Mr. Robb*, against it.

*Mr. Curtis.* The writ of error now before the court, although it brings up the proceedings in the Circuit Court prior to the mandate in the original cause, in contemplation of law can present for revision here solely the question, whether the Circuit Court erred in making the order by which the costs were allowed and directed to be inserted in the original judgment.

Over this question this court can have no jurisdiction, because—



## Argument against the motion to dismiss.

1. The amount in controversy is less than \$2,000.

The sole amount or item in controversy under the motion of the plaintiff below, and involved in the order of the Circuit Court thereon, was the costs prayed for, being \$1,811.59.

The original judgment had been reviewed in this court by the first writ of error; and after a mandate has issued from this court affirming a judgment below, and directing execution, a second writ of error can bring up nothing but the proceedings subsequent to the mandate. *Ex-parte Sibbald*, 12 Pet., 488, 492; *Browder v. McArthur*, 7 Wheat., 58.

It cannot be pretended that this court can acquire jurisdiction of this writ of error upon the ground that the court below has allowed it in the exercise of a discretion conferred by statute (July 4, 1836, sec. 17) in patent cases, where the amount in controversy is less than \$2,000. The settled construction of that statute, is that it confers a discretion on the courts below to allow writs of error in cases where the amount in controversy is less than \$2,000, for the purpose of having some question settled that involves the construction of the Patent Acts. *Hogg v. Emerson*, 6 How., 439, 478; *Wilson v. Sanford*, 10 How., 99. The court below, by allowing the first writ of error, which brought up the original judgment for a revision of the merits of the case, had exhausted all the discretion that the statute confers; and the question of allowing the plaintiff's costs to be taxed *nunc pro tunc*, and inserted in the judgment, had nothing to do with the construction of the Patent Laws.

Again, this court cannot take jurisdiction of this writ of error, because—

2. The order of the court below, although in form a final order or judgment, is, in fact and substance, an interlocutory order. The part of the order of which the plaintiffs in error complain, is that allowing the costs; and this was asked and allowed as a proceeding *nunc pro tunc*, and therefore was, in contemplation of law, prior to the final judgment from which the first writ of error was prosecuted. That part of the order which allows the execution in case the writ of error is not prosecuted within ten days, is not a final judgment, in the sense of the Judiciary Act.

*Mr. Robb* made the following points:

1. The amount in dispute between the parties exceeds the sum of \$2,000, although the amount of costs allowed by the court below to be inserted in the judgment, by way of amendment, is less than that sum. The necessary result of the allowance of the amendment is to subject the plaintiff to the payment of \$2,300, and upwards.

2. The defendant in error cannot, by a voluntary remittitur of the excess above \$2,000, against the consent of the plaintiffs in error, defeat their right to a writ of error from this court.

3. This court will not regard the order of the court below, allowing the amendment as a proceeding *nunc pro tunc*, and as of the October Term, 1848, of that court, if thereby the right of appeal to this court will be defeated.

4. The proceedings of the court below, in the execution of the mandate, are the subject of revision by this court; and it is error in the inferior court to grant any relief whatever after the mandate, or to examine it for any other purpose than execution. *Ex-parte Sibbald*, 12 Peters, 492. And the order or judgment purporting to be pursuant to and in execution of the mandate will be reviewed by this court; and if it appear by the record that such order is at variance with the mandate, the court will exercise jurisdiction for the purpose of examining into the grounds of such variance. The variance in this case is matter of substance. In contemplation of law, a judgment for a sum expressed as damages and "costs to be taxed," or taxed at —, is a judgment for damages alone, and execution can issue only for that sum. *Cook et al. v. Brister*, 4 Har., 73, and cases cited. This court will exercise jurisdiction over such proceedings, although the additional relief erroneously granted in the court below be less in amount than \$2,000.

5. This cause is now for the first time properly before this court upon the entire record, and the previous writ of error and the proceedings thereon, in this court were without jurisdiction, because the judgment of the Circuit Court upon which it was brought was not final. When costs are taxed upon a judgment, such taxation is to be considered as the period at which final judgment is pronounced. *Salter v. Slade*, 3 Nev. & M., 717; *Butler v. Bulkeley*, 8 Moore, 104; 1 Bing., 233; *Godson v. Lloyd*, 1 Gale, 244; *Wright v. Lewis*, 4 Jur., 1112, B. C.; *Blackburn v. Kymer*, 1 Chas. Marshall, 278. And the order of the court allowing the costs to be taxed should be treated as the completion of the judgment of the Circuit Court in the cause.

6. The present writ of error, therefore, is properly allowed by the court below, in the exercise of the discretion conferred by the seventeenth section of the act of July 4, 1836.

Mr. Chief Justice TANEY delivered the opinion of the court.

A motion has been made to dismiss the writ of error in this case for want of jurisdiction.

The case as it comes before us is this: Many, the defendant in

error, in the year 1848, recovered a judgment in the Circuit Court for the District of Massachusetts, against the plaintiffs in error, in an action for the infringement of certain letters patent. The verdict and judgment were for less than \$2,000, but the writ of error to remove the case to this court was allowed under the Patent Law of 1836. From some oversight or accident, the costs were not taxed in the Circuit Court before the transcript of the record was transmitted to this court; and the judgment as it stood upon the transcript was for the damages awarded by the jury, and costs of suit, leaving a blank space open for the insertion of the amount of the costs.

The judgment of the Circuit Court was affirmed at the December Term, 1851, and the usual mandate sent down directing execution.

Upon the receipt of the mandate by the Circuit Court, the defendant in error applied for leave to have the costs taxed, and the amount inserted in the blank left for that purpose in the original record of the judgment. The motion was refused. And thereupon the defendant in error, at December Term, 1852, applied to this court for a mandamus directing the court below to tax and allow his costs in the original action, amounting, as he alleged, to \$1,811.59. But the court refused the motion, upon the ground that a mandamus could not lawfully be issued to a Circuit Court to guide its judgment in the taxation of costs.

At a subsequent term of the Circuit Court, the defendant in error renewed his motion for an order allowing the taxation of these costs and their insertion in the original judgment; and the court thereupon allowed the taxation of costs, and directed the amount above mentioned to be inserted in the original judgment. But the court at the same time allowed a writ of error from their decision, and ordered that this second writ of error should operate as a *supersedeas* of the execution prayed for, if sued out within the time fixed by law. It is this writ of error that is now before the court, and which the defendant in error has moved to dismiss.

It has been settled, by the decisions of this court, that after a case has been brought here and decided, and a mandate issued to the court below, if a second writ of error is sued out it brings up for revision nothing but the proceedings subsequent to the mandate. None of the questions which were before the court on the first writ of error can be reheard on reëxamined upon the second; and there is nothing therefore now before the court but the taxation of costs. 7 Wheat., 58; 12 Pet., 488, 492.

The sum taxed being less than \$2,000, no writ of error will lie under the act of 1789. This act gives no jurisdiction to this court

over the judgment of a Circuit Court, where the judgment is for less than that sum.

Neither can the allowance of the writ by the Circuit Court give jurisdiction, where the only question is the amount of costs to be taxed, and the amount allowed is less than \$2,000. The discretionary power in this respect vested in the Circuit Courts by the act of July 4, 1836, sec. 17, is evidently confined to cases which involve the construction of the Patent Laws, and the claims and rights of patentees under them. But the amount of costs which either party shall be entitled to recover is not regulated by these laws. The costs claimed are allowed or refused in controversies arising under the Patent Acts, upon the same principles and by the same laws which govern the court in the taxation of costs in any other case that may come before it. The same laws, therefore, must be applied to them in relation to the writ of error, and must limit the jurisdiction of this court as in other cases.

The writ of error must therefore be dismissed for want of jurisdiction. But as the question raised in this case may often occur in the Circuit Courts, and it is important that the practice should be uniform, it is proper to say that we consider the decision of the Circuit Court, allowing those costs to be taxed after the receipt of the mandate from this court, to have been correct, and conformable to the general practice of the courts. The costs are perhaps never in fact taxed until after the judgment is rendered, and in many cases cannot be taxed until afterwards. And where this is the case, the amount ascertained is usually, under the direction of the court, entered *nunc pro tunc* as a part of the original judgment. And this mode of proceeding is necessary for the purposes of justice, in order to afford the necessary time to examine and decide upon the several items of costs to which the successful party is lawfully entitled.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Massachusetts, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that this cause be, and the same is hereby, dismissed for the want of jurisdiction.

DISMISSED.

WILLIAM H. SEYMOUR AND DAYTON S. MORGAN, PLAINTIFFS IN ERROR,  
v. CYRUS H. McCORMICK.

(16 Howard, 480.)

1. In 1834, McCormick obtained a patent for a reaping-machine. This patent expired in 1848.
2. In 1845, he obtained a patent for an improvement upon his patented machine, and in 1847 another patent for new and useful improvements in the reaping-machine. The principal one of these last was in giving to the raker of the grain a convenient seat upon the machine.
3. In a suit for a violation of the patent of 1847, it was erroneous in the Circuit Court to say that the defendant was responsible in damages to the same extent as if he had pirated the whole machine.
4. It was also erroneous to lay down as a rule for the measure of damages, the amount of profits which the patentee would have made, if he had constructed and sold each one of the machines which the defendants constructed and sold. There was no evidence to show that the patentee could have constructed and sold any more than he actually did.
5. The acts of Congress and the rules for measuring damages examined and explained.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Northern District of New York.

The manner in which the suit was brought, and the charge of the Circuit Court which was excepted to, are stated in the opinion of the court. The reporter passes over all other questions which were raised and decided, except those upon which the decision of this court turned.

It was argued by *Mr. Gillet*, for the plaintiffs in error, and by *Mr. Stevens* and *Mr. Johnson*, for the defendants in error. There was also a brief filed by *Mr. Selden*, for the plaintiffs in error.

The following points are taken from the brief of *Mr. Gillet*, for the plaintiffs in error:

*Sixth.* Where the claim on which the suit is founded is for an improvement on old machines, patented or unpatented, the plaintiff is not entitled to recover, as a measure of damages, the mechanical profits that he could make upon the whole machine, including the old part. His damages are limited to the profits on making and vending the improvement patented and infringed.

The plaintiff recited in his declaration and furnished oyer of his old patent of 1834, for a reaping-machine, which expired in 1848, and his patent of 1845, which is described as an "improvement upon his patented machine." In his patent of 1847, he claims "new and useful improvements in the reaping-machine formerly patented by

me," in which he also claims other improvements besides the one in controversy, which is his last claim, and relates to the seat. For the purpose of this suit, the machine described in the patent of 1834, (which had, in fact, become public property,) and the improvements in the patent of 1845, and a large portion of those included in that of 1847, the defendants had a perfectly lawful right to use. This covered the whole of the improved reaping-machine, except what related to the seat, and its combination with the reel. It cost the defendants to make their machine, which had no seat, about \$64.26. There was no proof to show the extent of the cost of the plaintiff's seat. One was made by Zinck for one dollar. The plaintiff allowed Brown, in effect, 1845-1846, \$75 each for making machines without the elevated seat; and he proved on this trial, by Blakesley, that it cost him only \$36, and, by Dorman, \$37, to make them with it. There can be no pretense that the addition of the seat, and what is covered by the last claim, added much, if anything; to the cost of constructing the improved machine. The plaintiff proved, by Blakesley, that the manufacturer's profit on the whole machine, including a thirty-dollar patent fee, was \$74.

It is evident that the manufacturer's profit constituted the principal item of gain in constructing and selling the plaintiff's reaper. The court instructed the jury that this profit on the two old machines, and on that part of the new not in controversy, could be recovered as a part of the plaintiff's "actual damage" for violating the last claim of the patent of 1847. The old machine of 1834 was public property, and everybody had a right to construct and use it. The patents show that it contained the great and fundamental parts, and nearly the whole of the new machine. As the plaintiff had decided not to proceed on his patent of 1845, that was, in effect, public property. By waiving any right to proceed on the first claim of his patent of 1847, the plaintiff limited himself to the seat, combined with the reel. The defendants had a right to make every other part of the improved machine, and having the right, the profits up to that point were lawfully theirs. They had the right to construct the whole, save the seat. If a profit could be made upon such construction, it was as clearly theirs as if they had been made upon a machine totally unlike the plaintiff's. There is no law, statute or otherwise, which prohibits their making and receiving such profits. The court instructed the jury that all these profits belonged to the plaintiff, but pointed to no law showing him entitled to them. The manufacturer's profits were distinct from his patent profits, which he estimated and charged the defendants and his partners generally at \$30. The charge of the

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Argument for the plaintiffs in error.

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court gives him both. It makes the monopoly of a patent confined to an inexpensive improvement carry with it a monopoly of manufacturer's profits upon what is public property, precisely the same as if the whole had been included in the claim on which the trial was had. The ruling of the judge allowed the plaintiff damages to as great an extent as if the trial had been on, and had established, the old patents of 1834 and 1845, and on the first claim of that of 1847, as well as on the last. If the defendants pay these damages, there is nothing to prevent the plaintiff suing on the patent of 1845, and on the first claim of that of 1847, because this trial and verdict were confined to the last claim of the latter patent. They were not recovered upon; but the plaintiff was adjudged to enjoy their advantages under the head of manufacturer's profits. But we deny that the Patent Laws confer a monopoly of profits on anything not actually patented. It would be extending the statute so as to make it cover, in effect, things that the patentee did not invent, and which by law belonged to the public at large. This principle would authorize the patentee of an improvement in steamboat machinery, or railroad cars, carding, spinning, weaving, and other like machines, to recover, on a patent for some trifling improvement of either, the entire profits of manufacturing the whole apparatus to which it might be attached.

The judge's rule allows the plaintiff precisely the same damages as if his last claim covered the whole reaping-machine, and had been held to be valid. Under his ruling, if the material parts, other than the seat, had been covered by several other patents, the defendants would have been responsible on each, as well as to the plaintiff, for all profits, manufacturing as well as for the patent-right. In such a case the plaintiff's rights, as against the defendants, would be precisely as strong as when the latter used what is now public property. If the plaintiff should bring a new suit on his patent of 1845, the recovery on that of 1847 would be no bar; and he might obtain a second manufacturer's profit. The defendants sought to attack the validity of the patent of 1845, but the evidence was ruled out; still the plaintiff was allowed to recover for the manufacturer's profits of the part of the machine covered by this patent, just the same as if it had been a part of the last claim of the patent of 1847. If the defendants had been patentees of the whole machine except the seat, and they had infringed the patent for that, could the plaintiff recover manufacturer's profits on the whole machine? Clearly not. Still the rights of the defendants to make and use all but the seat are just as strong and legal, when they use what is public prop-

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erty, or what is not covered by the last claim of the patent of 1847, as if they exercised them under a patent. The fact that they had or had not a patent for everything but the seat, can neither increase nor diminish the plaintiff's rights to damages; they must rest solely upon his patent, and not upon those of others. The law allows him all the profit he can make on his patented improvement, and nothing beyond. The judge's instruction was clearly erroneous, and vitiates the verdict.

*Seventh.* In estimating the plaintiff's damages for an infringement, his "actual damages" alone are to be considered, and the jury are not authorized to presume that if the defendants had not made and sold machines, "all persons who bought the defendants' machines would necessarily have been obliged to go to the patentee and purchase his machines."

The proof showed that the plaintiff manufactured his machines only at Chicago, in Illinois, and his sales were in the Western States, except a few in Western New York. The defendants manufactured their machines at Brockport, near Rochester, in New York, and sold them there, in Canada, and some at the West, as proved. It was proved by Hanna: "The demand within my knowledge has been unparalleled, the manufacturer oftentimes not being able to supply the demand at certain points." The plaintiff offered no proof tending to show that he could and did supply all the demands for his machine, and could have furnished more if called for. In the absence of this evidence, and in direct conflict with the oath of the plaintiff's own witness, who was his superintendent, the court instructed the jury, that, as a matter of law, they were to presume that if the defendants had not constructed and sold any machines, the plaintiff would have manufactured and sold machines to the same persons to whom the defendants had sold. Hence, the jury were instructed to presume, "in the judgment of the law," what was grossly improbable, and what the plaintiff himself had actually disproved. The law does not presume that all the persons who purchased of the defendants would have purchased of the plaintiff, because the law does not presume absurdities, and what is substantially a physical impossibility; nor does it presume, without evidence, that the plaintiff had introduced a witness who had sworn falsely. This part of the charge is clearly erroneous. The court should have submitted this matter to the jury, to pass on as a question of fact.

(Mr. Stevens' eighth point was relative to the following exception which had been taken by the defendants below, namely:)

To that part of the charge which states, "the general rule is, that



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the plaintiff, if he has made out his right to recover, is entitled to the actual damages he has sustained by reason of the infringement; and those damages may be determined by ascertaining the profits which, in judgment of law, he would have made, provided the defendants had not interfered with his rights. That view proceeds upon the principle, that if the defendants had not interfered with the patentee, persons who bought the defendants' machines would necessarily have all been obliged to go to the patentee and purchase his machine,"—the defendants counsel excepted.

*Eighth.* The tenth exception cannot be sustained. That exception is to that part of the charge which states that the rule of damages is "that the plaintiff is entitled to recover the actual damages he has sustained by reason of the infringement." Those damages may be determined by ascertaining the profits which the plaintiff would have made if the defendants had not interfered with his rights.

It is submitted that this is the correct rule of damages in any case; but in this case its correctness cannot be doubted. The defendants, with a full knowledge of plaintiff's rights, intentionally violated them. They were intentional wrong-doers, and were, therefore, bound to pay the plaintiff all the damage he had sustained by their tortious acts, just as much as they would be bound to pay him the full value of a horse or any other chattel of which they had tortiously deprived him.

It was, indeed, contended, on the trial, that defendants were only bound to pay such profits as they had made by this intentional piracy.

Without stopping to discuss the question whether there may not be considerations, in a suit in equity, where the defendants ignorantly infringed a patent, which might limit the damages in accordance with the rule contended for by the defendants, it is respectfully submitted, that in a suit at law, where the defendants have willfully, knowingly, and intentionally pirated the invention of the patentee, and appropriated it to their own use, the rule of damages laid down by the court in this case is correct.

An infringer can afford to sell the machine patented at a less profit than the patentee can.

He has spent no time, exercised no intellect, in excogitating the discovery or invention.

He has spent no time nor money in procuring the patent and bringing it into public use. Any other rule of damages, therefore, than that laid down by the court, would do great injustice to the patentee.

According to the rule contended for by defendants, if they had sold the reapers made by them for simply what it cost to construct them, or had given them away, although it deprived the patentee of

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the profits which he might have made upon those reapers, yet he could recover no damages.

But the defendants' counsel did not request the court to charge that the rule of damages was different from that stated by the court. They simply excepted to the charge of the court in that respect, without giving any reasons, or stating how otherwise they desired the court to charge, in that regard.

As to the rule of the damages, see *Pierson v. Eagle Screw Co.*, 3 Story, 402, 410; *Allen v. Blunt*, 2 Wood. & Min., 123, 446-7.

Mr. Justice GRIER delivered the opinion of the court.

The plaintiff below, Cyrus H. McCormick, brought this action against the plaintiffs in error, Seymour & Morgan, for the infringement of his patent-right. The declaration consisted of two counts.

The first alleged that the plaintiff was the true and original inventor of certain new and useful improvements in the machine for reaping all kinds of small grain, for which he obtained letters patent on the 21st of June, 1834; and, moreover, that the plaintiff was the inventor of certain improvements upon the aforesaid patented reaping-machine, for which he obtained letters patent on the 31st day of January, 1845. And it charged that the defendant had made three hundred reaping-machines which infringed the inventions and improvements fourthly and fifthly claimed in the schedule or specification of the last-named letters patent.

The second count alleged that the plaintiff was the first inventor of certain other improvements upon his said reaping-machine before patented, for which he obtained letters patent on the 23d day of October, 1847; and that the defendant manufactured and constructed three hundred machines embracing the principles of the last-named invention and improvements. The defendants pleaded not guilty; and the case being called for trial in October, 1851, they prayed a continuance of the cause, on account of the absence of certain witnesses material to their defense against the charge laid in the first count, to wit, the infringement of the patent of 1845.

The court intimated an opinion that the affidavit was sufficient to put off the trial of the cause; whereupon the plaintiff's counsel stated to the court, that rather than have the trial put off, they would not on said trial seek to recover against the defendant on account of any alleged infringement or violation by the defendants of the plaintiff's rights under his letters patent bearing date January 31, 1845, set forth in his declaration, but would proceed solely for a violation of the rights secured to him by his letters patent bearing date October

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23, 1847, set forth in his declaration, under the last claim specified in that patent relating to the seat for the raker.

The trial then proceeded on the last count in the declaration, for the infringement by defendants of this last patent; and testimony offered to show that the plaintiff was not the original and first inventor of the reaping-machine, as described in his patents of 1834 and 1845, was rejected.

Numerous exceptions were taken by defendants in the course of the trial and to various instructions contained in the charge of the court. Most of these involve no general or important legal principle, and could not be understood without prolix statements with regard to the facts of the case and the structure of the peculiar machines. To notice them in detail would be both tedious and unprofitable. We deem it sufficient, therefore, to say that the defendants have failed to support their exceptions as to the rulings of the court concerning the testimony, and that the charge of the learned judge is an able and correct exposition of the law as applicable to the case, with the exception of the points which we propose now to examine, and which are contained in the following portion of the charge:

“The only remaining question is that of damages. The rule of law on this subject is a very simple one. The only difficulty that can exist is in the application of it to the evidence in the case. The general rule is, that the plaintiff, if he has made out his right to recover, is entitled to the actual damages he has sustained by reason of the infringement, and those damages may be determined by ascertaining the profits which, in judgment of law, he would have made, provided the defendants had not interfered with his rights.

“That view proceeds upon the principle, that if the defendants had not interfered with the patentee, all persons who bought the defendants’ machines would necessarily have been obliged to go to the patentee and purchase his machine. That is the principle on which the profits that the patentee might have made out of the machines thus unlawfully constructed, present a ground that may aid the jury in arriving at the damages which the patentee has sustained.

“It has been suggested, by the counsel for the defendants, that inasmuch as the claims of the plaintiff in question here are simply for improvements upon his old reaping-machine, and not for an entire machine and every part of it, the damages should be limited in proportion to the value of the improvements thus made, and that therefore a distinction exists, in regard to the rule of damages, between an infringement of an entire machine and an infringement of a mere improvement on a machine. I do not assent to this distinction. On

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the contrary, according to my view of the law regulating the measure of damages in cases of this kind, the rule which is to govern is the same whether the patent covers an entire machine or an improvement on a machine. Those who choose to use the old machine have a right to use it without incurring any responsibility; but if they ingraft on it the improvement secured to the patentee, and use the machine with that improvement, they have deprived the patentee of the fruits of his invention, the same as if he had invented the entire machine; because it is his improvement that gives value to the machine, on account of the public demand for it. The old instrument is abandoned, and the public call for the improved instrument; and the whole instrument, with the improvement upon it, belongs to the patentee. Any person has a right to use the old machine; and if an inventor ingrafts upon an old machine, which he has a right to use, an improvement that makes it superior to anything of the kind for the accomplishment of its purposes, he is entitled to the benefit of the operation of the machine, under all circumstances, with the improvement ingrafted upon it, to the same degree in which the original inventor is entitled to the old machine.

“There are some data, furnished by the counsel on both sides, which it is proper the jury should take into view in ascertaining the damages, provided they arrive at this question in the case. It is conceded that just three hundred machines have been made by the defendants, of the description to which I have called your attention, and testimony has been gone into on both sides for the purpose of showing the cost of the machines, and the prices at which they sold. In order to ascertain the profits accruing to the party who makes machines of this description, you must first ascertain the cost of the materials and labor, and the interest on the capital used in the manufacture of the machines. You must also take into account the expenses to which the manufacturer is subjected in putting them into market, such as that of agencies and transportation, also of insurance; and where the article is sold on credit, a deduction must also be made for bad debts. All these things must be taken into account, in order to bring into the cost every element that properly goes to constitute it in the hands of the manufacturer. When you have ascertained the aggregate sum of the cost, deduct it from the price paid by the purchaser, and you have the net profit on each machine. By this process you are enabled to approximate to something like the actual loss that the patentee sustains in a case where his right has been violated by persons interfering with him and putting into market his improvement.”

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The plaintiffs in error complain that these rules with regard to damages, as thus laid down by the court, are incorrect, and have produced a verdict for most ruinous damages, far beyond anything justified by the facts of the case. 1. Because the jury were instructed that it is a legal presumption that if defendants had not made and sold machines, all persons who bought the defendants' machines would necessarily have been compelled to go to the patentee and purchase his machines. That this principle was enunciated as a binding principle of law, although the plaintiff below had given no evidence to show that he could have made and sold a single machine more than he did, or was injured in any way by the competition of the defendants, or hindered from selling all he made or could make. And, secondly, because the jury were instructed that the measure of damages for infringing a patented improvement on a machine in public use is the same as if the defendant had pirated the whole machine, and every improvement on it previously made; and, as a consequence, that the plaintiff below had a right to recover as great damages for the infringement of the patent in his second count as if he had proceeded on both counts of his declaration, and shown the infringement of all the patents claimed; and that in consequence of these instructions they have been amerced in damages to the enormous sum of \$17,306.66, and with costs to nearly the round sum of \$20,000.

We are of opinion that the plaintiffs in error have just reason of complaint, as regards these instructions and their consequent result.

The first Patent Act of 1790 made the infringer of a patent liable to "forfeit and pay to the patentee such damages as should be assessed by a jury, and, moreover, to forfeit to the person aggrieved the infringing machine."

The act of 1793 enacted "that the infringer should forfeit and pay to the patentee a sum equal to three times the price for which the patentee has usually sold or licensed to other persons the use of said invention." Here the price of a license is assumed to be a just measure of single damages, and the forfeiture by way of penalty is fixed at treble that sum. But as experience began to show that some inventions or discoveries had their chief value in a monopoly of use by the inventor, and not in a sale of licenses, the value of a license could not be made a universal rule as a measure of damages. The act of 17th of April, 1800, changed the rule, and compelled the infringer "to forfeit and pay to the patentee a sum equal to three times the actual damage sustained by such patentee." This act continued in force till 1836, when the act now in force was passed.

Experience had shown the very great injustice of a horizontal rule,

equally affecting all cases, without regard to their peculiar merits. The defendant who acted in ignorance or good faith, claiming under a junior patent, was made liable to the same penalty with the wanton and malicious pirate. This rule was manifestly unjust; for there is no good reason why taking a man's property in an invention should be trebly punished, while the measure of damages as to other property is single and actual damages. It is true, where the injury is wanton or malicious, a jury may inflict vindictive or exemplary damages, not to recompense the plaintiff, but to punish the defendant.

In order to obviate this injustice, the Patent Act of 1836 confines the jury to the assessment of "actual damages." The power to inflict vindictive or punitive damages is committed to the discretion and judgment of the court, within the limit of trebling the actual damages found by the jury:

It must be apparent, to the most superficial observer of the immense variety of patents issued every day, that there cannot, in the nature of things, be any one rule of damages which will equally apply to all cases. The mode of ascertaining actual damages must necessarily depend on the peculiar nature of the monopoly granted. A man who invents or discovers a new composition of matter, such as vulcanized India-rubber, or a valuable medicine, may find his profit to consist in a close monopoly, forbidding any one to compete with him in the market, the patentee being himself able to supply the whole demand at his own price. If he should grant licenses to all who might desire to manufacture his composition, mutual competition might destroy the value of each license. This may be the case, also, where the patentee is the inventor of an entire new machine.

If any person could use the invention or discovery by paying what a jury might suppose to be the fair value of a license, it is plain that competition would destroy the whole value of the monopoly. In such cases the profit of the infringer may be the only criterion of the actual damage of the patentee. But one who invents some improvement in the machinery of a mill could not claim that the profits of the whole mill should be the measure of damages for the use of his improvement. And where the profit of the patentee consists neither in the exclusive use of the thing invented or discovered, nor in the monopoly of making it for others to use, it is evident that this rule could not apply.

The case of Stimpson's patent for a turnout in a railroad may be cited as an example. It was the interest of the patentee that all railroads should use his invention, provided they paid him the price of his license. He could not make his profit by selling it as a com-

## Opinion of the court.

plete and separate machine. An infringer of such a patent could not be liable to damages to the amount of the profits of his railroad, nor could the actual damages to the patentee be measured by any known ratio of the profits on the road. The only actual damage which the patentee has suffered in such a case is the non-payment of the price which he has put on his license, with interest, and no more. There may be cases, as where the thing has been used but for a short time, in which the jury should find less than that sum; and there may be cases where, from some peculiar circumstance, the patentee may show actual damage to a larger amount. Of this, a jury must judge from the evidence, under instructions from the court that they can find only such damages as have actually been proved to have been sustained.

Where an inventor finds it profitable to exercise his monopoly by selling licenses to make or use his improvement, he has himself fixed the average of his actual damage, when his invention has been used without his license. If he claims anything above that amount, he is bound to substantiate his claim by clear and distinct evidence. When he has himself established the market value of his improvement, as separate and distinct from the other machinery with which it is connected, he can have no claim, in justice or equity, to make the profits of the whole machine the measure of his demand. It is only where, from the peculiar circumstances of the case, no other rule can be found, that the defendant's profits become the criterion of the plaintiff's loss. Actual damages must be actually proved, and cannot be assumed as a legal inference from any facts which amount not to actual proof of the fact. What a patentee "would have made, if the infringer had not interfered with his rights," is a question of fact, and not "a judgment of law." The question is not what speculatively he may have lost, but what actually he did lose. It is not a "judgment of law," or necessary legal inference, that if all the manufacturers of steam-engines and locomotives who have built and sold engines with a patented cut-off, or steam whistle, had not made such engines, that therefore all the purchasers of engines would have employed the patentee of the cut-off, or whistle; and that, consequently, such patentee is entitled to all the profits made in the manufacture of such steam-engines by those who may have used his improvement without his license. Such a rule of damages would be better entitled to the epithet of "speculative," "imaginary," or "fanciful," than that of "actual."

If the measure of damages be the same, whether a patent be for an entire machine or for some improvement in some part of it, then

## Order.

it follows that each one who has patented an improvement in any portion of a steam-engine, or other complex machines, may recover the whole profits arising from the skill, labor, material, and capital employed in making the whole machine, and the unfortunate mechanic may be compelled to pay treble his whole profits to each of a dozen or more several inventors of some small improvement in the engine he has built. By this doctrine, even the smallest part is made equal to the whole, and "actual damages" to the plaintiff may be converted into an unlimited series of penalties on the defendant.

We think, therefore, that it is a very grave error to instruct a jury "that as to the measure of damages the same rule is to govern, whether the patent covers an entire machine, or an improvement on a machine."

It appears, from the evidence in this case, that McCormick sold licenses to use his original patent of 1834, for twenty dollars each. He sold licenses to the defendants to make and vend machines containing all his improvements, to any extent, for thirty dollars for each machine, or at an average of ten dollars for each of his three patents. The defendants made and sold many hundred machines, and paid that price and no more. They refused to pay for the last three hundred machines, under a belief that the plaintiff was not the original inventor of this last improvement, whereby a seat for the raker was provided on the machine, so that he could ride, and not be compelled to walk, as before. Beyond the refusal to pay the usual license price, the plaintiff showed no actual damage. The jury gave a verdict for nearly double the amount demanded for the use of the three several patents, in a suit where the defendant was charged with violating one only, and that for an improvement of small importance when compared with the whole machine. This enormous and ruinous verdict is but a corollary or necessary consequence from the instructions given in that portion of the charge of the court on which we have been commenting, and of the doctrines therein asserted, and to which this court cannot give their assent or concurrence.

The judgment of the Circuit Court is reversed, with a *venire de novo*.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is



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Argument for the plaintiff in error.

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hereby, remanded to the said Circuit Court, with directions to award *a venire facias de novo*.

REVERSED AND REMANDED.

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THE YORK AND MARYLAND LINE RAILROAD COMPANY, PLAINTIFF IN  
● ERROR, v. ROSS WINANS.

(17 Howard, 30.)

1. A railroad company, organized under a charter from Pennsylvania, is responsible for the infraction of a patent-right respecting cars, although the entire capital stock of the company was held by a connecting railroad company in Maryland, which latter company also worked the road by the instrumentality of its agents, and motive-power, and cars.
2. The obligations to the community which the Pennsylvania company is placed under, by its charter, cannot be evaded by any transfer of its rights and powers to another company; and in this case, the Pennsylvania company contributes to the expense of working the road, and of paying the officers and agents who are employed.
3. Courts will not allow corporations to escape from their proper responsibility, by means of any disguise.
4. Where the patent was signed by an acting Commissioner of Patents, it was not necessary to aver or prove that he was legally entitled to act in that capacity. The court will judicially take notice of the persons who preside over the Patent Office, whether they do so permanently or transiently.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Eastern District of Pennsylvania.

The case is stated in the opinion of the court.

It was argued by *Mr. J. Mason Campbell* and *Mr. Johnson*, for the plaintiff in error, and by *Mr. St. George T. Campbell* and *Mr. Latrobe*, for the defendant.

The points made by the counsel for the plaintiff in error were the following:

The court below (Judge Kane) charged the jury, in substance, that as the infraction complained of was committed on the road of the plaintiff in error, though the cars were owned by the Baltimore and Susquehanna Railroad Company, the plaintiff in error was responsible in this action, because the profits accruing from the use of the cars were divided between the two companies.

He also charged the jury, that in estimating the amount of damages, they were to be guided by the sum which had been fixed by the witnesses as the fair compensation for an annual license for each

car, and were to allow such sum annually, for each car, for a period of six years antecedently to the institution of the suit.

The plaintiff in error will contend that the learned judge below erred in both parts of his charge—

1. As to the liability of the plaintiff in error. The cars which were assumed to be made in violation of the patent of the defendant in error were not built by, and did not belong to, the plaintiff in error. It is not liable, therefore, for their construction; nor is it pretended that it has sold any. If liable at all, it is for a use of the cars.

Now, in point of fact, it did not run the cars in question over its road.

The whole transportation was done by the Baltimore and Susquehanna Railroad Company; and if there has been any user by the plaintiff in error of cars in violation of the patent of the defendant in error, it is a constructive user, growing out of the agreement between it and the Baltimore and Susquehanna Railroad Company, by which one-third of the net revenue from transportation is credited to it, and a user in fact, under that agreement, by the Baltimore and Susquehanna Railroad Company.

This agreement is supposed, by the learned judge below, to do one of two things: either to constitute the relation of principal and agent between the two corporations, or to make them partners.

As to the first view, it may be observed that the subject of the agency being the running of the cars, and the plaintiff in error having nothing to do with the running, it can hardly be deemed an agent, in the face of the fact that it does nothing in the agency. With still less plausibility can it be regarded as a principal; its supposed agent in that case, the Baltimore and Susquehanna Railroad Company, not only owning and running the obnoxious cars itself, but doing so by force of its own power in the premises.

As to the other view, to wit, that of a partnership between the plaintiff in error and the Baltimore and Susquehanna Railroad Company, a more extended examination is necessary.

In the first place, it seems impossible to establish this hypothesis, without conceding that these two corporations would have had a right to form a partnership expressly. Whether the partnership be express or implied, only relates to the nature of the evidence by which it is shown. The thing is the same, however proved. Now, the power to form a partnership is one which corporations do not possess, unless it be given in express terms, or by necessary implication. *Sharon Canal Co. v. Fulton Bank*, 7 Wend., 412; *Canal Bridge v. Gordon*, 1 Pick., 305.

## Argument for the plaintiff in error.

There are neither such words nor implication in the present instance, and, of consequence, no partnership can be deduced where the power to create that relation is wanting.

If, however, the power be conceded, and no partnership has been in terms formed, it is only to be implied, in law, from the division of the net profits of transportation between the two corporations, provided for by their agreement.

But the reception of a part of the profits is not always attended with this consequence. Seamen and clerks may receive their pay in this form, without becoming partners thereby, either *inter se* or as to third persons. So a landlord may get his rent in the shape of profits, and not be made a partner by such receipt. The test seems to be in the *animus* of the parties as to the reservation of profits, and not in the reservation itself. If their purpose be compensation merely to one furnishing something necessary to the business, a partnership is not held to be created. Such is the present case, where it is plain that the object was merely to compensate the plaintiff in error for the use of its road, and to make the rent therefor commensurate with the use. Story on Part., secs. 36, 38; 3 Kent's Comm., 33; *Perrine v. Hankenson*, 6 Halsted, 181; *Heimstreet v. Howland*, 5 Denio, 68; *Heckert v. Pegely*, 6 Watts & Serg., 143; *Boyer v. Anderson*, 2 Leigh, 550; *Loomis v. Marshall*, 12 Conn., 69; Collyer on Part., sec. 44, and note.

Conceding, however, *argumenti gratiâ*, that the relation of principal and agent, or of partners, existed between the two corporations, it cannot be denied that the infringements complained of were not committed by the plaintiff in error, but by the Baltimore and Susquehanna Railroad Company.

Now, the tortious acts of the company last named cannot be considered as acts done in the ordinary course of the business between it and the plaintiff in error, whatever be the relation between these parties; and to make the plaintiff in error responsible, it must be shown to be privy to their commission, before or after. Story on Agency, sec. 455; Collyer on Part., sec. 457; *Keplinger v. Young*, 10 Wheat., 358, 363.

But the learned judge below excludes altogether this element of accountability, and makes the plaintiff in error liable, without putting the fact of privity to the jury.

2. The charge below is also erroneous as to the amount of damages recoverable.

It gave the jury to understand that they could find against the

plaintiff in error for a user of the patent of the defendant in error, for six years preceding the commencement of the suit.

But the declaration only charged (Record, 4) a user during the term of seven years for which the extension of the patent had been granted.

Now, the seven years' extension began only on the 1st of October, 1848, and all, therefore, that was recoverable under the declaration was for a user from the 1st of October, 1848, to the time of suit brought, (April, 1851,) a period of less than three years, instead of six, as charged.

3. The suit being only for infringements committed during the extension of the patent, it is further submitted, that the extension being by the acting Commissioner of Patents, is unavailing to give the defendant in error any rights.

If this court, in 4 Howard, 646, meant to affirm the validity of the acts of such a functionary, as is supposed by Mr. Justice Woodbury, in 1 Woodbury and Minot, 248, this point is not now open; but if it be open, the plaintiff in error relies on the first and second sections of the Patent Act of 1846, as governing the Patent Office, to the exclusion of the acts of 1792 and 1795. 1 Stat. at Large, 281, 415.

The counsel for the defendant in error made the following points:

1. The extension of the patent by the acting Commissioner, &c. (The argument upon this head is omitted.)

The remaining exceptions to the charge of the judge were—

1. "That the York and Maryland Line Railroad Company, and the Baltimore and Susquehanna Railroad Company, were two distinct companies as to third persons." The force of this exception is not clearly apprehended. If it is meant to convey the idea that the judge should have charged that the two companies were the same, and not "two distinct companies as to third persons," it is difficult to perceive, first, how it could have been sustained in point of law; or, second, how it would serve the defendants below. They were two corporations, had two charters from different sovereignties, and had never been united by law. How could the judge say, then, that they were not two distinct companies?

But if they were the same company as to third persons, the judge should, as this exception supposes, have so charged; and then the main point of defense, that the use by one was not the use by the other, would have utterly failed.

In fact, however, upon this point, all the judge said, was that if

## Argument for the defendant in error.

there were two tortfeasors, a suit could be maintained against either; for which proposition no authority is needed.

2. The second exception to the charge is—

In charging further, that whether the relation between them was that of agency or partnership, the liability of defendants was the same.

As a legal proposition, standing singly, this can hardly be questioned.

One of two partners is liable to an action for an infringement, as for any other tort committed by his authority, or participated in by him. This was all the judge said. He was not asked to charge—

1. That two corporations cannot form a contract of copartnership.

2. Or that, under the evidence in this cause, there was no proof of partnership.

3. Or that there was no evidence of agency by which the defendants could be held liable.

Not being asked, he expressed no opinion on the point, but simply said, whether the relations were those of partners, or principal and agent, neither would affect the plaintiff's right. In this, there was, it is admitted, no error. If the defendant desired specific instructions, they should have been prayed.

The judge, by limiting his illustration to partnership or agency, actually favored the defendants; for he might have charged, that under the facts, no matter by what name the relation of the companies was called, the defendants were liable, participating as they did in the tort. Grant that no copartnership contract can lawfully be made between two corporations; yet, if they did make it, shall they be allowed to allege its unlawfulness against a third party, whose property is tortiously used for their profit?

If they do make such a bargain, whether lawful or otherwise, and it result in a use by them of the patented improvement, the unlawfulness of the contract by which the use was accomplished can be no defense.

They are complained of for one unlawful act, and this would be to defend it by showing another.

If they participated in the use of the patented thing, no matter how, whether under a lawful or unlawful contract, they are liable. It is the doing of the thing, and not the mode in which it is done, that is complained of.

Without defining the relations of the parties, the defendants, upon this view, are clearly liable.

Whether the contract was lawful or unlawful, its effect was to

make the act of one the act of the other; the use by one the use by the other.

If, however, the relation of the two companies is here to be considered, and its character, not made the subject of an express point in the court below, is to be argued, it will be contended that such a use of the thing patented was proved as made the defendants liable, in any view that can be taken of the case.

1. Whether the use proved was to be regarded as a direct and independent use by the defendants below.

2. Or as a use through their agents, (the Maryland company,) with their knowledge, by their authority, upon their property, and of which use they directly received a portion of the profits.

3. Or as a use, as a partner, with the Maryland company, paying a proportion of losses by, and receiving a proportion of the profits, as such, from the use.

4. Or whether contributing as they did their road, which was essential to the availability of the cars of the Susquehanna company, the defendants below were to be looked upon, as suggested by the judge's charge, as the agents of the former company.

1. There was evidence of a direct and independent use by the defendants below, to the prejudice of the patentee.

The defendants were a Pennsylvania company, fully organized, and having possession of their road.

The uses made of their road were their own uses. The road and the cars upon it are a single machine, the use of a part of which involves the use of all other parts. The cars are useless without the road. The road is useless without the cars. The terms upon which the cars are permitted to be used are immaterial. The injury complained of is the use.

It is this which distinguishes this case from the case of *Keplinger v. Young*, 10 Wheaton, 358. There Young was held not to be liable, because he only purchased the product of a machine; but it would have been different had he taken the machine into his own keeping, and used it.

Indeed, in that case the court intimate that had the facts from which it might fairly have been inferred that Young used the machine been before them, the result might have been different.

2. Even if the fact of the ownership of the cars by the Maryland company is inconsistent with this view, yet the Maryland company, using the defendants' road only through their consent, can occupy no other position than that of agents, for whose acts, done in the

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Argument for the defendant in error.

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course of their business, the principals must be responsible, especially as they are directly benefitted by them.

The Pennsylvania company may, by law, run cars on their own road. The Maryland company has no right to do so, by law, within Pennsylvania. Their charter gives, and can give, no such authority; and such running would be a nuisance, if done by them in Pennsylvania, and could not be justified under their own charter. The Pennsylvania company, duly chartered, build a road; they need rolling-stock, and the patented cars are used as such, and they receive one-third of the net profits of the earnings thereof. Without this, the Maryland company could not use the Pennsylvania road; by it, they become, for a fluctuating compensation, the agents of the Pennsylvania company, to stock and run their road. If there can be no partnership, they enter Pennsylvania by virtue of this agency alone. A portion of the things done by them in the fulfillment of that agency, by the authority, with the sanction, and upon the property of the defendants, is to use the patented improvement. A proportion of the repairs upon it are charged to the principal; a portion of the profits from its use is paid to the principal. No authorities are needed to show that for an injury by an agent the principal or the agent may be sued. The ownership of the infringing machine is immaterial; its use alone is in controversy; and it will be submitted that such an use, by an agent, as is here proved, will render the principal liable.

3. Or, regarding the use as the result of a partnership with the Maryland company, the defendants paying a proportion of losses and receiving a proportion of the profits, as such, from the use, the latter must be liable to the patentee.

Under this head, the second of the exceptions to the charge of the judge will be properly considered.

There was some relation between the companies, surely. What was it? If in fact it be that the Maryland company were simply using a Pennsylvania charter to carry on their business,—a change of name merely,—the stock, property, and everything being owned by the same parties, then, in Pennsylvania, the Maryland company's use was the Pennsylvania company's use.

The judge does not, however, define the character of this relation. He was not called upon to do so.

If it were needful, it might be well contended that the relation of the companies was that of partnership. Corporations may form partnerships under circumstances, so far, at least, as to preclude them from setting up separate rights, to the prejudice of third persons.

In the case of *Canal Bridge v. Gordon*, 1 Pick., 297, which was a case where a bridge and an embankment leading to it were owned by different corporations, Parker, C. J., after referring to the technical difficulties of considering several corporations as copartners, goes on to say, what covers precisely the present controversy: "And yet, if they are all composed of the same individuals, using several corporate powers for the same end and purpose, with nothing but the form of a record to distinguish them, equity would seem to require that they should not be allowed to sever, to the prejudice of any person with whom either might contract."

And for the same reason, where both are benefitted by the wrong done by one of them, they should not be allowed to sever.

That contracts of the same nature are looked upon and treated as partnerships, will further appear by reference to the following authorities: 4 Law and Equity Reports, 171; 2 Id., 319.

In the present case, there was every element required to form a partnership contract.

It is not the case where a portion of the gross receipts was used as a mode of calculating rent, as in 5 Denio, 68, cited by plaintiff in error, but a right to a share of the net profits, as such, which that case decides to be a criterion of partnership. Nor is it the case in 17 Wendell, 412, where it was held that two corporations cannot sue jointly, as corporations, in contract; but where it was not held that if, in fact, such partnership existed, either could escape liability for a tort arising in that relation, by alleging its unlawfulness.

The law of New York, upon this question of partnership liability to third persons, is clearly settled in *Bostwick v. Champion*, 11 Wend., 571, where it was held, that where A, B, and C run a line of coaches, the route being divided between them into sections, each furnishing his own horses and coaches, and hiring drivers, and paying the expenses of his own section, the fare, less the tolls, being divided in proportion to the number of miles run, that a passenger injured by negligence of the drivers of A's coach might sue them all.

The court is referred to the opinion of Judge Nelson, at page 584, and to same case, Chancellor Walworth's opinion, 18 Wend., 175.

A division of profits, as profits, and a right to file a bill for an account, may be regarded as conclusive evidence of a copartnership contract.

Both, it is submitted, concur here.

The distinction which, it is believed, will reconcile all the cases, is between a stipulation for a compensation proportioned to the profits, and one for an interest in such profits.



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Opinion of the court.

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To this effect, the cases are numerous. See Carey on Part., 9; Story on Part., 36; Bissett on Part., 4; Collyer on Part., 44, and the cases here cited.

Every element referred to by these authorities exists here.

If they may so contract as partners, it will be contended that the evidence exhibits every feature required by law for that relation.

If not liable as joint tort feasers or partners, from want of legal authority to make such a contract, or if the contract as made does not by law create this relation, still the defendants are liable by reason of the use made of this road by the Susquehanna company.

Mr. Justice CAMPBELL delivered the opinion of the court.

The plaintiff is a corporation existing under a charter from the State of Pennsylvania, and authorized to construct a railroad from the town of York to the Maryland line. Its stock was subscribed for by the Baltimore and Susquehanna Railroad Company, a Maryland corporation, and their joint capital is vested in a continuous railroad from the city of Baltimore to York. The management of the road is committed to the Maryland company, which appoints the officers and agents upon it, and furnishes the rolling-stock necessary for its operation. The president and secretary of the two companies are the same. The directors of the Pennsylvania corporation (plaintiff) are selected by the Maryland company, and are qualified by a transfer of one or more shares of its stock to them, shortly before an election, and which they return on vacating their office. This nominal organization is made necessary by the charter, which requires that the majority of the officers shall be citizens of Pennsylvania, and that annual reports of the condition and business of the company shall be rendered to the legislature. To preserve appearances with the legislature, an annual statement is made.

In this, the gross receipts of the entire road for the year are ascertained, and the expenses deducted; the balance is then divided, one-third being assigned to the plaintiff; but no money passes between the corporations. In these expense accounts, the salaries of officers, conductors, and engineers, the cost of locomotives and fuel, of the repairs and insurance of cars, and the losses of business, enter as constituent items. It was admitted, upon the trial of the cause, that a number of cars, made according to the specification of the patent of the defendant, had been used upon the road without his license, and for which he brought this suit. A verdict was rendered in his favor, and the judgment thereon is brought to this court, upon exceptions to the instructions of the Circuit Court to the jury.

The court charged the jury, that the road on which the infraction was committed was held under a Pennsylvania charter to the defendant in that court; that the transportation on the road was carried on by the Maryland corporation; and that the profits accruing from the use of the cars upon the road—that is, the profits of the infraction—are nominally divided between the two companies. That upon these facts, the plaintiff is entitled to recover against the present defendants, whether they are to be regarded as partners, or as principal, or agent of the Maryland corporation.

The plaintiff complains here of this charge, for that the cars employed were not built by, and did not belong to, the company; that they were the exclusive property of the Maryland corporation; and that the agreement to divide the profits did not constitute a partnership, nor evince a relation of principal or agent to impose a liability. This conclusion implies that the duties imposed upon the plaintiff by the charter are fulfilled by the construction of the road, and that by alienating its right to use, and its powers of control and supervision, it may avoid further responsibility. But those acts involve an overturn of the relations which the charter has arranged between the corporation and the community. Important franchises were conferred upon the corporation, to enable it to provide the facilities to communication and intercourse required for the public convenience. Corporate management and control over these were prescribed, and corporate responsibility for their insufficiency provided, as a remuneration to the community for their grant. The corporation cannot absolve itself from the performance of its obligations, without the consent of the legislature. *Beman v. Rufford*, 1 Simon, N. S., 550; *Winch v. B. and L. Railway Company*, 13 L. & E., 506.

If, then, the case had terminated with the facts that the infringement of the defendant's patent had taken place, by the acts of persons using the corporate name of the plaintiff, with the assent of the corporate authorities, their liability would have been fixed.

But the case before us is, that the motive-power on the road partly belongs to the plaintiff; that the agents and officers employed are in its service, and are paid by it; and that the cars are fitted and repaired at the common expense of the two corporations. It follows, therefore, that the plaintiff is a principal, coöperating with another corporation, in the infliction of a wrong, and is directly responsible for the resulting damage.

Nor will the plea that the corporation has no independent nor responsible existence, as regards the Maryland company, and that its

## Opinion of the court.

display of a president and directors, of conductors, engineers, and agents, of annual elections and annual statements, import only a formal and illusive representation before the Legislature of Pennsylvania, or their constituents, of a compliance with the conditions of the charter, avail the plaintiff. It is certainly true, that the law will strip a corporation or individual of every disguise, and enforce a responsibility according to the very right, in despite of their artifices. And it is equally certain, that, in favor of the right, it will hold them to maintain the truth of the representations to which the public has trusted, and estop them from using their simulation as a covering or defense. *Welland Canal Co. v. Hathaway*, 8 Wend., 480.

The Supreme Court of Pennsylvania, in *Peters v. Ryland*, 8 Harris, 497, has announced principles decisive of this case.

The court held, that the owner of a passenger-car, employed on a railroad belonging to the State, and the motive-power and superintendence of which is furnished by the State, is responsible for the misconduct of the public agents. It says: "The case before them is *sui generis*; but it comes much nearer to that class of decisions in which it has been held, that several parties engaged in carrying over different portions of the same line of conveyance, each sharing in the profits of the whole route, and of course of each section of it, are all responsible for the faithful discharge of their duty, and liable to respond in damages for any injury which results from the negligence or unskillfulness of any of the proprietors and servants." 11 Wend., 571; 18 Id., 175; 19 Id., 534.

"The State, as well as the carrier, is paid for every passenger transported on this railroad, which shows their community of interest; and if there be a common liability, that of the State cannot be enforced by action; and this circumstance does not diminish that of the carrier. Because they have a common interest, however, and share the business of transportation, it is apparent, that in holding the party before us to answer for the negligence of the State's agents, we do not punish one man for the misfeasance of another's servants."

The objection taken to the patent, that it is signed by "an acting Commissioner of Patents," and that the record contains no averment nor proof of his title to the office, is not tenable. The court will take notice judicially of the persons who from time to time preside over the Patent Office, whether permanently or transiently; and the production of their commission is not necessary to support their official acts. *Wilson v. Rousseau*, 4 How., 686.

The judgment of the Circuit Court is affirmed.

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Statement of the case.

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**ORDER.** This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Eastern District of Pennsylvania, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, affirmed with costs, and interest until paid, at the same rate per annum that similar judgments bear in the State of Pennsylvania.

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**THE TROY IRON AND NAIL FACTORY, APPELLANT, v. GEORGE ODIORNE, JR., AND FRANCIS ODIORNE.**

(17 Howard, 72.)

A machine for making hook-headed spikes was constructed in Boston prior to the 18th of April, 1839, and therefore not within a patent for a machine for a similar purpose which Burden applied for on that day.

(Mr. Justice CURTIS, having been of counsel, did not sit in this cause.)

THIS was an appeal from the Circuit Court of the United States for the District of Massachusetts, sitting as a court of equity.

It was a bill filed by the Troy Iron and Nail Factory, a manufacturing corporation established in the State of New York, to restrain the Odiornes from infringing certain letters patent granted to Henry Burden on the 2d of September, 1840, and by him assigned to the complainants.

The respondents filed an answer, taking various grounds of defense, which it is not necessary, under the circumstances of the case, to particularize. At October Term, 1851, the following stipulation was signed by the parties, and filed in the cause:

“The defendants agree not to deny the validity of the complainants’ patent, provided they make out their title to the said letters patent to be good.

“They also agree not to deny that the machine complained of in the complainants’ bill is an infringement on the patent granted to H. Burden on August 4, 1840. [Sept. 2.]

“If the complainants shall establish their title to the letters patent aforesaid, the proper decree may be entered for the complainants, unless the defendants shall prove that the spike-machine used by them, and complained of in the bill aforesaid, was constructed prior

## Opinion of the court.

to the alleged application of H. Burden, made April 18, 1839, for letters patent therefor, according to the provisions of the statute of the United States, 1839, ch. 88, sec. 7; or was the result of an independent original invention, prior in time to the invention of the said Burden; in either of which cases, the proper decree shall be entered for defendants.

“C. P. CURTIS, JR., *Plaintiff's Attorney.*

“J. A. ANDREW, *for Defendants.*”

Much testimony was taken upon the subjects involved, and in December, 1852, the Circuit Court dismissed the bill.

From this decree the complainants appealed to this court.

The case was argued by *Mr. George T. Curtis*, for the appellants; no counsel appearing for the appellee.

The argument upon the point upon which the court rested its decision consisted of an examination of the evidence bearing upon it, which it is not necessary to state.

Mr. Justice CATRON delivered the opinion of the court.

Henry Burden obtained a patent, in 1840, for a machine to make hook-headed spikes. He applied for the patent on the 18th of April, 1839. It was assigned to the Troy Iron and Nail Company, who filed a bill against the Odiornes, to enjoin them, and for an account for using a machine to make similar spikes; and which machine, it is alleged, infringed the monopoly secured to Burden by his patent of 1840. The case was brought to a hearing on the following stipulation:

“The defendants agree not to deny the validity of the complainants' patent, provided they make out their title to the said letters patent to be good.

“They also agree not to deny that the machine complained of in the complainants' bill is an infringement on the patent granted to H. Burden on August 4, 1840.

“If the complainants shall establish their title to the letters patent aforesaid, the proper decree may be entered for the complainants, unless the defendants shall prove that the spike-machine used by them, and complained of in the bill aforesaid, was constructed prior to the alleged application of H. Burden, made April 18, 1839, for letters patent therefor, according to the provisions of the statute of the United States, 1839, ch. 88, sec. 7; or was the result of an independent original invention, prior in time to the invention of the said

## Syllabus.

Burden; in either of which cases, the proper decree shall be entered for defendants."

The only question presented for our consideration on the stipulation, is whether the machine employed by the appellees was constructed prior to the 18th of April, 1839, when Burden made application at the Patent Office for his patent.

The machine complained of was built by Richard Savary, for the Boston Iron Company, in the spring of 1839, and obtained by the appellees by assignment. Savary was the patentee of a machine to make ship and boat spikes, and, at the suggestion of the agents of the Boston Iron Company, added an attachment of an apparatus to make a hook-head to spikes; the process for making which Savary deposes he discovered in August, 1838. The time at which this apparatus was attached to the machine (substantially complete in its operative parts) is the time when the machine complained of was "constructed," in the sense of the stipulation, it not being necessary that the machine should be geared and doing work. We are satisfied that it was set up and substantially finished before the 18th of April, 1839, and therefore order the decree below to be affirmed.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Massachusetts, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of the said Circuit Court in this cause be, and the same is hereby,

AFFIRMED WITH COSTS.

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JOSEPH BATTIN, PATENTEE, AND SAMUEL BATTIN, ASSIGNEE, PLAINTIFFS IN ERROR, v. JAMES TAGGERT, DEFENDANT IN ERROR. JOSEPH BATTIN, PATENTEE, AND SAMUEL BATTIN, ASSIGNEE, PLAINTIFFS IN ERROR, v. ROBERT RADCLIFFE AND JOHN JOHNSON, DEFENDANTS IN ERROR. JOSEPH BATTIN, PATENTEE, AND SAMUEL BATTIN, ASSIGNEE, PLAINTIFFS IN ERROR, v. JOHN G. HEWES, DEFENDANT IN ERROR.

(17 Howard, 74.)

1. Whether the defect be in the specifications or in the claim of a patent, the patentee may surrender it, and, by an amended specification or claim, cure the defect.
2. When this is done, and a reissued and corrected patent is taken out, the omissions and defects are cured; and nothing within the scope of the patentee's

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Statement of the case.

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original invention can be considered as having been dedicated to the public, by the lapse of time between the original and reissued patent.

3. Hence, where a patent was taken out for a new and useful improvement in the machine for breaking and screening coal, and the claim was for the manner in which the party had arranged and combined with each other the breaking-rollers and the screen, and the amended specification of the reissued patent described essentially the same machine as the former one did, but claimed as the thing invented the breaking apparatus only, a dedication to the public did not accrue in the interval between the one patent and the other.
4. It was for the jury to determine, from the facts in the case, whether the specifications, including the claim, were so precise as to enable any person skilled in the structure of machines to make the one described; also, to judge of the novelty of the invention, and whether the renewed patent was for the same invention as the original patent; also, whether the invention had been abandoned to the public. The jury were also to judge of the identity of the machine used by the defendant with that of plaintiffs, or whether they have been constructed and act on the same principle.

THESE three cases were argued and decided together. They were brought up by writ of error from the Circuit Court of the United States for the Eastern District of Pennsylvania.

On the 6th of October, 1843, Joseph Battin obtained a patent for a new and useful improvement in the machine for breaking and screening coal, which he defined in his specification as one in which the breaking and screening were effected simultaneously, by a set of breaking-rollers, of a certain form, operating in connection with an assorting-screen. After describing the machine, the claim was made as follows, namely:

“Having thus fully described the nature and operation of my machine for breaking and screening coal, what I claim as new therein, and desire to secure by letters patent, is the manner in which I have arranged and combined with each other the breaking-rollers and the screen, the respective parts being formed and operating substantially as herein set forth and made known. JOSEPH BATTIN.”

On the 20th of January, 1844, he took out another patent for the addition of a third, or auxiliary roller, of smaller diameter than the two at first used, and placed above them, and claimed as follows:

“Having thus fully described the nature of my improvement in the manner of combining and arranging the toothed rollers used in the machine for breaking coal, what I claim therein as new, and desire to secure by letters patent, is the so forming and gearing of such rollers as that the teeth of one of them shall always be opposite to a space between the teeth in the other, whenever they are operating upon the article to be broken; the same being effected substantially in the manner herein set forth. JOSEPH BATTIN.”

A suit was brought by Battin against Clayton, in the Circuit Court for the Eastern District of Pennsylvania, to recover damages for the infringement of the patent of October 6, 1843, when the court held, that "the patent being merely for the combination of machinery, it could neither be supported nor assailed by proof of the novelty of the parts." The plaintiff thereupon submitted to a nonsuit; surrendered the patents of 1843 and 1844, and obtained a reissue of the patent of 1843, upon an amended specification. The patent of 1844 was not reissued.

The description of the machine and claim in the reissued patent concluded as follows, namely:

"By the construction and arrangement of the breaking-rollers, it will be perceived, that, as they rotate, the teeth constitute a series of progressive levers, which act on opposite sides of the lumps, and being placed so as not to coincide, snap, or break the lumps between the points of pressure; this pressure gradually increasing until the separation is effected, that is, during the rotation, until the teeth reach a plane passing through the axis of the two rollers, and then the effect having been produced, the teeth recede to liberate the lumps, and thus avoid the further reduction of the material. This mechanical action of the rotary teeth is thus adapted to the frangible or brittle nature of coal, which is readily pulverized, when subjected to a continued percussion or pressing action.

"It will be obvious, from the foregoing, that the form and size of the teeth may be greatly varied, as well as the space between the periphery of the two rollers, without changing the principle or mode of operation of my invention, so long as the two rollers are geared together, and the teeth of one are in the rotation made to come opposite to, or in the space between, the teeth of the other, and *vice versa*, space sufficient to hold the required size of lumps of coal being left between the teeth of the two rollers, when passing a plane which coincides with the axis of the two rollers.

"What I claim, therefore, as my invention, and desire to secure by letters patent, is the arrangement of the teeth on the two rollers, substantially as herein described, so that, in their rotation, the teeth of one shall come opposite the spaces between the teeth of the other, with sufficient space between to hold lumps of the required size, the rollers being so combined, by gearing, as to make them rotate in opposite directions, and, with the required velocities, to retain the relative position of the teeth of the two rollers, as described.

"JOSEPH BATTIN."



## Statement of the case.

At April Term, 1850, Joseph Battin, as patentee, and Samuel Battin, as assignee of an undivided half part, brought suits against the three parties named as defendants in error in the caption of this report. The defendants pleaded not guilty, and the cause came up for trial, when the jury found a verdict for the plaintiff for \$800. Upon motion of the counsel for the defendants, a new trial was granted, the following reasons being filed:

1. The court erred in deciding that the patent of September 4, 1849, was for the same invention as that claimed in the patent of October 6, 1843, and could be included in the reissued patent.

2. The court erred in deciding that the suits can be maintained in the name of Samuel Battin, as assignee, under the assignment to him of February, 1844.

3. The copy of the assignment from the Patent Office was illegally received in evidence for any purpose.

4. The court erred in permitting the plaintiff to amend his declaration, in a material matter of substance, without any condition, and without granting a continuance to the defendants, as requested.

5. Material evidence, on the part of the defendants, was excluded by the construction given to the defendants' notice of special matter, which, if received, would have produced a different result.

6. Important evidence was discovered when it was too late to give notice, and during the trial, which is set forth in the affidavit of John L. L. Morris, which was presented to the court.

7. The court erred in the instruction given to the jury as to the grounds upon which they should ascertain the actual damages.

8. The damages are excessive.

At October Term, 1852, the cause came up again for trial, when the jury, under the instructions of the court, found a verdict for the defendants.

The bill of exceptions set forth the whole of the evidence, and the entire charge of Judge Kane to the jury.

The plaintiffs took exceptions to the charge, on the following grounds, namely:

That the learned judge erred—

1. In the construction given by him to the patents and specifications of October, 1843, February, 1844, and September, 1849.

2. In ruling, as matter of law, that the patentee had given his invention to the public.

3. In construing the thirteenth section of the act of 1836, and the seventh section of the act of 1837.

4. In charging the jury that "Mr. Battin's invention, as he now

defines it, was in use for nearly six years before he claimed that it was his property. He had made it known as an unprotected element of the combination he patented in 1843. It was not till 1849 that he asserted any other right in it for himself than he conceded to everybody else. He cannot reclaim what he has thus given to the public." And in not submitting to the jury the facts proved in regard to the origin and use of the invention.

5. In directing the jury that a description by the applicant for a patent of a machine, or a part of a machine, in his specification, unaccompanied by notice that he has rights in it as inventor, or that he desires to secure title to it as patentee, is a dedication of it to the public; and that such a dedication cannot be revoked after the machine has passed into public use, either by surrender and reissue, or otherwise.

6. In holding that the facts of this case are embraced in the foregoing propositions.

7. In not deciding that the patent of 4th of September, 1849, is good and valid in law.

8. In directing the jury to find a verdict for the defendant.

It is difficult to explain the nature of some of these objections, without setting forth the entire charge, which cannot be done. The following extracts, however, from the charge, appear to contain the ruling upon those points on which the decision of this court turned. The charge said:

"It is said that the present defendants are using the apparatus described in this reissued patent, and that they should be mulcted in damages accordingly. But there are two legal positions, of a general character, which appear to me to bar the plaintiffs' right of recovery. They are these:

"1. That a description, by the applicant for a patent of a machine, or a part of a machine, in his specification, unaccompanied by notice that he has rights in it as inventor, or that he desires to secure title to it as patentee, is a dedication of it to the public.

"2. That such a dedication cannot be revoked after the machine has passed into public use, either by surrender and reissue, or otherwise.

"The first of these propositions will hardly be disputed. If an inventor has a right at all to give up his invention to the world, there is no more unequivocal way of doing so than by publishing it on the records of the Patent Office, and at the same time making no claim to it as his exclusive property. There is no need of a formal disclaimer, where no claim can be implied; and the implication is all

## Argument for the plaintiffs in error.

the other way, when, of several things described, one is claimed without the rest.

“The second proposition also seems to be susceptible of easy demonstration. Protection is given to an inventor, under the Patent Laws, as the consideration for his disclosing what was not known before, not as a tribute of civic gratitude for ‘good deeds past.’ He loses his right, if he allows his invention to become known before he patents it; and when he does patent it, he is required so to describe it, at the very outset, that others may not only know how to use it profitably after his patent shall have expired, but be able to distinguish it from other things while his patent is in force.”

And again :

“Mr. Battin’s invention, as he now defines it, was in use for nearly six years before he claimed that it was his property. He had made it known as an unprotected element of the combination he patented in 1843. It was not till 1849 that he asserted any other right in it for himself than he conceded to everybody else. He cannot reclaim what he has thus given to the public.

“For these reasons, we instruct you that your verdict, in each case, must be for the defendants.”

The cause was argued in this court by *Mr. Keller* and *Mr. Dallas*, for the plaintiffs in error, and by *Mr. Sheppard*, *Mr. Mallery*, and *Mr. St. George T. Campbell*, for the defendants in error.

The following were the points made by the counsel for the plaintiffs in error :

1. That the court erred in charging, as will be found in the first and second propositions of the charge, “That a description, by the applicant for a patent of a machine, or a part of a machine, in his specification, unaccompanied by notice that he has rights in it as inventor, or that he desires to secure title to it as patentee, is a dedication of it to the public;” and “that such a dedication cannot be revoked after the machine has passed into public use, either by surrender or reissue, or otherwise.”

2. That the error in the foregoing propositions of the charge involves error in the construction of the thirteenth section of the act of July 4, 1836, and in the construction of, and the force given to, the several patents put in evidence.

3. That the court erred in determining, judicially, by the construction of the surrendered and cancelled patents, that the reissued patent of September, 1849, is not for the same invention intended to

## Argument for the defendants in error.

have been patented by the patent of October, 1843, instead of submitting the question as matter of fact to be determined by the jury.

4. That the court erred in ruling, as matter of law, that the patentee had dedicated or abandoned his invention to the public, instead of submitting it as a question of fact to be determined by the jury.

The counsel for the defendants in error made the following points:

1. The first patent (October 6, 1843) was not for the breaking-rollers, but for the combination of the breaking-rollers and the screen.

2. If the patentee described the rollers and the screen, but did not claim them, it was a waiver of his rights, if any he had therein, as inventor, and an abandonment of them, by operation of law, to public use.

3. If the original patent of 1843 was for the combination of the breaking-rollers and the screen, and if the patentee, by describing the rollers, without claiming them, allowed them to go into public use, with a waiver of his rights, if he had any, it is submitted that he cannot, in 1849, reclaim the rollers.

The different claims were thus set forth. The want of sameness is evident on the face of the patents, and the repugnancy is manifest upon inspection and comparison:

Claim in original patent of October 6, 1843.

Having thus fully described the nature and operation of my machine for breaking and screening coal, what I claim as new therein, and desire to secure by letters patent, is the manner in which I have arranged and combined with each other the breaking-rollers and the screen; the respective parts being formed and operating substantially as herein set forth and made known.

Claim in the patent of February 12, 1844, which was subsequently surrendered, cancelled, and not reissued.

Having thus fully described the nature of my improvement in the manner of combining and arranging the toothed rollers used in the machine for breaking coals, what I claim therein as new, and desire to secure by letters patent, is the so forming and gearing of such rollers as that the teeth of one of them shall always be opposite to a space between the teeth in the other, whenever they are operating upon the article to be broken, the same being effected substantially in the manner herein set forth.

Claim in the reissued patent of Sept. 4, 1849.

What I claim, therefore, as my invention, and desire to secure by letters patent, is the arrangement of the teeth of the rollers, substantially as herein described, so that, in their rotation, the teeth of one shall come opposite the space between the teeth of the others, with sufficient space between to hold lumps of the required size, the rollers being so combined, by gearing, as to make them rotate in opposite directions, and, with the required velocities, to retain the relative position of the teeth of the two rollers, as described.

Here the reissued patent, instead of being for the same invention as the original patent, was for an invention patented in letters patent issued after the original patent, and which have been surrendered, cancelled, and not reissued. The patentee having surrendered that patent, cannot include its subject-matter in the reissue of a prior patent.

## Opinion of the court.

Mr. Justice McLEAN delivered the opinion of the court.

This case is before us on a writ of error to the Circuit Court for the Eastern District of Pennsylvania.

The action was brought for the infringement of a patent. The jury, under the instructions of the court, found a verdict for the defendant. Exceptions were taken to the rulings of the court, which present the points of law for consideration.

On the 6th of October, 1843, Joseph Battin obtained a patent for the invention of a new and useful improvement in the machine for breaking and screening coal.

After describing the different parts of the machine, he sums up by saying: "Having thus fully described the nature and operation of my machine for breaking and screening coal, what I claim as new therein, and desire to secure by letters patent, is the manner in which I have arranged and combined with each other the breaking-rollers and the screen; the respective parts being formed and operating substantially as herein set forth and made known."

An improvement to the above machine, by adding an auxiliary roller, was patented to Battin on 20th of January, 1844; and on the 12th of February, 1844, another patent was granted to him for a new and useful improvement in the machine for breaking coal.

In his specification, he says that he had made a new and useful improvement in the manner of combining and arranging the toothed rollers used in the machine for breaking coal, "which rollers, as combined and arranged by me, are described as follows, in the specification attached to letters patent for a machine for the effecting simultaneously the breaking and screening of coal, granted to me under date of the 6th day of October, 1843: The breaking part of my machine consists of two rollers of cast iron, the peripheries of which are provided with teeth so placed as that, in the revolution of the rollers, the teeth of each of them shall stand opposite to the spaces formed by two contiguous teeth on the opposite roller. These rollers are geared together, in order to preserve the same relative position."

In the above-named letters, he says: "The manner of arranging and combining the toothed rollers was not made the subject of a claim, the said patent having been obtained for the combining of a roller breaking-machine, with a screen for separating the coal into the different sizes required; but as the breaking-rollers, so formed, and arranged, and combined, are applicable to the ordinary cylinder breaking-machine, when not used in combination with a screen, and as I have found, by continued experiment, that such rollers constitute a real improvement in any breaking-machine, I have determined to

secure to myself the benefit of such improvement, in a distinct and separate patent therefor. Rollers for the breaking of stone, of ores, of coal, of corn, and of other substances, have been frequently constructed, and are well known," &c.

And he adds: "Having thus fully described the nature of my improvement in the manner of combining and arranging the toothed rollers used in the machine for breaking coal, what I claim therein as new, and desire to secure by letters patent, is the so forming and gearing of such rollers as that the teeth of one of them shall always be opposite to a space between the teeth in the other, whenever they are operating upon the article to be broken; the same being effected substantially in the manner herein set forth."

And afterwards, on the 4th of September, 1849, the said Joseph Battin obtained a patent, in which it is stated that he had invented a new and useful machine for breaking coal, for which letters patent were granted to him, dated October 6, 1843, to which was added an additional improvement, dated 20th of January, 1844, and said letters having been surrendered by him, the same have been cancelled, and new letters patent have been ordered to issue to him, on an amended specification. He also surrendered the patent granted to him on the 12th of February, 1844, for an improved machine for breaking coal, which patent is hereby cancelled, but not reissued, &c.

After describing the invention, he sums up by saying: "What I claim, therefore, as my invention, and desire to secure by letters patent, is the arrangement of the teeth on the two rollers substantially as herein described, so that in their relation the teeth of one shall come opposite the spaces between the teeth of the other, with sufficient space between to hold lumps of the required size, the rollers being so combined in gearing as to make them rotate in opposite directions, and, with the required velocities, to retain the relative position of the teeth of the two rollers as described."

In the sixth section of the Patent Act of 1836, it is declared, that "before any inventor shall receive a patent, he shall deliver a written description of his invention in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains to make and construct the same; and in case of any machine, he shall fully explain the principle, and the several modes of the application of the machine, so that it may be distinguished from other inventions; and shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery."

And by the thirteenth section of the same act, it is provided, "that

## Opinion of the court.

when a patent shall be inoperative or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention more than he had or shall have a right to claim as new, if the error has or shall have arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, &c., to cause a new patent to be issued to the said inventor, for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification; and the patent so issued shall have the same effect and operation in law, on the trial of all actions hereafter commenced, for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing of the original patent."

In his charge to the jury, the district judge said: "The case of *Battin v. Clayton*, which was before us some time ago, grew out of an alleged infraction of this patent of 1843. We held, on the trial of that case, that the patent being merely for the combination of machinery, it could neither be supported nor assailed by proof of the novelty, or want of novelty, of the parts. The patent was thereupon surrendered, and a new one issued on the 4th of September, 1849, under an amended specification, which described essentially the same machine as the former one did, but claimed as the thing invented the breaking apparatus only."

And he remarks: "It is said that the present defendants are using the apparatus described in this reissued patent, and that they should be mulcted in damages accordingly." But there are two legal positions of a general character which appear to me to bar the plaintiff's right of recovery. They are these:

1. That a description, by the applicant for a patent of a machine, or a part of a machine, in his specification, unaccompanied by notice that he has rights in it as inventor, or that he desires to secure title to it as a patentee, is a dedication of it to the public.

2. That such a dedication cannot be revoked after the machine has passed into public use, either by surrender and reissue, or otherwise.

The above instructions, we think, were erroneous.

Whether the defect be in the specifications or in the claim, under the thirteenth section above cited, the patentee may surrender his patent, and, by an amended specification or claim, cure the defect. The reissued patent must be for the same invention substantially,

though it be described in terms more precise and accurate than in the first patent. Under such circumstances, a new and different invention cannot be claimed. But where the specification or claim is made so vaguely as to be inoperative and invalid, yet an amendment may give to it validity, and protect the rights of the patentee against all subsequent infringements.

So strongly was this remedy of the patentee recommended by a sense of justice and of policy, that this court, in the case of *Grant v. Raymond*, 6 Peters, 218, sustained a reissued and corrected patent, before any legislative provision was made on the subject. In that case, the chief justice said: "It will not be pretended that this question is free from difficulty. But the executive departments, it is understood, have acted on the construction adopted by the Circuit Court, and have considered it as settled. We would not willingly disregard the settled practice, in a case where we are not satisfied it is contrary to law, and where we are satisfied it is required by justice and good faith." The same principle was sanctioned in the case of *Shaw v. Cooper*, 7 Pet., 310.

How much stronger is a case under the statute which secures the rights of the patentee by a surrender, and declares the effect of the reissued and corrected patent? By the defects provided for in the statute, nothing passes to the public from the specifications or claims, within the scope of the patentee's invention. And this may be ascertained by the language he uses.

In the case of *Stimpson v. The West Chester Railroad Company*, 4 Howard, 380, it was held, that "where a defective patent had been surrendered, and a new one taken out, and the patentee brought an action for a violation of his patent-right, laying the infringement at a date subsequent to that of the reissued patent, proof of the use of the thing patented, during the interval between the original and renewed patents, will not defeat the action." In the same case, it was also held, that the proceeding before the Commissioner, in the surrender and reissue of a patent, is not open for investigation, except on the ground of fraud.

The patent of 1843 was not surrendered on the obtainment of the patent of 1844. That was intended to be a new invention of arranging and combining the toothed rollers, which the patentee says was not made the subject of a claim in the patent of 1843. The patent of 1844 was cancelled, but not reissued, when the patent of 1849 was issued. At that time, the patent of 1843, and the improvement thereon, dated January 20, 1844, were surrendered and cancelled, and new letters patent were issued on an amended specification.



## Order.

The cause of the surrender of the patent of 1843, as stated in the charge to the jury, was the ruling of the court in the case of *Battin v. Clayton*, and that the amended patent of 1849 was consequently obtained. That ruling is not now before us; nor is it necessary to inquire whether the patent of 1843, on the specifications and claim, was sustainable. The plaintiff, by a surrender of that patent, and the procurement of the patent of 1849, with amended specifications, abandoned his first patent, and relied wholly on the one reissued. The claim and specifications in this patent, as amendatory of the first, were within the thirteenth section of the act of 1836. It is said, with entire accuracy, in the charge, in regard to the amended specification of the patent of 1849, that it "described essentially the same machine as the former one did, but claimed as the thing invented the breaking apparatus only." And this the patentee had a right to do. He had a right to restrict or enlarge his claim, so as to give it validity, and to effectuate his invention.

In the argument, the counsel very properly considered the patent of 1844 as not in the case. It was designed to secure a new combination, not included in the first patent; and as the patent of 1844 was surrendered and cancelled, and not reissued, it being equally disconnected with the patent of 1843 and the reissued and corrected patent of 1849, it can have no effect on the claim of the plaintiff.

We think the court also erred in saying to the jury, "We instruct you that your verdict in each case must be for the defendants."

This, as well as the two instructions above noticed, took from the jury facts which it was their province to examine and determine. It was the right of the jury to determine, from the facts in the case, whether the specifications, including the claim, were so precise as to enable any person skilled in the structure of machines to make the one described. This the statute requires, and of this the jury are to judge.

The jury are also to judge of the novelty of the invention, and whether the renewed patent is for the same invention as the original patent; and they are to determine whether the invention has been abandoned to the public. There are other questions of fact which come within the province of a jury, such as the identity of the machine used by the defendant with that of the plaintiff's, or whether they have been constructed and act on the same principle.

The judgment is reversed and the cause is remanded to the Circuit Court for further proceedings.

ORDER. This cause came on to be heard on the transcript of the

## Statement of the case.

record from the Circuit Court of the United States for the Eastern District of Pennsylvania, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a *venire facias de nova*.

JAMES STEVENS, APPELLANT, v. ROYAL GLADDING AND ISAAC T. PROUD.

(17 Howard, 447.)

1. Whether patent-rights and copyrights, held under the laws of the United States, are subject to seizure and sale on execution, is a question upon which the court does not express an opinion in the present case.
2. The seizure and sale, under execution, of "one copper-plate for the map of the State of Rhode Island," did not carry with it the right to print and publish the map.
3. It is distinguishable from a voluntary sale of a plate by the owner thereof.
4. The ownership of a plate, and the ownership of the copyright, are distinct species of property; and the plate may be used without infringing upon the copyright of printing and publishing the map.
5. But the penalties imposed by the seventh section of the act of Congress passed on the 3d of February, 1831, namely, the forfeiture of the printed copies, and the sum of one dollar for each sheet unlawfully printed, cannot be enforced in a court of equity.
6. Under a prayer for general relief, the court can decree for an account of profits. This right is incident to the right to an injunction in copy and patent right cases.

THIS was an appeal from the Circuit Court of the United States for the District of Rhode Island.

It was a branch of the case of *Stevens v. Cady*, reported in 14 Howard, 528, and the difference between the two cases is stated in the opinion of the court.

The decree of the Circuit Court was follows:

*Decree.*

This cause came on to be heard on the bill, answer, replication, depositions, and other papers in the case, and after the hearing, it is ordered by the court that the following entry be made on the minutes in relation to the same:

"The court differ in opinion as to the effect of the sale of the copper-plate, but agree that injunction cannot issue without a return of the money paid for the plate."

Argument for the appellees.

And afterwards, at the same term, Mr. Stevens having the election to return the price of the plate or not, elected not to return the same; upon which the respondents move that the bill be dismissed, which is dismissed as follows:

"This cause having been heard on the bill, answer, and other pleadings therein, and the complainant having refused to return the price of the plate of the map in question, as required by the court,—

"It is now, on motion of the respondents, and by the consideration of the court, ordered, adjudged, and decreed that the said bill be, and the same is hereby, dismissed with costs.

"November Term, A. D. 1849."

From this decree Stevens appealed to this court.

It was submitted on a printed argument by the appellant, and argued by *Mr. Ames*, for the appellees.

*Mr. Ames* made the following points:

1. The seventh section of the act of Congress approved February 3, 1831, entitled "An act to amend the several acts respecting copyrights," (4 Stats. at Large, 438,) inflicting forfeiture and penalties upon those who shall sell any map, &c., "without the consent of the proprietor or proprietors of the copyright thereof first obtained in writing, signed in the presence of two credible witnesses," applies only to persons claiming the right of sale by act of party, and not to those claiming and proving such right by act or operation of law. 4 Stats. at Large, 435; sec. 1; *Hesse v. Stevenson*, 3 Bos. & Pul., 565, 578; *Bloxam v. Elsee*, 1 C. & P., 578; S. C., 11 Eng. C. L. R., 468; S. C. in Error, 6 B. & C., 69; S. C., 13 Eng. C. L. R., 133; *Cartwright v. Amatt*, 2 Bos. & Pul., 43; *Savin et al. v. Guild*, 1 Gallis., 485; *Wilson v. Rousseau*, 4 How., 646; Webster on Patents, 21–23, 82, n. n; Godson on Patents and Copyright, 2d ed., 219, 221, 377, 430; 2 Renouard Traité des Droits d'Auteurs, ch. 3, sec. 4, arts. 204, 205, p. 348, and onwards.

2. Copyrights and patent-rights are, by the law of England, and in conformity to the principles of justice and policy prevailing there, as well as in countries of the civil law, liable as goods and chattels to the payment of the debts of the authors or inventors who may hold them. As goods and chattels, they pass to assignees in bankruptcy, and to provisional assignees in insolvency, as "the assignees" or "representatives" of the bankrupt or insolvent author or inventor, and both in England and in France may be seized and sold on execution or decrees of seizure issued against him. *Hesse v. Stevenson*,

*supra*; *Bloxam v. Elsee*, *supra*; *Cartwright v. Amatt*, *supra*; *Mary York v. Twine*, Cro. Jac., 78; Sewall, Office of Sheriff, 46 Law Lib., 225; Webster on Patents, 21-23; Godson on Patents and Copyright, 219-221, 430; Renouard *Traité des Droits d'Auteurs*, 348, 349, &c., ch. 3, sec. 4, arts. 204, 205.

3. After an author has printed his book or map, in performance of the contract of copyright with the public, and it has thus passed from the condition of a thought or conception still under deliberation, as well as after a patented machine has been completed and sold by the inventor, in fulfillment of the contract of his letters patent, and he has, in any manifest form, clothed his incorporeal right with a valuable corporeal substance, and, abstracting other values for the purpose, has brought it into the condition of property, in the nature of a personal, tangible good or chattel, he thereby has made the right to use and sell the same, appurtenant thereto; and public policy, common honesty, attention to the true interests of the author or proprietor of the copyright, as well as of his creditors, and every legal analogy, require that the two should not be dissevered for the purpose of enabling him to defeat the rights of his creditors, sought through the remedies provided by law. *Wilson v. Rousseau*, 4 How., 682, 684; *Bloomer v. McQuewan et al.*, 14 Id., 549, 550, 553, 554; 2 Renouard *Traité des Droits d'Auteurs*, 348, and onwards, ch. 3, sec. 4, arts. 204, 205.

4. That the engraving of a map upon copper-plate brings it fairly within the principle and policy that the proprietor, having made the right to use the plate appurtenant to the same, and to the right of property therein, such right will pass with the right of property in the plate, whenever that right passes by act or operation of law in forms appropriate to such act or operation.

5. That at least the condition of relief annexed by the court below was, under the circumstances of this case, a perfectly equitable one; and upon non-compliance therewith by the complainant, the bill ought to have been, as it was, dismissed with costs. Origin of rule imposing terms of relief on complainant: 1 Spence, *Equitable Jurisdiction of Chancery*, 216, 422, 423, and notes. Though equity cannot relieve against common-law or statute penalties and forfeitures, (*Peucy v. Duke of Somerset*, 1 Stra., 447; *Keating v. Sparrow*, 1 Ball & Beatty, 372, 373, 374,) yet it does, in the case of usurious bonds and instruments, grant relief against them only on condition of payment of the principal and legal interest of the amount borrowed; in other words, only upon waiver of the statute forfeitures. 1 Story's *Eq. Jur.*, 64c, and cases cited; *Rogers v. Rathbone*, 1 Johns. Ch., 365; *Tupper v.*

## Opinion of the court.

*Powell*, Id., 439; *Morgan v. Schermerhorn*, 1 Paige, 544; *Livingston v. Harris*, 3 Id., 528; *Campbell v. Morrison*, 7 Id., 158; *Judd v. Seaver*, 8 Id., 548; *Cole v. Savage*, 10 Id., 583.

Mr. Justice CURTIS delivered the opinion of the court.

The appellant filed his bill in the Circuit Court of the United States for the District of Rhode Island, to restrain the defendants from printing and publishing a map of that State, whereof he claimed to be the exclusive proprietor, under the act of Congress of February 3, 1831, concerning copyrights of maps, &c. The defendants admit that they have sold such maps, but allege that a copper-plate, owned by the plaintiff, was duly sold on an execution which issued on a judgment recovered against the plaintiff, in the Court of Common Pleas for the county of Bristol, in the State of Massachusetts, and that one Isaac H. Cady was the purchaser of the plate under that sale; that Cady has used the plate to print the said maps, and the defendants have sold them; and they insist, that, by the purchase of the copper-plate, Cady acquired the right to print maps therewith, and to publish and sell them; and that, therefore, the defendants have not infringed on any exclusive right of the complainants.

By reference to the case of *Stevens v. Cady*, reported in 14 Howard, 528, it will be seen that the same title now asserted by these defendants was tried on that case between the complainant and Cady. But, as is stated in the report of that case, no counsel then appeared or was heard in support of Cady's title; and Mr. Justice Woodbury, who sat in the cause in the Circuit Court, having deceased, this court was not apprised of the grounds and reasons on which the decree of that court dismissing the bill rested; and when this cause was called, counsel having appeared and desired to be heard, though he frankly avowed that the question passed on in the former case was the only one which could be raised, the court readily assented; and having now considered the argument of the respondent's counsel, the court directs me to state its opinion in the cause.

The positions assumed by the respondent's counsel are, that copy and patent rights are subject to seizure and sale on execution; and that whenever the owner of a copyright of a map causes a plate to be made which is capable of no beneficial use except to print his map, he thereby annexes to the plate the right to use it for printing that map, and also the right to publish and sell the copies when printed; and that when the plate is sold on execution, these rights pass with the plate, and as incidents or accessories thereto, though no mention is made of them in the sale.

There would certainly be great difficulty in assenting to the proposition that patent and copy rights, held under the laws of the United States, are subject to seizure and sale on execution. Not to repeat what is said on this subject in 14 Howard, 531, it may be added that these incorporeal rights do not exist in any particular State or district; they are coëxtensive with the United States. There is nothing in any act of Congress, or in the nature of the rights themselves, to give them locality anywhere, so as to subject them to the process of courts having jurisdiction limited by the lines of States and districts. That an execution out of the Court of Common Pleas for the county of Bristol, in the State of Massachusetts, can be levied on an incorporeal right subsisting in Rhode Island or New York, will hardly be pretended; that by the levy of such an execution, the entire right could be divided, and so much of it as might be exercised within the county of Bristol sold, would be a position subject to much difficulty.

These are important questions, on which we do not find it necessary to express an opinion, because in this case neither the copyright, as such, nor any part of it, was attempted to be sold. The return of the officer on the execution is, that he seized and sold "one copperplate for the map of the State of Rhode Island." The defendants must therefore stand upon the second position assumed by their counsel, that the right to print and publish the map passed by the execution sale with the plate.

There are no special facts in this case to distinguish it from any case of a sale on execution of copper or stereotype plates. It appears that the plaintiff owned the plate; whether he made it, or caused it to be made, or purchased it after it had been made, does not appear.

Nor should the case be confounded with one where the owner of copper or stereotype plate sells them. What rights would pass by such a sale would depend on the intentions of its parties, to be gathered from their contract and its attendant circumstances. In this case, the owner of the copyright made no contract of sale, and necessarily had no intention respecting its subject-matter.

The sole question is whether the mere fact that the plaintiff owned the plate attached to it the right to print and publish the map, so that this right passed with the plate by a sale on execution.

And upon this question of the annexation of the copyright to the plate, it is to be observed, first, that there is no necessary connection between them. They are distinct subjects of property, each capable of existing, and being owned and transferred, independent of the other. It was lawful for any one to make, own, and sell this

## Opinion of the court.

copper-plate. The manufacture of stereotype plates is an established business, and the ownership of the plates of a book under copyright may be, and doubtless in practice is, separated from the ownership of the copyright. If an execution against a stereotype founder were levied on such plates which he had made for an author, and not delivered, the title to those plates would be passed by the execution sale, and the purchaser might sell them; but clearly he could not print and publish the book for which they were made. The right to print and publish is therefore not necessarily annexed to the plate, nor parcel of it.

Neither is the plate the principal thing, and the right to print and publish an incident or accessory thereof. It might be more plausibly said that the plate is an incident or accessory of the right, because the sole object of the existence of the plate is as a means to exercise and enjoy the right to print and publish.

Nor does the rule, that he who grants a thing grants impliedly what is essential to the beneficial use of that thing, apply to this case. A press, and paper, and ink are essential to the beneficial use of a copper-plate. But it would hardly be contended that the sale of a copper-plate passed a press, and paper, and ink as incidents of the plate, because necessary to its enjoyment.

The sale of a copper-plate passes the right to such lawful use thereof as the purchaser can make, by reason of the ownership of the thing he has bought; but not the right to a use thereof, by reason of the ownership of something else which he has not bought, and which belongs to a third person. If he has not acquired a press, or paper, or ink, he cannot use his plate for printing, because each of these kinds of property is necessary to enable him to use it for that purpose. So if he has not acquired the right to print the map, he cannot use his plate for that purpose, because he has not made himself the owner of something as necessary to printing as paper and ink, or as clearly a distinct species of property as either of those articles. He may make any other use of the plate of which it is susceptible. He may keep it till the limited time during which the exclusive right exists shall have expired, and then use it to print maps. He may sell it to another, who has the right to print and publish; but he can no more use that right of property than he can use a press or paper which belongs to a third person.

The cases mentioned at the bar, in which incorporeal rights have been held to pass with corporeal property, do not apply.

By the levy of an execution on a mill, the incorporeal rights actually annexed to the mill, and necessary to its use, pass with the mill. So

does what is parcel of the mill, though temporarily removed from it; as, a mill-stone which has been taken from its place to be picked. These and many other such cases are collected in Broome's Legal Maxims, 198, 205.

But the right in question is not parcel of the plate levied on, nor a right merely appendant or appurtenant thereto, but a distinct and independent property, subsisting in grant from the government of the United States, not annexed to any other thing, either by the act of its owner or by operation of law.

For these reasons, as well as those stated in 14 Howard, our conclusion is, that the mere ownership of a copper-plate of a map by the owner of the copyright does not attach to the plate the exclusive right of printing and publishing the map, held under the act of Congress, or any part thereof; but the incorporeal right subsists wholly separate from and independent of the plate, and does not pass with it by a sale thereof on execution.

The next question is whether the complainant can have a decree in accordance with the prayer of his bill, for the penalties imposed by the seventh section of the act of February 3, 1831. The bill prays specifically for a decree for these penalties. We speak of the forfeiture of the printed copies, as well as of the sum of one dollar for each sheet unlawfully printed, as penalties; for, under the laws of the United States, it is clear that the complainant can have no title to either of them, except by way of penalty.

There being no common law of copyright in this country, whatever rights are possessed by the proprietor of the copyright must be derived from some grant thereof in some act of Congress, either *nominatim* or by a satisfactory implication; and looking to the act of Congress applicable to this subject-matter, it appears that the rights claimed by this bill are expressly conferred by way of forfeiture. Its language is: "Then such offender shall forfeit the plate or plates on which such map, &c., shall be copied, and also all and every sheet thereof so copied or printed as aforesaid, to the proprietor or proprietors of the copyright thereof; and shall further forfeit one dollar for every sheet of such map, &c., which may be found in his or their possession, printed, &c., contrary to the true intent and meaning of this act, the one moiety thereof to the proprietor or proprietors, and the other moiety to the use of the United States, to be recovered in any court having competent jurisdiction thereof."

In the case of *Colburn v. Simms*, 2 Hare, 554, Mr. Vice-Chancellor Wigram came to the conclusion, that, since the decision of the House of Lords in the case of *Miller v. Taylor*, the right to a decree for the



## Opinion of the court.

delivery up of copies must be rested by the complainant upon some statute provision; and that inasmuch as courts of equity do not enforce forfeitures by an exercise of their ordinary jurisdiction, such a jurisdiction also must be derived from an act of Parliament; and though the eighth section of the act of 1 and 2 Vict., ch. 59, as well as the preceding act of 54 George III, ch. 156, sec. 4, allows the forfeited copies to be recovered in "any court of record in which an action at law or a suit in equity shall be commenced by such author or authors, or other proprietor or proprietors," &c., yet it was admitted, in *Colburn v. Simms*, that no such order had ever been made, *in invitum*, in a court of equity. It is a significant fact, that Congress, in legislating on this subject, though manifestly acquainted with the phraseology of the act of George III, and though in some particulars it adopted that phraseology, yet omitted to confer upon courts of equity power to enforce either of the forfeitures provided for, but left them to be recovered "in any court having competent jurisdiction thereof"; and the only equitable jurisdiction, as to copyright, conferred upon the courts of the United States, is by the act of February 15, 1819, which gives original cognizance to the courts of the United States, as well in equity as at law, of cases arising under any law of the United States granting to authors or inventors the exclusive right to their respective writings, inventions, and discoveries; and upon any bill in equity filed by any party aggrieved in any such case, shall have authority to grant injunctions according to the course and principles of courts of equity, to prevent the violation of the rights of any authors or inventors secured to them by any laws of the United States, on such terms as the said courts may deem fit and reasonable. Though the substance of this enactment is incorporated into the seventeenth section of the Patent Act of July 4, 1836, so far as it related to inventors, and so far as it related to the subject of patent-rights, is no longer in force, *proprio vigore*, yet so far as it gave cognizance to the courts of the United States of cases of copyright, it still remains in force, and is the only law conferring equitable jurisdiction on those courts in such cases; for the ninth section of the act of February 3, 1831, protects manuscripts only.

There is nothing in this act of 1819 which extends the equity powers of the courts to the adjudication of forfeitures, it being manifestly intended that the jurisdiction therein conferred should be the usual and known jurisdiction exercised by courts of equity for the protection of analogous rights. The prayer of this bill for the penalties must therefore be rejected.

The remaining question is whether there ought to be a decree for

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an account of the profits. The complainant has not prayed for such an account, nor have the defendants stated one in their answer; but the bill does pray for general relief.

The right to an account of profits is incident to the right to an injunction, in copy and patent right cases. *Colburn v. Simms*, 2 Hare, 554; 3 Dan. Ch. Pr., 1797. And this court has held, in *Watts et al. v. Waddle et al.*, 6 Peters, 389, that where the bill states a case proper for an account, one may be ordered under the prayer for general relief. See, also, 2 Pet., 612; 14 Id., 156; 16 Id., 195; 9 How., 405.

The decree of the Circuit Court must be reversed, and the cause remanded to the Circuit Court, with directions to award a perpetual injunction, as prayed for in the bill, and to take an account of the profits received by the defendants from the sales of the map.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Rhode Island, and was argued by counsel; on consideration whereof, it is now here ordered, adjudged, and decreed by this court, that the decree of the said Circuit Court in this cause be, and the same is hereby, reversed with costs; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to award a perpetual injunction, as prayed for in the bill filed in this case, and to take an account of the profits received by the defendants from the sales of the map, and for such further proceedings, in conformity to the opinion of this court, as to law and justice shall appertain.

REVERSED WITH COSTS.

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EDWIN C. LITTLE AND OLIVER SCOVILL, APPELLANTS, v. LEVI W. HALL, ANTHONY GOULD, DAVID BANKS, WILLIAM GOULD, AND DAVID BANKS, JR.

(18 Howard, 165.)

1. On the 27th of December, 1847, George F. Comstock was appointed State reporter, under a statute of the State of New York, which office he held until the 27th of December, 1851.
2. During his term of office, viz., in 1850, he, in conjunction with the comptroller and Secretary of the State, acting under the authority of a statute, made an agreement with certain persons, that for five years to come they should have the publication of the decisions of the Court of Appeals, and the exclusive benefit of the copyright.

Argument for the plaintiffs in error.

3. At the expiration of Mr. Comstock's term, viz., on the 27th of December, 1851, he had in his possession sundry manuscript notes, and the decisions made at the ensuing January Term were also placed in his hands, to be reported. Out of these materials he made a volume, and sold it upon his own private account.
4. Whatever remedy the first assignees may have had against Mr. Comstock individually, they are not to be considered as the legal owners of the manuscript, under the copyright act of Congress, and are not entitled to an injunction to prevent the publication and sale of the volume.

THIS was an appeal from the Circuit Court of the United States for the Northern District of New York.

The case is stated in the opinion of the court.

It was argued by *Mr. Seward*, for the plaintiffs in error, and by *Mr. Haven*, for the defendants.

*Mr. Seward* made the following points:

1. Comstock, by accepting the office of State reporter, and acting under it, and by uniting with the Secretary of State and comptroller in the contract with the appellants of April 20, 1850, must be deemed to have accepted the terms and conditions of the act of April 11, 1848, and of April 9, 1850. And those statutes operated, by reason of such acquiescence on his part, to vest in the State of New York all the interest and right which he might have, as author, in any reports of decisions of the Court of Appeals which should be prepared by him as reporter; and the State became the absolute owner thereof.

2. By the contract made by the State reporter, the Secretary of State, and the comptroller, on behalf of the State, with the appellants, the interest of the State in all matter constituting the reports to be made by Comstock, as reporter, was equitably and legally vested in the appellants, for the purpose of being published exclusively by them during the term specified in the contract.

3. The appellants, by the operation of the contract, and of the laws of the State in pursuance of which it was made, became the legal assignees and proprietors of the manuscript matter prepared by Comstock as State reporter, under the ninth section of the law of Congress of 1831, which right was exclusive of all others during the continuance of the contract. The exclusive copyright was the exclusive right to publish the manuscripts.

This proposition is a legal deduction from the two former propositions already established.

4. Volume 4 of Comstock's Reports was covered by the contract, as to all the matter that it contained, and so was subject to the exclu-

sive right of the appellants to the manuscript matter prepared by the reporter, and incorporated into the work.

The expiration of Comstock's term of office did not alter his liability in this respect. True, he could not be required to prepare the decisions for publication, and to furnish notes and references; but (1) if he did not do this, he must hold the material subject to the order of his successor, who must do the labor; or if he did use them, and prepare them for publication with notes and references, then the materials and additional matter, being incorporated together, and so prepared according to the contract, must pass, under the contract, to the appellants.

Had Comstock died during his term of office, the trust and bailment would have remained attached to the materials in the hands of his executors. A trust would have resulted to the State a right of action, legal or equitable, to the appellants, when the purpose for which he received the materials failed to take effect. 2 Fonblanque, 118.

It is wholly unimportant that Comstock might, either while in office or after going out of office, have acquired similar materials by other means.

1st. As he would in that case have used similar materials, as the basis for labor to be performed for the appellants under the contract, and as he had received an equivalent in advance for that labor, either the labor must be done for their benefit or not at all.

2d. But in point of fact he received these specified materials as a trustee and bailee, and he must be held to the obligations they created.

These are principles so familiar, and they so fully pervade every branch of jurisprudence, equally the law and equity, that references to authorities would seem superfluous; but, for convenience, refer to Hill on Trustees, 172, 282, 509; 2 Vesey, 498; *Taylor v. Plumer*, 3 Maule & Selwyn, 562, 567, 574; *Adair v. Shew*, 1 Schoale & Lefroy, 262; Story on Equity Jurisprudence, sec. 533, &c., 1257, 1258, 1261; *Kane v. Bloodgood*, 7 Johnson's Ch. Reports, 110, where it is held that every deposit is a trust, and that every person who receives money to be paid to another, or to be applied to a particular purpose to which he does not apply it, is a trustee. So the principle adopted in the case of a tenant, that he cannot deny the title of his landlord so long as he retains possession, but must surrender the premises, and place himself in hostility to his landlord, before he can set up a title in himself, is founded on the very contract of tenancy itself. Nelson, Ch. J.; *Phelan and Wife v. Kelly*, 25 Wend., 392. See, also, *Mas-*

*sey v. Davis*, 2 Ves. Jr., 318, 320; *East India Co. v. Hinchman*, 1 Id., 289.

5. It is in evidence that Mr. Comstock has commenced, and still has pending, an action to establish his right to the office of State reporter, at this time. This claim of continuance in office is utterly inconsistent with the position of individual and private right, action, and interest in regard to volume 4, set up by the respondents, and is conclusive against him and them, that volume 4 was prepared by him as State reporter, and subject to the operation of the contract, exhibit A. Lord Chancellor, in 2 Ves. Jr., 696; 1 Swanston, note (a) to p. 381; Comyn's Digest, Election, C. I.

Comstock has made his election to claim and hold the office of State reporter, with full knowledge of his rights, and he is bound by it.

6. There is no proof of any acquiescence by the appellants in the claim of Mr. Comstock, by which he was misled or induced to incur expense.

*Mr. Haven*, for defendants in error, made the following points:

1. There is no question of copyright or of property in manuscripts involved in the case, and the plaintiffs' claim does not fall within the provisions of any of the acts of Congress, and this is fatal to the plaintiffs' case.

I. The laws of the United States afford remedies, and the Federal courts have jurisdiction only in favor of the "author" of a book or "his legal assigns," or the "author or legal proprietor" of a manuscript. Of course, a book or manuscript belongs primarily, under the copyright laws, to the author. The plaintiffs not being the "author," must therefore deduce from him a "legal" right and title to the book or manuscript, or else they cannot sustain their bill in the Federal courts. If they can allege any other rights which have been violated, these must be asserted in the State courts, and on some general principle of equity or of law. See the opinion of the Circuit Court, which proceeds very much on this ground. See, also, laws of the United States, 2d sess. 21st Cong., 1831, p. 11, secs. 1, 9; 2 Kent's Comm., 6th ed., 379; *Clark v. Price*, 2 Wilson Ch., 157; *Jollie v. Jaques*, 1 Blatchf., 618, 627.

II. But the strongest manner in which the plaintiffs can state their case is to allege that the notes, references, and manuscript matter composed by Mr. Comstock, and contained in the book in question, fall within the purview of their contract for the publication of the State Reports, to be composed by the State reporter. We say the

strongest, because this assumes the precise fact controverted, to wit, that Mr. Comstock's labors upon this book were official, and not private. It is not pretended, of course, that the plaintiffs, under their contract with the State officers, could have any interest in the labors of Mr. Comstock, or any one else, as a private reporter.

III. Assuming, then, this, the best statement of the plaintiffs' case, to be true, it only follows that the contract with the plaintiffs has been violated, affording perhaps a just ground of action or claim against the State of New York, or its agents who made the contract. But it by no means follows that the plaintiffs have the "legal" title to, or are "the legal proprietors" of, the book or of the manuscript in question. At the time of the contract, no part of the work was composed. The agreement, therefore, was simply executory, and could vest no title or actual property in that which had no existence.

2. But the case is not such as has been thus far assumed. In fact, Mr. Comstock was not in the service of the State. He was a private citizen, and another person held the office of State reporter, and received the salary annexed thereto. In fact, also, Mr. Comstock, at no period of his labors on this book, pretended to be acting for the State or the plaintiffs. Being a private citizen, in fact, before he began, he distinctly announced that he should not prepare the work for the State or the plaintiffs, but should do it in his private character, and would sell it as his own property. After he began, he employed the stereotype printer on his private account. Still later, he invited proposals to buy the work as his own, and, among others, invited the plaintiffs; and finally he sold it as his own, thus maintaining from the beginning to the end an open consistency of conduct, a course of conduct at the time called in question by no one, not even the plaintiffs, who now seek to appropriate the result of his labors as their property.

3. What has been thus far said, it is believed, shows that the plaintiffs, in the most favorable views which can be taken of their case, have no such title as will sustain their bill, nor indeed any title at all, whatever may be said of the defendants, their position, and that of their vendor, Mr. Comstock. We shall now speak of them and of him, especially of his position and relations to the subject, placing the facts and circumstances of the case in the light in which we regard them, and demonstrating, if we can, that, upon every principle of law and justice, the copyright of the book in question is with the defendants.

4. The complainants are equitably estopped from claiming the relief asked for in their bill.

## Opinion of the court.

Mr. Justice McLEAN delivered the opinion of the court.

This is an appeal from the decree of the Circuit Court of the United States for the Northern District of New York.

A want of jurisdiction to sustain this appeal was alleged by counsel, as it does not appear from the record that the amount in controversy exceeds the sum of two thousand dollars; but this objection was obviated by an affidavit, which stated that the amount claimed by the plaintiffs exceeds that sum.

This bill was filed, under the copyright act, to enjoin the defendants from publishing and selling the fourth volume of Comstock's Reports.

The plaintiffs, who are publishers and booksellers at Albany, New York, represent that, on the 20th of April, 1850, they entered into an agreement with Washington Hunt, comptroller, Christopher Morgan, secretary, and George F. Comstock, reporter, of the State of New York, as required by statute, that they should have the publication, for the term of five years, of the decisions of the Court of Appeals, and the exclusive benefit of the copyright, to be taken out in behalf of the State, of the notes and references, and other matter furnished by the reporter, connected with said decisions; and that instrument was declared to be an assignment and transfer of the copyright of the matter so published, which should consist of volumes of not less than five hundred pages each.

On the 27th of December, 1847, George F. Comstock was appointed State reporter for three years, and until his successor was appointed and qualified, at a salary of \$2,000 per annum. He was to have, under the law, no interest in the reports, but the copyright of his notes, references, and abstracts of arguments was to be taken in the name of the Secretary of State, for the benefit of the people of New York. The law forbade the reporter and all other persons from acquiring a copyright in the reports, but declared they might be republished by any person.

Mr. Comstock's term of office expired on the 27th of December, 1850, and his successor, Henry R. Selden, Esq., was appointed to succeed him on the 17th of January, 1851. Mr. Comstock questioned the validity of his appointment, and the matter was referred to the judges of the Court of Appeals, then in session at Albany, who decided that Mr. Selden was duly appointed. He took the oath on the 21st of January, 1851, and immediately entered upon the duties of his office.

Mr. Comstock published three volumes of his reports; and having in his hands, at the expiration of his office, opinions of the court to

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make half or more of another volume, on the suggestion of the judges, and with the consent of Mr. Selden, the opinions of the January Term were delivered to him, that he might complete his fourth volume. At the time of this arrangement, he had made no preparation, by notes, &c., for this volume, and did not commence the work until some months afterwards.

After he had made considerable advance in the preparation of this volume, he invited proposals for the purchase of the copyright; and although the plaintiffs, in conversation with him, said they would give as much as any other persons, yet they made no proposal, as they were apprehensive it might affect the contract for the publication of the reports, as above stated. The defendants purchased the copyright, for which they paid \$2,500. At a large expense, they prepared stereotypes for the work, and printed it.

The plaintiffs, so soon as the volume was published, commenced a republication of it, and filed this bill to enjoin the defendants from selling their edition. Previous to the publication of the third volume of Comstock's Reports, the Secretary of State had the copyright of the head-notes, references, &c., entered by the clerk of the District Court of the United States, for the benefit of the State; and the complainants had a similar entry made, to secure the copyright to the State, of the fourth volume. This was not done by the Secretary of State, as the law directed, and it seems it was not sanctioned by him, as he was doubtful whether he had the power to do so.

The ninth section of the copyright act of the 3d of February, 1831, provides "that any one who shall print or publish any manuscript whatever, without the consent of the author or legal proprietor first obtained as aforesaid," "shall be liable to suffer and pay to the author or proprietor all damages occasioned by such injury," &c.

At common law, an author has a right to his unpublished manuscripts, the same as to any other property he may possess, and this statute gives him a remedy by injunction to protect this right.

A formal transfer of a copyright by the supplementary act of the 30th of June, 1834, is required to be proved and recorded as deeds for the conveyance of land, and such record operates as notice.

After the expiration of his official term, Comstock did not and could not act as reporter. His successor, having been appointed and qualified, discharged the duties of the office and received the salary. As many of the opinions of the court were in the hands of Comstock when his office expired, it might have been made a question whether he could not publish the fourth volume as reporter. This would have given to the State a continuous report of the decisions of the



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Court of Appeals, as the law contemplated, with the copyright of the notes, &c., secured for the benefit of the people of the State. If the opinions of the court came into his hands during his continuance in office, there would seem to be no impropriety in his publishing them, as filling up the measure of his term.

But it seems a different view was taken by the late reporter. As his term of office had expired, he was unwilling to publish the fourth volume without compensation for his labor. This changed his relations with the plaintiffs, as that contract was made as reporter, and on the supposition that he would be continued in that office. Under that contract, the complainants had the advantage of publishing the reports for the price stipulated, but any one was at liberty to republish them.

The fourth volume was published by Mr. Comstock as an individual, he having secured to himself the copyright. This probably insured to the purchaser of the right the republication of the work for the term of twenty-eight years. Under the agreements made with the plaintiffs, they had only the profit of their contract.

Whether the plaintiffs may not have a remedy on their contract with Mr. Comstock in the local tribunals of the State, is not a question before us. Our only inquiry, is whether any relief can be given by this court under the copyright act. Where a case arises under that act, we have jurisdiction, though both the parties, as in this case, are citizens of the same State. But if the act do not give the remedy sought, we can only take jurisdiction on the ground that the controversy is between citizens of different States.

Were the plaintiffs the legal proprietors of the manuscript from which the fourth volume of Comstock's Reports was published? The plaintiffs rely upon their contract with the comptroller, the Secretary of State, and Mr. Comstock, the reporter. In that contract it is said: "This instrument is declared to be an assignment and transfer of the copyright of the matter so published to the parties of the second part."

This contract was made with Mr. Comstock as reporter, and the plaintiffs agreed to publish the work in volumes containing five hundred pages each, to have them well bound in calf, the types, paper, and the entire execution to be equal to Denio's Reports; the work to be done under the superintendence of the reporter; copies to be furnished to certain officers of the State, and the publishers were to keep the volumes for sale at two dollars and fifty cents per copy; and in all things they were bound to comply with the statutes of the State.

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Comstock could not have published the work as reporter without the consent of the Court of Appeals, and also the Secretary of State, who was required to secure the copyright to the State; and for his labor in preparing the notes, references, &c., and superintending the printing, he could have received no compensation.

Without saying what effect might have been given to the contract had the relation of the parties remained unchanged, we are unable to say, as the case now stands before us, that the plaintiffs were the legal owners of the manuscript within the copyright law. The contract was made by Comstock as reporter, whose duties were regulated by law; and the obligations of the complainants as publishers were embodied in the contract, and were incompatible with any publication on private account.

The entire labor of the work was performed by Comstock, not as reporter, but on his own account. It is, we think, not a case for a specific execution of the contract; and, in effect, that is the object of the bill. This result has not been brought about by the acts of Comstock. He may have been imprudent in extending his contract unconditionally beyond the term of his office. But in doing so he has an apology, if not an excuse, by being associated in making the contract with two high functionaries of the State. Under the changed relation of the parties, the plaintiffs cannot be considered as the legal owners of the manuscript, for the purposes of the contract, under the copyright law.

Whatever obligation may arise from the contract, under the circumstances, as against Comstock, must be founded on his failure to furnish the manuscripts to the plaintiffs, and of such a case we can take no jurisdiction as between the parties on the record.

The decree of the Circuit Court is affirmed.

**AFFIRMED.**

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**ISRAEL KINSMAN AND CALVIN L. GODDARD, APPELLANTS, v. STEPHEN R. PARKHURST.**

(18 Howard, 289.)

1. Where there was an agreement between a patentee and an assignee that the latter should manufacture the machines for a certain time and upon certain terms, it is too late for him, when called upon in chancery for an account, to deny that the patentee was the original inventor of the thing patented.
2. Even if the patent were invalid, yet that does not so taint with illegality the sales of the machines by the assignee, as to affect the claim of the assignor to an account of the sales.

## Argument for the appellee.

3. The agreement that one only of the parties should continue the manufacture, was not void as being in restraint of trade.
4. The assignee could not legally purchase the outstanding claim of a third person, and set it up against the patentee, with whom he had an existing agreement in the nature of a copartnership.
5. If the assignee transfers his contract, the person to whom he transfers it is bound by the same equities which existed between the original parties to the contract, having purchased with a full knowledge of the state of things.
6. If the report of the master was incorrect, exception should have been taken to it in the court below. It cannot be examined in this court; no exception having been taken.

THIS was an appeal from the Circuit Court of the United States for the Southern District of New York.

The facts are stated in the opinion of the court.

It was argued by *Mr. Keller*, for the appellants, and by *Mr. Gifford*, for the appellee.

*Mr. Keller* made ten points.

The first three assailed the validity of Parkhurst's patent. The others raised the following questions:

4. Whether the agreement, preventing one of the parties from making the article and both from selling it under a certain price, was not void as being in restraint of trade and against public policy, if either or both of the parties knew that the patent was not valid.

The 5th, 6th, and 7th related to the responsibility of Goddard.

The 8th. Whether Kinsman and Goddard were responsible for bad debts, provided they were prevented from receiving the money by the interference of Parkhurst.

The 9th again attacked the patent.

The 10th. Whether Kinsman and Goddard were responsible, if the machines which they made did not, in law or fact, infringe the letters patent.

*Mr. Gifford* made eleven points.

The first related to the propriety of entertaining the appeal at all.

The 2d, 3d, and 4th. That the agreements between the parties fixed their relation and prescribed their rights and obligations.

5. That Kinsman was estopped from denying the validity of the patent.

6. That Goddard, having come in under the agreement, was in the same situation as Kinsman.

7. That the machines made by Kinsman and Goddard were covered by the patent.

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8. That Kinsman had made enough to reimburse himself, and fraudulently refused to account for the surplus.

9. That Parkhurst was the inventor of the thing patented.

10. That he never obtained a single feature of his invention from any other person.

11. That he had always acted fairly.

Mr. Justice CURTIS delivered the opinion of the court.

This is an appeal from a decree of the Circuit Court of the United States for the Southern District of New York, in a suit in equity brought by the appellee, Parkhurst, against the appellants. The bill states, and the proofs show, that Parkhurst, being the owner of letters patent for improvements in the machine for ginning cotton and wool, on the 22d of May, 1845, entered into a written agreement with Kinsman, the substance of which was, that Parkhurst was to be the owner of two-thirds, and Kinsman of one-third, of the letters patent; that the business of manufacturing and selling the patented machines should be carried on by the parties on their joint account, in the proportion of two-thirds and one-third, Kinsman giving his personal attention to the business, and advancing a sum not exceeding one thousand dollars for the purchase of machinery, stock, &c., for which advance he was to be repaid out of the first profits of the business. Kinsman was to pay Parkhurst two thousand dollars in cash, and give his note for one thousand dollars, payable in sixty days. Under this agreement, the manufacture and sales of the machines were begun and carried on until the 9th day of February, 1846, at which time the parties entered into a new agreement, the substantial part of which was as follows:

“Whereas the party of the first part has advanced moneys, and become responsible for various sums of money which have been expended in getting up machinery, and tools, and stock, &c., for the manufacture of burning and carding machines, which were invented by the said Parkhurst, one-third part of which he sold and assigned to the party of the first part: Now, therefore, the party of the first part, in consideration of one dollar in hand paid by the party of the second part, the receipt whereof is hereby acknowledged, hereby covenants and agrees, that, as soon as the profits which have accrued, and which may hereafter arise, from the manufacture and sale of the said machines so invented by the party of the second part, and so made and sold by the party of the first part, shall be sufficient to pay all legal demands for the purchase of machinery, tools, &c., and other expenses incurred by said party of the first part, then he, the said

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party of the first part, shall and will discontinue the manufacture and sale of said machines, invented as aforesaid, and that all machines which he shall manufacture and sell after this date should not be sold for a less profit than one hundred dollars each, and that he will be accountable for one hundred dollars profit on each and every machine made and sold from this day, unless he has the written consent of the party of the second part to sell at a less price."

"The party of the second part, in consideration of one dollar to him in hand paid by the party of the first part, the receipt whereof is hereby acknowledged, and also in consideration of the agreements aforesaid, hereby covenants and agrees with the party of the first part, that he will go on and manufacture the machines aforesaid as soon as the party of the first part discontinues the same, and that he will not sell any machine for a less profit than one hundred dollars, without the written consent of the party of the first part, and that he will pay over to the party of the first part one-third part and share of the said profits upon all machines which he makes and sells hereafter, and that for any machines which he may manufacture, or have manufactured, before the discontinuing of the building of the same by the party of the first part, shall be subject to the same restrictions of selling for at least one hundred dollars profit on each machine, one-third of which shall be paid to the party of the first part."

The original and supplemental bills aver, that under this agreement Kinsman prosecuted the business, and not only reimbursed himself for the cost of the machinery, tools, &c., and all his other advances, but, in violation of his agreement, continued the manufacture and sale of the machines, so as to receive large profits, of which it prays an account, and also an injunction to restrain the further making or vending of the machines in violation of the agreement. A temporary injunction was applied for and obtained on the 3d day of July, 1847. On the 29th day of June, 1847, Kinsman made a transfer to the appellant Goddard, who was then a clerk in his employment, of the tools, stock, &c., used in the manufacture; and, after Kinsman was enjoined, the business was carried on in Goddard's name. A supplemental bill was then filed, making Goddard a party, charging him with notice of all the complainant's rights at the time of the transfer to him, alleging the transfer itself to have been only colorable, and praying an account and decree as against him and Kinsman. The Circuit Court made an interlocutory decree, declaring Parkhurst's right to an account, referring the cause to a master to take and state the accounts, directing the master, in taking the accounts, to ascertain and report the number of machines made and

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sold by Kinsman and Goddard, or either of them; the advances made by Kinsman and Goddard, or either of them; and charging a profit of one hundred dollars on each machine sold.

The master reported; and his report, not being excepted to, was confirmed, and a final decree made, that Kinsman and Goddard should pay to the complainant the amount reported by the master to be due from them. From this decree the appeal now before us was taken.

The principal objection made by the appellants to the decree of the court below, is that Parkhurst was not the original and first inventor of the thing patented. We are not satisfied that this is made out. But we have not found it necessary to come to a decided opinion upon this point, because we are all of opinion that, under the agreement of the 9th of February, 1846, the invalidity of the patent would not afford a bar to the complainant's right to an account. Having actually received profits from sales of the patented machine, which profits the defendants do not show have been or are in any way liable to be affected by the invalidity of the patent, its validity is immaterial. Moreover, we think the defendants are estopped from alleging that invalidity. They have made and sold these machines under the complainant's title and for his account; and they can no more be allowed to deny that title and retain the profits to their own use, than an agent who has collected a debt for his principal can insist on keeping the money, upon an allegation that the debt was not justly due.

The invalidity of the patent does not render the sales of the machine illegal, so as to taint with illegality the obligation of the defendants to account. Even where money has been received, either by an agent or a joint owner, by force of a contract which was illegal, the agent or joint owner cannot protect himself from accounting for what was so received, by setting up the illegality of the transaction in which it was paid to him. Thus where a vessel engaged in an illegal trade carried freight which came into the hands of one of the part owners, and on a bill filed by the other part owner for an account, the defendant relied on the illegality of the trade, but it was held to be no defense. *Sharp v. Taylor*, 2 Phil. Ch. R., 801. So in *Tenant v. Elliot*, 1 B. & P., 3, the defendant, an insurance broker, having effected an illegal insurance for the plaintiff, and received the amount of a loss, endeavored to defend against the claim of his principal by showing the illegality of the insurance, but the plaintiff recovered. See, also, *McBlair v. Gibbes*, 17 How., 236.

Here, however, as already observed, there was no illegality; it is

## Opinion of the court.

simply a question of failure of title, and as that does not appear in any manner to have affected the profits which the defendants received, there can be no ground to allow it to be shown in defense. *Bartlett, Ad'r, v. Holbrook*, 1 Gray, 114; *Wilder v. Adams*, 2 Wood. & Min., 329, are in point.

Similar views are decisive against the objection that this was a contract in restraint of trade. It was certainly competent for two persons, being joint owners of letters patent, whether valid or invalid, to enter into a copartnership for the manufacture and sale of the patented machines, and to stipulate that one of them should alone conduct the business. This was a provision for the prosecution of the business in a particular mode, and not for its restraint. It is a very common and not an illegal stipulation in partnership articles, that neither partner shall carry on that business for which the partnership is formed, outside of the partnership and for his own account. Besides, if the contract to refrain from the manufacture could not be enforced, as being against public policy, this would afford no answer to a claim for an account of profits actually realized by prosecuting the business, there being no connection between the illegal stipulation and the profits of the business.

It was insisted by the appellants that they did not act under the complainant's title, but under some right acquired from one Sargent. We are not satisfied that Sargent had even an inchoate right to a patent for the machines which the appellants made and sold. But even if he had, the defendant Kinsman could not secretly acquire the outstanding right of Sargent, if any, and set it up against his joint owner, Parkhurst, in derogation of his rights under the agreement of the 9th of February, which Kinsman entered into with knowledge of this alleged title of Sargent; and Goddard is bound by the same equities, for he not only purchased *pendente lite*, and with actual notice of the suit, but we are satisfied the sale to him was made to enable Kinsman to attempt to evade the injunction.

The appellant Goddard objects that he has been charged by the final decree, jointly with Kinsman, for the profits on sales of machines made before the transfer to him by Kinsman. If this be so, it arises from the report of the master, who was directed by the interlocutory decree to report the sales made by Kinsman and Goddard, or either of them, and the advances and expenditures of them, or either of them.

If his report was in this or any other particular erroneous, it was incumbent on the defendants to have pointed out the error, by an exception filed pursuant to the rules of the court on that subject.

## Opinion of the court.

But no exception was filed, the report was confirmed, and the final decree was drawn up and entered without objection by the appellant Goddard, reciting that it appears by the report of the master that the sum of \$23,220<sup>28</sup>/<sub>100</sub> is due and owing by Kinsman and Goddard to Parkhurst, and thereupon proceeds to decree them to pay that sum. When a motion to dismiss the appeal was made at a former day, on the ground that the master's report not having been excepted to, and the appellants not having objected to the final decree, there was nothing open on this appeal, the appellants' counsel declared that the appeal was designed only to review the interlocutory decree which had decided the merits of the cause, and that, unless error was found therein, there was no ground for the appeal. The motion to dismiss the appeal was overruled, the court being of opinion that it was open to the appellants to review the decision made by the interlocutory decree. But the interlocutory decree does not direct the master to charge Goddard and Kinsman jointly with profits on sales made by Kinsman alone. If the master put such an interpretation on the decree, it was an erroneous interpretation, and should have been brought before the court below by an exception. It is too late to object to it here, for the first time.

The appellants also insist that they were charged with profits not actually received, by reason of the failure of the purchasers to pay, and other causes. But this was in accordance with the agreement of the 9th of February, which stipulates that Kinsman shall be accountable for one hundred dollars, profit on each machine made and sold by him. By force of this stipulation, he and Goddard, who acted with him under this agreement, took the risk of bad debts. It appears, from the master's report, that evidence tending to show that some of these losses were attributable to the interference of Parkhurst, was offered to the master and rejected by him. But no exception having been taken to bring this point before the Circuit Court, it is not open here.

We have considered all the objections to the decree of the Circuit Court, and finding them untenable, we order the decree to be

**AFFIRMED WITH DAMAGES AND COSTS.**



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Statement of the case.

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WILLIAM H. SEYMOUR AND LAYTON S. MORGAN, PLAINTIFFS IN ERROR,  
v. CYRUS H. McCORMICK.

(19 Howard, 96.)

1. The act of Congress passed on the 3d of March, 1837, 5 Stat. at Large, 194, provides that a patentee may enter a disclaimer, if he has included in his patent what he was not the inventor of; but if he recovers judgment against an infringer of his patent, he shall not be entitled to costs, unless he has entered a disclaimer for the part not invented.
2. It also provides that if a patentee unreasonably neglects or delays to enter a disclaimer, he shall not be entitled to the benefit of the section at all.
3. In 1845, McCormick obtained a patent for improvements in a reaping-machine, in which, after filing his specification, he claimed, amongst other things, as follows, viz.: "2. I claim the reversed angle of the teeth of the blade, in manner described. 3. I claim the arrangement and construction of the fingers, (or teeth for supporting the grain,) so as to form the angular spaces in front of the blade, as and for the purpose described."
4. These two clauses are not to be read in connection with each other, but separately. The first claim, viz., for "the reversed angle of the teeth of the blade," not being new, and not being disclaimed, he was not entitled to costs, although he recovered a judgment for a violation of other parts of his patent.
5. Under the circumstances of the case, the patentee was not guilty of unreasonable neglect or delay in making the disclaimer, which is a question of law for the court to decide.
6. The facts that a similar machine was in successful operation in the years 1829 and 1853, do not furnish a sufficient ground for the jury to presume that it had been in continuous operation during the intermediate time.
7. The fifteenth section of the Patent Act of 1836, which allows the defendant to give in evidence that the improvement had been described in some public work anterior to the supposed discovery of the patentee, does not make the work evidence of any other fact, except that of the description of the said improvement.

THIS case came up by writ of error from the Circuit Court of the United States for the Northern District of New York.

It was a suit brought by McCormick against Seymour & Morgan, for a violation of his patent-right for reaping-machines, which suit was previously before this court, and is reported in 16 Howard, 480.

It will be seen, by reference to that case, that McCormick obtained three patents, viz., in 1834, 1845, and 1847. The suit, as originally brought, included violations of the patent of 1845, as well as that of 1847; but the plaintiff, to avoid delay, proceeded then only in his claim for a violation of the patent of 1847, which consisted chiefly in giving to the raker of the grain a convenient seat upon the machine. When the case went back under the mandate of this court, the claim was for the violation of the patent of 1845, that of 1847 being men-

## Statement of the case.

tioned only in the declaration, and not brought before the court upon the trial, the main question being the violation of the patent of 1845.

McCormick's claim in the patent of 1845 was as follows, viz.:

"I claim, 1st. The curved (or angled downward for the purpose described) bearer, for supporting the blade in the manner described.

"2d. I claim the reversed angle of the teeth of the blade, in manner described.

"3d. I claim the arrangement and construction of the fingers, (or teeth for supporting the grain,) so as to form the angular spaces in front of the blade, as and for the purpose described.

"4th. I claim the combination of the bow, L, and dividing iron, M, for separating the wheat in the way described.

"5th. I claim setting the lower end of the reel-post, R, behind the blade, curving it at R 2, and leaning it forward at top, thereby favoring the cutting, and enabling me to brace it at top by the front brace, S, as described, which I claim in combination with the post."

The fourth and fifth claims were those which were alleged to have been infringed.

The defendants pleaded the general issue, and gave notice of various prior inventions and publications in public works, which they designed to give in evidence in their defense. The last trial was had in October, 1854, when the plaintiff obtained a verdict for \$7,750, and judgment was entered in June, 1855, for \$10,348.30.

There were twenty exceptions taken in the progress of the trial, twelve of which were as to rulings upon points of evidence, which it is not material to notice. The remaining eight were to portions of the charge of the court to the jury.

The defendants, in addition to other matters of defense, alleged that the second claim was not new, and that as there had been unreasonable delay in the disclaimer of it, the plaintiff was not entitled to recover at all; and, at all events, was not entitled to recover costs.

Only such portions of the charge of the court to the jury will be here inserted, as were the subjects of the opinion of this court.

One part of the charge was as follows, viz.:

"The claim in question is founded upon two parts of the patent. As the construction of that claim is a question of law, we shall construe it, for your guidance. In the forepart of the patent we have a description of the blade, and of the blade-case, and of the cutter, and of the mode of fastening the blade and the blade-case and the cutter, and of the machinery by which the arrangement is made for the cutter to work. We have also the description of the spear-shaped fingers, and of the mode by which the cutter acts in connection with

## Statement of the case.

those fingers. Then, among the claims are these: '2. I claim the reversed angle of the teeth of the blade, in manner described. 3. I claim the arrangement of the construction of the fingers, (or teeth for supporting the grain,) so as to form the angular spaces in front of the blade, as and for the purpose described.' Now, it is insisted, on the part of the learned counsel for the defendants, that this second claim is one simply for the reversed angles of the sickle-teeth of the blade. These teeth are common sickle-teeth, with their angles alternately reversed in spaces of an inch and a quarter, more or less. The defendants insist that the second claim is merely for the reversed teeth on the edge of the cutter, and that the reversing of the teeth of the common sickle as a cutter in a reaping-machine was not new with the plaintiff; and that if it was new with him, he had discovered it and used it long before his patent of 1845. The defendants claim that Moore had discovered it as early as 1837 or 1838; and it would also seem that the plaintiff had devised and used it at a very early day after his patent of 1834—that is, the mere reversing of the teeth. But, on looking into the plaintiff's patent more critically, we are inclined to think that when the plaintiff says, in his second claim, 'I claim the reversed angle of the teeth of the blade, *in manner described*,' he means to claim the reversing of the angles of the teeth *in the manner previously described in his patent*. You will recollect that it has been shown, in the course of the trial, that, in the operation of the machine, the straw comes into the acute-angled spaces on each side of the spear-shaped fingers, and that the angles of the fingers operate to hold the straws, while the sickle-teeth, being reversed, cut in both directions as the blade vibrates. The reversed teeth thus enable the patentee to avail himself of the angles on both sides of the spear-shaped fingers; whereas, if the sickle-teeth were not reversed in sections, but all ran in one direction, like the teeth of the common sickle, he could use the acute angles upon only one side of the fingers, because the cutter could cut only in one direction. We are therefore inclined to think that the patentee intended to claim, by his second claim, the cutter having the angles of its teeth reversed, in connection with the angles thus formed by the peculiar shape of the fingers; and, as it is not pretended that any person invented that improvement prior to the plaintiff, the point relied on in this respect by the learned counsel for the defendant fails."

The other parts of the charge which were excepted to by the counsel for the defendants were thus specifically mentioned:

To so much of the charge of the court as instructed the jury, in substance, that the plaintiff, in his patent of January 31, 1845, did

## Statement of the case.

not claim the reversed angle of the teeth of the blade as a distinct invention, but only claimed it in combination with the peculiar form of the fingers described in the same patent, the defendants' counsel excepted.

The defendants' counsel requested the court to instruct the jury, that if they should be satisfied that Hiram Moore was the first inventor of the reversed angle of the teeth of the blade, and that the plaintiff was notified of that fact by the testimony of Moore on the trial of this cause in June, 1851, and had not yet disclaimed that invention, then, in judgment of law, he has unreasonably delayed filing his disclaimer, and the verdict should be for the defendants.

The court declined so to instruct the jury, and the defendants' counsel excepted to the refusal.

The defendants' counsel further requested the court to instruct the jury, that if they should be satisfied that Hiram Moore was the first inventor of the reversed angle of the teeth of the blade, and that the plaintiff was notified of that fact by the testimony of Hiram Moore on the trial of this cause in June, 1851, and had not yet disclaimed that invention, then it was a question of fact for them to decide whether the plaintiff had or had not unreasonably delayed the filing of a disclaimer; and if they should come to the conclusion that there had been such unreasonable delay, their verdict should be for the defendants.

The court refused so to instruct the jury, and the defendants' counsel excepted to the refusal.

The defendants' counsel requested the court to submit to the jury the question, under the evidence in the case, whether the plaintiff did or did not claim, in his patent of January 31, 1845, the reversed angle of the teeth of the blade, independent of any combination.

The court refused to submit that question to the jury, and the defendants' counsel excepted to the refusal.

The defendants' counsel also asked the court to instruct the jury, that, from the facts that Bell's machine operated successfully in 1829, and that it operated well also in 1853, they were at liberty to infer that it had operated successfully in the intermediate period, or some part of it.

But the court held and charged, that there being no evidence respecting it, except at the trial of it in 1829, and the trial of it in 1853, the jury could not infer anything on the subject, and refused to charge as requested. The defendants' counsel excepted to the refusal, and also excepted to the charge in this respect.

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Argument for the plaintiff in error.

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Upon these exceptions, the case came up to this court, and was argued by *Mr. Harding* and *Mr. Stanton*, for the plaintiffs in error, and by *Mr. Dickerson* and *Mr. Johnson*, for the defendant. There was also a brief filed by *Mr. Selden*, for the plaintiffs in error.

It is almost impossible to convey to the reader a clear idea of the argument, because models and drawings were produced in court by the counsel on both sides. The points made, however, were the following, viz.:

For the plaintiff in error.

VI. The construction given in the court below to the second claim of the patent of 1845, was erroneous.

1. The words "in manner described," used in the second claim, refer exclusively to the description of the construction of the sickle, given in folio 155, without reference to the peculiar shape of the fingers, or to any combination whatever. They refer to the straight blade alone, with the specified positions of its teeth.

To test this construction, suppose a prosecution under this claim, of one who used such *blade* as is here described, with fingers having parallel sides, forming right angles with the line of the blade, could it be said that this claim was not infringed? If it could not, there must be error in the charge on this point.

The construction given to this claim by the court would permit the free use by the public of the reversed angle of the sickle, *when not combined with the spear-headed finger*. Can that be reconciled with the language of the patentee, either in the description of his invention, or of the claim based upon it?

If it can, a similar construction must be given to the third claim, which is thus rendered *identical with the second*, as each will then cover *exactly the same combination*, and the spear-head finger will be given to the public, except when combined with the straight blade and reversed angle of the teeth.

We suppose the correct rule for the interpretation of patents is laid down by Mr. Curtis, in his Treatise on Patents, sec. 126: "The nature and extent of the invention claimed by the patentee, is the thing to be ascertained; and this is to be arrived at through the fair sense of the words which he has employed to describe his invention." But that rule, even as limited or aided by the principle referred to in section 132, viz., "that a specification should be so construed as, consistently with the fair import of language, will make the claim coextensive with the actual discovery," does not relieve the plaintiff here

from the distinct claim of the reversed teeth of the blade *as an independent invention*.

This principle was well applied in the case of *Haworth v. Hardcastle*, Webster's Patent Cases, 484, 485, from which it was taken by Mr. Curtis. In that case it is shown, by the opinion of Chief Justice Tindal, that a forced construction of the language of the patent was required to make the claim embrace what it was alleged to embrace; but in the present case a forced construction not only of the language of the claim, but of the description of the invention, must be adopted to exclude the claim of the reversed teeth of the blade as an independent invention. Such latitude of interpretation cannot be safely allowed of a patent, or any other instrument. Neither is it necessary for the protection of the rights of the patentee. If he made "a mistake, the Patent Law affords means of correcting it; but until corrected, the claim must be taken as it stands, whatever error may have led to it." *Byam v. Farr*, 1 Curtis, 263; act of 1836, sec. 13.

A patent for an invention is a grant from the government, and should be construed, as we suppose, *like all other grants, fairly and liberally for the accomplishment of the objects designed by it*, and not otherwise. Curtis, sec. 386. Rights, the result of intellectual labor, are no doubt sacred; but we believe them no more sacred than those which are the result of more humble toil, and that *the same liberality of interpretation* should be extended to the title-deeds of both. That those rules of construction which are applied to patents for lands should be applied to patents for inventions. That the latter should no more be stretched beyond the fair import of their terms when the interest of the patentees would be promoted by their extension, or contracted in like degree when their interest would be promoted by their restriction, than should any other deeds or contracts. Godson on Patents, 204, 205; *Le Roy v. Tatham*, 14 How., 176.

Any more loose construction would render nugatory the statute requiring "a written description of the invention," &c., in "full, clear, and exact terms"; and in case of any machine, that the patentee "shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery." Act of 1836, sec. 6.

And it would render entirely useless the provision in section 13 of the same act, providing for the amendment of defective specifications.

The reason usually given for requiring a more liberal construction of patents than of other instruments, is that there is a great difficulty in giving exact descriptions of inventions. Conceding the fact to be so, it may be a sufficient answer to say, that the statute *requires an exact description* as a condition of the grant. But, aside from the statute,

## Argument for the plaintiff in error.

it should be borne in mind, that every mechanic in the land is bound, *at his peril, to decide correctly, from the specification, what every patent touching his business covers*; and the question is, if the subject be difficult, where should the responsibility of its solution rest—upon him who makes the description of *his own work*, for *his own interest*, and with all the aids to be derived from the Patent Office, and, if he chooses, from patent agents, and men of science skilled in such matters; or from the mechanic pretending to no particular knowledge on the subject, *having no interest*, and often deprived of all extraordinary aids? We think that both reason and the statute demand of him who claims the exclusive right to define clearly the limits of his invention. It can in no case be difficult for an inventor to say, distinctly, whether he claims two or more elements singly, or merely in combination. *Evans v. Hettich*, 3 Wash., 408; S. C., 1 Robb, 166.

## 2. The point was material.

Hiram Moore used such a sickle as early as 1836, if not in 1834, and this was proved on the first trial of this case, as long ago as June, 1851. Notice of this invention by Moore was given to the plaintiff as early as September, 1850. The sickle, as used by Moore in 1836, was also described by witnesses examined in October, 1851, and cross-examined by plaintiff's counsel in this cause.

The plaintiff, in his history of his invention, sworn to January 1, 1848, presented to the Commissioner of Patents, for the purpose of obtaining an extension of his first patent, shows, as we think, that he did not use the blade with reversed teeth until the harvest of 1841.

Under these circumstances, we insist that the plaintiff was called upon, during the three years that intervened between the trial in June, 1851, and that in October, 1854, to disclaim the invention of the reversed angle of the teeth of the blade.

It was therefore a question for the jury, under section 9 of the act of March 3, 1837, (Curtis, 489, 490,) whether the plaintiff had not unreasonably neglected or delayed to enter at the Patent Office his disclaimer.

To allow a patentee, under such circumstances, to designedly delay a disclaimer, would defeat the manifest object of the last proviso to section 9 above referred to, which was to compel a patentee who had inadvertently covered by his patent something to which he was not entitled, and thus wrongfully obstructed its free use, to remove the obstruction as soon as possible after the discovery of his mistake.

XI. The request of instructions to the jury, "that from the facts that Bell's machine operated successfully in 1829, and that it operated well also in 1853, they were at liberty to infer that it had oper-

## Argument for the plaintiff in error.

ated successfully in the intermediate period, or some part of it," should have been given; and the actual charge, "that there being no evidence respecting it, except the trial of it in 1829, and the trial of it in 1853, *the jury could not infer anything on the subject*," was erroneous.

What the evidence was, of the use of Bell's machine, will be found in Loudon's *Encyclopædia of Agriculture*, pages 427 to 442, and from the testimony of Obed Hussey.

We think that on this evidence, (that the machine used in England was that described by Loudon,) it was proper to submit to the jury the question as to its operation, and not to place it under the ban as an entire failure, which seems to be the effect of the charge as it was given.

If it operated well in 1829 and in 1853, which is clearly proved, and is assumed by the judge, it must certainly have been *capable* of operating well at any intermediate time. Whether actually used or not, is wholly immaterial.

And if the machine as a whole operated well, then the divider, reel, and reel-bearer each operated well, and the reel was supported by a practically successful contrivance, which formed no impediment in the way of the divider, or of the division and separation of the grain, and on which no straws could clog, as the entire space beneath the reel-shaft is, in this machine, left unobstructed by the reel-bearer, which is horizontal some feet above the platform, and completely out of the reach of the grain. There is no difference between the reel-bearer in the machine of the plaintiffs in error and that in Bell's machine. Waters, (McCormick's witness,) on being shown the drawing of Bell's machine, in Loudon's *Encyclopædia of Agriculture*, says: "As a mere manner of supporting the reel, I see no difference between the method of supporting the reel in this and the defendants' machine."

This prior invention of Bell's, if the court had not substantially excluded it from the consideration of the jury, would have furnished a complete answer to the charge of infringement of the fifth claim of McCormick's patent of 1845. *Evans v. Hettich*, 3 Wash., 408; S. C., 1 Robb, 166.

XII. It was erroneous to grant *costs* to the plaintiff, inasmuch as it appeared that he was not the first inventor of the reversed angle of the sickle, and had not filed a disclaimer prior to the commencement of the suit. Act of 1837, sec. 9.

The testimony showed conclusively that Moore was the first inventor of the reversed angle of the teeth.



Points for the defendant in error.

*Thirteenth Exception.*—The description annexed to the letters patent of plaintiff describes a sickle with reversed-cut teeth, and then describes the manner in which this reversed-cut sickle operates in connection with the spear-headed fingers, “forming an acute angle between the edge of the blade and the shoulder of the spear, by which the grain is prevented from yielding to the touch of the blade.” The specification then claims “the reversed angle of the teeth of the blade in the manner described.”

1. It also appeared, that ever since the date of the first reaping machine patent in 1834, the plaintiff had experimented with this reversed sickle edge without producing any successful result, until he combined it with the manner described in the patent of 1845.

2. The sickle, separate and apart from the machine, is no invention, in whatever way the teeth are cut, but when combined in the machine in the manner described, the reversed cut becomes a very valuable invention, enabling the sickle to cut itself clear each stroke, whereas if the sickle were cut only one way, and the fingers were straight, it would only operate on the grain half the time.

3. This part of the invention was not infringed.

*Fourteenth Exception.*—Unreasonable neglect to file a disclaimer under the ninth section of the act of 1837, is a question of fact for the jury.

*Fifteenth Exception.*—There was no evidence that Moore had ever constructed a reversed-cut sickle in the manner described in the patent of plaintiff, nor that he had ever made one in any manner which was successful—the only claim being, that in 1836–1837 Moore had made a reversed-cut sickle, and had never seen one before, while the plaintiff had done the same thing in 1834. There was, therefore, no fact for the jury to find, and it would have been erroneous if the court had submitted an hypothesis unsupported by evidence for their decision.

The construction of the claim also settled this point, because there was a pretense that such a manner of applying the reversed-cut sickle was old.

*Twentieth Exception.*—The facts stated in this exception, that the machine operated successfully in 1829 and in 1853, are not evidence from which the jury could legally infer that it had operated successfully in the intermediate period, or any part; for there is no rule which raises a presumption of successful operation out of the facts assumed in the prayer, but rather the contrary, since, if it ever did succeed at all, it most probably never would have been abandoned, and then

continued use to a more recent date would have been quite as easily proved as its use at any prior date.

Mr. Justice NELSON delivered the opinion of the court.

This is a writ of error to the Circuit Court of the United States for the Northern District of New York.

The suit was brought by McCormick against Seymour & Morgan, for the infringement of a patent for improvements in a reaping-machine granted to the plaintiff on the 31st of June, 1845. The improvements claimed to be infringed were, (1) a contrivance or combination of certain parts of the machinery described, for dividing the cut from the uncut grain; and (2) the arrangement of the reel-post in the manner described, so as to support the reel without interfering with the cutting instrument.

In the course of the trial, a question arose upon the true construction of the second claim in the patent, which is as follows: "I claim the reversed angle of the teeth of the blade in manner described." This claim was not one of the issues in controversy, as no allegation of infringement was set forth in the declaration. But it was insisted, on the part of the defendants, that the claim or improvement was not new, but had before been discovered and in public use; and that under the ninth section of the act of Congress passed March 3, 1837, the plaintiff was not entitled to recover cost, for want of a disclaimer of the claim before suit brought; and that if he had unreasonably neglected or delayed making the disclaimer, he was not entitled to recover at all in the case.

The ground upon which the defendants insisted this claim was not new, was that it claimed simply the reversed angle of the teeth of the blade or cutters. The court below were of opinion, that, reading the claim with reference to the specification in which the instrument was described, it was intended to claim the reversed angle of the teeth in connection with the spear-shaped fingers arranged for the purpose of securing the grain in the operation of the cutting—the novelty of which was not denied.

The majority of the court are of opinion that this construction of the claim cannot be maintained, and that it is simply for the reversed angle of the cutters; and that there is error, therefore, in the judgment, in allowing the plaintiff costs.

In respect to the question of unreasonable delay in making the disclaimer, as going to the whole cause of action, the court are of opinion that the granting of the patent for this improvement, together with the opinion of the court below maintaining its validity, repel any

## Opinion of the court.

inference of unreasonable delay in correcting the claim; and that, under the circumstances, the question is one of law. This was decided in the case of *The Telegraph*, 15 Howard, 121. The chief justice, in delivering the opinion of the court, observed that "the delay in entering it (the disclaimer) is not unreasonable, for the objectionable claim was sanctioned by the head of the office; it has been held to be valid by a Circuit Court, and differences of opinion in relation to it are found to exist among the justices of this court. Under such circumstances, the patentee had a right to insist upon it, and not disclaim it until the highest court to which it could be carried had pronounced its judgment."

Several other questions were raised in the case, which have been attentively considered by the court, and have been overruled, but which it cannot be important to notice at large, with one exception, which bears upon the fifteenth section of the Patent Act of 1836.

Bell's reaping-machine was given in evidence, in pursuance of a notice under this section, with a view to disprove the novelty of one of the plaintiff's improvements; a description of it was read from Loudon's *Encyclopædia of Agriculture*, published in London, England, in 1831. In addition to the description of the machine, it appeared in the work that the reaper had been partially successful in September, 1828, and 1829.

It also appeared, from the evidence of Mr. Hussey, that he saw it in successful operation in the harvest of 1853.

The court was requested, on the trial, to instruct the jury, that from the facts that Bell's machine operated successfully in 1829 and in 1853, they were at liberty to infer that it had operated successfully in the intermediate period, which was refused. Without stating other grounds to justify the ruling, it is sufficient to say, that the only authority for admitting the book in evidence is the fifteenth section of the act above mentioned. That section provides that the defendant may plead the general issue, and give notice in writing, among other things, to defeat the patent, "that it (the improvement) had been described in some public work anterior to the supposed discovery thereof by the patentee." The work is no evidence of the facts relied on for the purpose of laying a foundation for the inference of the jury, sought [to] be obtained.

The judgment of the court below is affirmed, with the qualification, that on the case being remitted to the court below, the taxation of costs be stricken from the record.

Mr. Justice GRIER dissented.

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Argument for the plaintiff in error.

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ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Northern District of New York, and was argued by counsel; on consideration whereof, it is now here ordered and adjudged by this court, that the judgment of the said Circuit Court in this cause, except that part embracing the taxation of costs in the Circuit Court, be, and the same is hereby, affirmed with costs; and it is further ordered and adjudged by this court, that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to strike from the record the taxation of costs in this cause.

AFFIRMED WITH COSTS.

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JOHN BROWN, PLAINTIFF IN ERROR, v. ——— DUCHESNE.

(19 Howard, 183.)

The rights of property and exclusive use granted to a patentee do not extend to a foreign vessel lawfully entering one of our ports; and the use of such improvement in the construction, fitting out, or equipment of such vessel, while she is coming into or going out of a port of the United States, is not an infringement of the rights of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs.

THIS case came up by writ of error from the Circuit Court of the United States for the District of Massachusetts.

The facts in the case and state of the pleadings in the Circuit Court are set forth so particularly in the opinion of the court that they need not be repeated.

It was submitted on a printed argument by *Mr. Dana*, for the plaintiff in error, and argued by *Mr. Austin*, for the defendant.

As the points raised in the case are entirely new, it is thought expedient to present them to the reader as they were brought before the court by the respective counsel.

*Mr. Dana*, for the plaintiff in error, after stating the circumstances of the case, said that the question for the court to decide was—

Whether, under these circumstances, there is an exemption from the operation of our Patent Laws, by reason of the nationality of the vessel.

## Argument for the plaintiff in error.

Since this cause was argued in the Circuit Court, my attention has been called to the case of *Caldwell v. Van Vlissingen*, 9 Hare, 415; 9 Eng. L. and Eq., 51.

In that case, the machine patented was a screw propeller. This was a substantial part of the vessel, and almost necessary to her use. The vessel was built and solely owned in Holland, where the invention was in free and common use. The affidavits set forth facts sufficient to establish an exemption, if national character can give one. The court fully considers the question, and decides against the exemption. (On pages 58 and 59, the court puts the right to an injunction upon the ground that actions at law are maintainable in these cases.) The court considers that the question of the exemption of foreign vessels, either entirely or in cases of reciprocity, is one of national policy, and to be dealt with by the legislature, rather than by the courts.

After reading this decision, I wrote to Sir William Page Wood, the counsel for the respondents, then Solicitor-General, and now Vice-Chancellor, and received from him the following reply:

31 GREAT GEORGE STREET, WESTMINSTER,

November 6, 1855.

MY DEAR SIR: Your letter reached me yesterday. The case you refer me (*Caldwell v. Van Vlissingen*) was *not* appealed. I thought the decision was right, though it was against me. At the same time, I saw that there were inconveniences in the application of the law; and in the session of 1852, when a bill was passing through the House of Commons, with reference to the amendment of the Patent Laws, I proposed the insertion of the following clause. [Here follows section 26 of the act of 15 and 16 Victoria, ch. 83.]

The opinion of Sir William Page Wood is entitled to great weight before every judicial tribunal, as is well known to your honors.

After this decision, the act 15 and 16 Victoria, ch. 83, was passed, section 26 of which is as follows (4 Chitty's Statutes, 217): "No letters patent for any invention (granted after the passing of this act) shall extend to prevent the use of such invention in any foreign ship or vessel, or for the navigation of any foreign ship or vessel, which may be in any port of her Majesty's dominions, or in any of the waters within the jurisdiction of any of her Majesty's courts, where such invention is not used for the manufacture of any goods or commodities to be vended within or exported from her Majesty's dominions: Provided, always, that this enactment shall not extend to the ships or vessels of any foreign State, of which the laws authorize

subjects of such foreign State, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British ships or vessels, while in the ports of such foreign State, or in the waters within the jurisdiction of its courts, where such inventions are not so used for the manufacture of goods or commodities to be vended within or exported from the territories of such foreign State."

Such is the state of the law in Great Britain, the greatest commercial nation of Europe. There is no reason to believe that the law of any other nation of Europe varies from that of England. Indeed, it is probable that other nations will do likewise, and keep in their own hands the power of granting or withholding such an exemption, on considerations of policy, by legislation or treaty.

It is therefore respectfully suggested that the court should leave this question to the law-making and treaty-making departments of our government, in the meantime placing the law in this country upon the same basis upon which it rests in England.

Is there any controlling reason why the court should not do this?

It is conceded that the statute, in its terms, suggests no exemption. No *interpretation* of the statute would suggest an exemption. If one is established, it must be by some *imposed construction*, paramount over the plain language of the acts. This is found solely in certain supposed principles of international law. No decision in point, in this country, has been cited, and the English cases referred to are inapplicable, as shown in *Culdwell v. Van Vlissingen*, cited.

The defendant's vessel, being private property, and here voluntarily, for purposes of trade, has no exemption from general national jurisdiction. Phillimore's Int. Law, 367, 373; *The Exchange*, 7 Cr., 144; Story's Conflict of Laws, sec. 383.

International law respects absolute rights, the violation of which is cause of war, and comity, or rights of imperfect obligation, the contravention of which is not presumed, but which each nation is competent to contravene if it chooses. This distinction is well stated in Mr. Webster's letter to Lord Ashburton, in appendix to Wheaton's Law of Nations.

It will not be claimed that the prohibition of the use of such an article as this, in a private vessel, under these circumstances, is a violation of any absolute right secured by the law of nations. The government has the right to prohibit commerce altogether, or with particular nations, as by embargo or non-intercourse laws. 1 Kent's Comm., sec. 33, n.; Vattel, book 2, ch. 7, sec. 94; ch. 8, sec. 100; ch. 2, secs. 25, 33—book 1, ch. 8, sec. 90.

## Argument for the plaintiff in error.

As a nation may prohibit trade, so it may lay conditions and restrictions. Authorities cited *supra*. Vattel, book 2, ch. 8, sec. 100.

The question is really under the *comitas gentium*. Between countries trading freely, is there a presumption from the law of comity that no nation will prohibit or restrict the use of such an invention, under such circumstances, so well settled as to authorize a court to establish the exception against the language of the statute?

This can hardly be contended, since the case of *Caldwell v. Van Vlisengen*, and the act 15 and 16 Victoria.

This is not a question of property, or of the domicile or *situs* of property. The defendant may have his vessel full of these articles, if he chooses. We admit the property in the article to be in him, and that it is part of the national wealth of France, and has its *situs* in France, for purposes of taxation, and for all national purposes. *Hays v. Pacific Co.*, 17 How., 596. The question is upon a restriction of its use within our dominions.

As the use of the machine is not alleged to be necessary, and the presence of the vessel here is voluntary, if the comity of nations does not allow the prohibition in this case, it would forbid it in all cases of patents; and vessels nominally owned in the British Provinces, and in the West India Islands, may use all our nautical patents.

To what burdens is the foreigner and his personal property subject?

Not to taxes *for the support of the government*. *In re Bruce*, 2 Cr. & J., 437; Vattel, book 2, ch. 8, sec. 106.

Nor to duties that relate to the quality of a citizen, as militia or jury duties. But they are subject to all burdens, taxes, and duties relating to the police and economical regulations of a State. Vattel, book 2, ch. 8, sec. 106.

They are subject to imposts and duties levied for the purpose of encouraging the manufactures or other industry of a country, and are liable to prohibitions and restrictions made for the same purpose. Such are most navigation laws, and a large part of the revenue laws of a country. Vattel, book 2, ch. 8, sec. 106; 1 Kent's Comm., 35.

Their exemption seems to be based upon the principle that they shall not be required to do anything inconsistent with their home allegiance, or anything which supposes an allegiance or fealty to the State in which they merely sojourn.

The patent and copyright laws of a country stand upon the same ground with navigation laws, and laws prohibiting altogether or restricting certain kinds of trade, for economical purposes, or to add to the military resources and strength, or to increase the effective

power and industry of a country, or to develop its genius. As to these, each nation is the proper judge of its own policy. Vattel, book 2, ch. 2, secs. 25, 33.

Indeed, Vattel (book 1, ch. 20, sec. 255) seems to define the police regulations of a country so as to include Patent Laws.

The object of the Patent Laws is to develop the genius and industry of the country, as well for war as for peace. And whether the law in this case be looked upon as a prohibition of the use, or as a duty, burden, or tax on the use, it is equally within the recognized jurisdiction of the sovereign, under the comity of nations.

Under the British copyright laws, a foreigner cannot introduce into England, even for his private use, a book printed in his own country, if it is subject to copyright in England; and the introduction entails a forfeiture, instead of a tax to be paid to the author. Act 5 and 6 Victoria, ch. 45.

In this state of the international law, in the absence of all direct decisions in support of the defendant's position, and since the passage of 15 and 16 Victoria, and the decision in *Caldwell v. Van Vlissingen*, it is respectfully suggested that the question of exemption of foreigners (in cases not of necessity or charity) should be treated as a political rather than a legal question, and the British precedent be followed by the court, until Congress or the treaty-making power shall act upon it.

*Mr. Austin*, for defendant in error, made the following points:

I. Foreign vessels entering a port of the United States, by the express or implied permission of the government, do so under an implied immunity and reservation of the right belonging to them by the laws of the country to which they belong, with an implied understanding that the persons on board shall not violate the peace or domestic laws of the country. Vattel's Law of Nations, book 2, ch. 8, sec. 101.

The *Aleyon*, coming from the island of Miquelon, may be deemed to have entered a port of the United States by express permission. 5 United States Statutes at Large, 748, ch. 66, which specially mentions this island.

The plaintiff says that the terms of the Patent Law are broad enough to render the use of the aforesaid contrivance or gaff-saddle on board of the *Aleyon*, while in the harbor of Boston, a violation of his right.

The question is whether the Patent Law can be properly so construed as to include a use of said gaff-saddle, notwithstanding the circumstances under which the said gaff-saddle was incorporated into



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Argument for the defendant in error.

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the structure of the *Alcyon*, and notwithstanding the express or implied permission of the United States, by force of which she entered a port of the United States.

II. What shall or does constitute a vessel must be determined exclusively by the law of the country to which the vessel belongs, *i. e.*, by the law of the owner's domicil.

This follows necessarily from general maxims of international jurisprudence. Story on Con. of Laws, secs. 18, 20.

In order to ascertain what is or is not real property, we must resort to the *lex loci rei*; (*Id.*, secs. 382, 447;) so as to what is or what is not a corporation. *Bank of Augusta v. Earle*, 13 Pet., 519.

The *Alcyon*, although in a port of the United States, was still within the jurisdiction of France.

Children born on board of her while in Boston harbor would have been French subjects. Vattel's L. of N., book 1, ch. 19, sec. 216.

The extent to which this principle is applied is shown in the case of *In re Bruce*, 2 Cr. & J., 437, and *Thompson v. The Advocate-General*, 12 Clark & F., 1. See, also, *United States v. Wiltberger*, 5 Wheat., 76.

The gaff-saddle was as much an integral part of the *Alcyon* as her rudder, or her keel, or her gaff. Whether a more or less necessary part, does not alter the fact that it *was* rightfully a part of the vessel by French law. Therefore, if the United States Patent Law operated to prevent the defendant from using the gaff-saddle while in the harbor of Boston, notwithstanding it was a part of his vessel, without plaintiff's permission, it operated just so far to impose a restriction on the implied permission accorded by the United States to all French vessels to enter the ports of the United States, and upon the express permission accorded to all French vessels from Miquelon.

The statutes of the United States relating to patents were not intended to affect, and do not affect, foreign vessels coming into the ports of the United States.

1. The statutes of a country relating to patents are not such laws as a foreigner, visiting this country temporarily, and not to become a resident, is bound to obey, so far as those laws relate merely to the use of articles purchased abroad, and brought into the country solely for the personal use of the party in possession while a transient visitor. Vattel's L. of N., book 2, ch. 8, secs. 101, 106, 109; Boulle's *Traité des Statuts*, pp. 2, 3, 4; *Universities of Oxford and Cambridge v. Richardson*, 6 Ves. Jr., 689, which entirely supports this position.

2. The United States, in granting letters patent, or any other exclusive privilege, to a citizen, necessarily always reserve by impli-

cation their own rights of sovereignty, which are not to be affected by any individual or private privilege.

Examples of the application of this principle are as follows:

1. In regard to the right of eminent domain.

This exists inherently in every government. Vattel's L. of N., book 1, ch. 20, sec. 244; *Bonaparte v. The Camden and Amboy Railroad*, 1 Bald., 220.

It is recognized in the Constitution of the United States. Fifth amendment.

Therefore, if the government, by a land patent, convey to-day a portion of its public lands to an individual, it could to-morrow, by virtue of the implied reservation of its right of eminent domain, resume the land from its own grantee, and against his consent, by paying to him an indemnity.

Independently of the principle that the right of eminent domain, being an attribute of sovereignty, *could* not be conveyed away, the conclusion above stated follows from the rule that in public grants nothing passes by implication. *United States v. Arredondo*, 6 Pet., 738; *Jackson v. Lamphire*, 3 Pet., 289.

2. The constitutional power of Congress over commerce.

This power extends to navigation, (2 Story's Comm. on Con., sec. 1061,) and to every species of commercial intercourse. *Id.*, 1061.

In the exercise of this power, Congress, in 1845, after the date of the plaintiff's patent, passed the law relating to French vessels coming from Miquelon, (*ubi supra*,) which law makes no exception as to the kind of vessel, or the mode of its rig, or the peculiarities of its structure.

Either, therefore, the power of Congress to pass an act thus broad in its terms was limited by the grant to the plaintiff of an exclusive right to use the contrivance in question, or the exclusive right was limited in its extent by the implied reservation of power to pass such an act. As the grant to the plaintiff and the act of 1845 are in direct opposition, the grant must be construed against grantee. *Mills v. St. Clair County*, 8 How., 569.

The defendant does not contend that he would have a right to bring into a port of the United States a cargo or any number of these contrivances for sale; nor even that he had a right to detach and sell that on board of the *Aleyon*. In this argument the gaff-saddle is deemed a part of the schooner, in the same way as fixtures are parts of the reality.

3. The power of Congress to alienate a portion of its territory.

This power exists in every government. Vattel's L. of N., book 1,

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Argument for the defendant in error.

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ch. 21, sec. 263. It was exercised in the Treaty of Washington, 1842. 8 U. S. Stat. at Large, 572.

Every patent-right then existing extended over the whole country as then bounded. The alienation of a portion of the territory diminished the value, by diminishing the extent of every existing patent-right; but they were all granted, subject to the implied reservation of power on the part of the government thus to diminish their value.

The right, therefore, of the plaintiff to an exclusive use of his patented contrivance within the jurisdiction of the United States, was limited by the paramount right of the sovereignty of the United States to admit all vessels into the ports of the United States, which right they have exercised in regard to French vessels, by implication, by treaty, and by statute. The same reasoning which would separate the gaff-saddle from the schooner might be allowed to separate her into as many parts as there should happen to be articles on board of her incorporated into her structure, the like of which were patented in this country.

3. The private right of every patentee is subject to the public right of the government to admit into the ports of the United States any foreign vessel, free from any private or public charges, tolls, or burdens, other than those imposed by treaty or by the laws of nations. *The Attorney-General v. Burrige*, 10 Price, 350; *The Attorney-General v. Parmeter*, Id., 378; *Parmeter v. The Attorney-General*, Id., 412.

The cases cited are exactly analogous in principle to the case at bar.

In the citations, the *jus privatum* was a grant by Charles I of his property in land between high and low water mark; and the *jus publicum* with which it interfered was the right of the public freely to pass and repass upon the salt water between high and low water mark.

In the present case, the *jus privatum* is the exclusive right granted to the plaintiff to use within the jurisdiction of the United States a certain machine; and the *jus publicum* with which it interferes is the right the public has to the free admission into the ports of the United States of all foreign vessels, being such according to the law of the country where they belong.

The grant by Charles I of land between high and low water mark was held void, so far as it prevented this free passage. By parity of reasoning, the letters patent of the plaintiff must be held void, or rather as never having extended to foreign vessels visiting the ports of the United States, as the *Alcyon* visited Boston.

The principle here contended for, as it applies to ports and har-

bors, is clearly stated by Lord Hale, in his treatise *De Jure Maris*, ch. 6, p. 35, and in the treatise *De Portibus Maris*, chapter on the *jus publicum*, pages 84, 89: "When a port is fixed and settled," "though the soil, and franchise, and dominion thereof *prima facie* be in the king, or by derivation from him in a subject, yet that *jus privatum* is clothed and superinduced with a *jus publicum*." So in the case at bar, the *jus privatum* of the patentee is subject to the *jus publicum* by which foreign vessels, however constructed, may enter our ports; this government never having undertaken to decide, nor ever having granted to an individual the right to decide for the government, that certain vessels, or vessels constructed partly or wholly in a certain way, shall not enter our ports without paying a toll, or charge, or duty, not imposed by treaty or special laws relating thereto.

4. The statutes relating to patents cannot properly be so construed as to include machines or contrivances forming a part of the original structure of foreign vessels entering the ports of the United States, as the *Alcyon* entered Boston harbor.

(1.) Because such construction, for the reasons above stated, would introduce public mischiefs and manifest incongruities. *Savin v. Guild*, 1 Gall., 485; *Talbot v. Seaman*, 1 Cr., 1; *Murray v. The Charming Betsey*, 2 Id., 64.

(2.) These statutes were passed *alio intuitu*. See the reasoning of Judge Curtis, in the opinion delivered by him in this case, printed from the original manuscript in 4 Am. Law Register, 152. Also, *Lessee of Brewer v. Blougher*, 14 Pet., 178: "The laws will restrain the operation of a statute within narrower limits than its words import, if the literal meaning of its language would extend to cases which the legislature never designed to embrace in it"—198. It cannot be supposed that Congress intended the statutes on patents to confer a right on a patentee to interfere in any way with the exercise of a license conferred by government on a foreign vessel. Same doctrine in *Mercer v. Mechanics' Bank of Alexandria*, 1 Pet., 64.

IV. Letters patent of the United States confer upon the grantee the exclusive right to the subject-matter of the patent, *to be exercised within their jurisdiction*. A foreign ship coming within one of the ports of the United States, with their express or implied permission, is without the jurisdiction within which this exclusive right is to be exercised.

1. Foreigners within the territorial jurisdiction of a country may yet be within its municipal jurisdiction for no purpose whatever. Such is the status of public ministers, (Wheaton's Elements of the L.

Argument for the defendant in error.

of N., part 3, ch. 1, sec. 14; Id., part 2, ch. 2, sec. 9,) and of foreign sovereigns entering the territory of another, (Id., Id., Id.) and of foreign armies marching, &c., through the territory, (Id., Id., Id.) and of a foreign ship of war, (Id., Id., Id.) and *Schooner Exchange v. McFadden*, 7 Cr., 135, 147.

2. Foreigners within the territorial may be within the municipal jurisdiction of a country for all purposes. This is the status of foreigners who come into the country *animo manendi*, becoming inhabitants. Vattel's L. of N., book 1, ch. 19, sec. 213.

3. Foreigners within the territorial may be within the municipal jurisdiction for some purposes, and not for others. This is the case with transient persons (Vattel's L. of N., book 2, ch. 8, secs. 105, 106, 108, 109) and consuls. Wheaton's Elements, part 3, ch. 1, sec. 23. The same principle applies to a part of the country in temporary possession of an enemy. *United States v. Hayward*, 2 Gall., 485. To goods imported, and not entered, although within the territorial jurisdiction of the State, they are not subject to its municipal jurisdiction. *Harris v. Dennie*, 3 Pet., 292.

This principle applies to a foreign commercial vessel visiting a port of the United States. It is within the jurisdiction of the United States, so far that persons on board are bound to do no act against the public peace, or *contra bonos mores*, or against the revenue laws, &c., &c. But "for all the personal relations and responsibilities existing in a ship at the time she entered a port, and established or permitted by the laws of her own country, her authorities are answerable only at home; and to interfere with them in discharge of the duties imposed upon them, or the exercise of the powers vested in them by those laws, on the ground of their being inconsistent with the municipal legislation of the country where the ship happens to be lying, is to assert for that legislation a superiority not acknowledged by the law, and inconsistent with the independence of nations." Mr. Legare's Opinion, 4 Opin. of Attorneys-General, 98, 102; same point, 6 Webster's Works, 303.

V. The case of *Caldwell v. Van Vlissingen*, 9 Hare, 415, reprinted in 9 Eng. Law and Equity R., 51, will be cited by plaintiff in error, as deciding the point before the court. On this case, the defendants say:

1. It will be regarded by this court only so far as the reasoning commends itself to the court as sound.

2. The case was not placed upon the grounds assumed in the case at bar. The principles here contended for were neither considered nor even presented to the court.

3. Statute 15 and 16 Victoria, ch. 83, sec. 26, passed July 1, 1852. provides that letters patent thereafter granted shall not prevent the use of inventions in foreign ships resorting to British ports when not used for the manufacture of goods to be vended in or exported from England, excepting from the act ships of foreign States in the ports of which British ships are prevented from using foreign inventions when not employed for the manufacture of goods to be vended in or exported from such foreign States.

This statute was passed in evident recognition of the existence and propriety of the principles of international law contended for by the defendant in error.

Mr. Chief Justice TANEY delivered the opinion of the court.

This case comes before the court upon a writ of error to the Circuit Court of the United States for the District of Massachusetts.

The plaintiff in error, who was also plaintiff in the court below, brought this action against the defendant for the infringement of a patent which the plaintiff had obtained for a new and useful improvement in constructing the gaff of sailing vessels. The declaration is in the usual form, and alleges that the defendant used this improvement at Boston without his consent. The defendant pleaded that the improvement in question was used by him only in the gaffs of a French schooner, called the *Alcyon*, of which schooner he was master; that he (the defendant) was a subject of the Empire of France; that the vessel was built in France, and owned and manned by French subjects; and, at the time of the alleged infringement, was upon a lawful voyage, under the flag of France, from St. Peters, in the island of Miquelon, one of the colonies of France, to Boston, and thence back to St. Peters, which voyage was not ended at the date of the alleged infringement; and that the gaffs he used were placed on the schooner at or near the time she was launched by the builder, in order to fit her for sea.

There is also a second plea, containing the same allegations, with the additional averment that the improvement in question had been in common use in French merchant vessels for more than twenty years before the *Alcyon* was built, and was the common and well-known property of every French subject long before the plaintiff obtained his patent.

The plaintiff demurred generally to each of these pleas, and the defendant joined in demurrer; and the judgment of the Circuit Court being in favor of the defendant, the plaintiff thereupon brought this writ of error.

## Opinion of the court.

The plaintiff, by his demurrer, admits that the *Atyon* was a foreign vessel, lawfully in a port of the United States for the purposes of commerce, and that the improvement in question was placed on her in a foreign port to fit her for sea, and was authorized by the laws of the country to which she belonged. The question, therefore, presented by the first plea is simply this: Whether any improvement in the construction or equipment of a foreign vessel, for which a patent has been obtained in the United States, can be used by such vessel within the jurisdiction of the United States, while she is temporarily there for the purposes of commerce, without the consent of the patentee?

This question depends on the construction of the Patent Laws. For undoubtedly every person who is found within the limits of a government, whether for temporary purposes or as a resident, is bound by its laws. The doctrine upon this subject is correctly stated by Mr. Justice Story, in his Commentaries on the Conflict of Laws, ch. 14, sec. 541, and the writers on public law to whom he refers. A difficulty may sometimes arise, in determining whether a particular law applies to a citizen of a foreign country, and intended to subject him to its provisions. But if the law applies to him, and embraces his case, it is unquestionably binding upon him when he is within the jurisdiction of the United States.

The general words used in the clause of the Patent Laws granting the exclusive right to the patentee to use the improvement, taken by themselves, and literally construed, without regard to the object in view, would seem to sanction the claim of the plaintiff. But this mode of expounding a statute has never been adopted by any enlightened tribunal, because it is evident that in many cases it would defeat the object which the legislature intended to accomplish. And it is well settled, that in interpreting a statute, the court will not look merely to a particular clause in which general words may be used, but will take in connection with it the whole statute (or statutes on the same subject) and the objects and policy of the law, as indicated by its various provisions, and give to it such a construction as will carry into execution the will of the legislature, as thus ascertained, according to its true intent and meaning.

Neither will the court, in expounding a statute, give to it a construction which would in any degree disarm the government of a power which has been confided to it to be used for the general good—or which would enable individuals to embarrass it, in the discharge of the high duties it owes to the community—unless plain and express words indicated that such was the intention of the legislature:

## Opinion of the court.

The Patent Laws are authorized by that article in the Constitution which provides that Congress shall have power to promote the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries. The power thus granted is domestic in its character, and necessarily confined within the limits of the United States. It confers no power on Congress to regulate commerce, or the vehicles of commerce, which belong to a foreign nation, and occasionally visit our ports in their commercial pursuits. That power and the treaty-making power of the general government are separate and distinct powers from the one of which we are now speaking, and are granted by separate and different clauses, and are in no degree connected with it. And when Congress are legislating to protect authors and inventors, their attention is necessarily attracted to the authority under which they are acting, and it ought not lightly to be presumed that they intended to go beyond it, and exercise another and distinct power, conferred on them for a different purpose.

Nor is there anything in the Patent Laws that should lead to a different conclusion. They are all manifestly intended to carry into execution this particular power. They secure to the inventor a just remuneration from those who derive a profit or advantage, within the United States, from his genius and mental labors.

But the right of property which a patentee has in his invention, and his right to its exclusive use, is derived altogether from these statutory provisions; and this court have always held that an inventor has no right of property in his invention, upon which he can maintain a suit, unless he obtains a patent for it, according to the acts of Congress; and that his rights are to be regulated and measured by these laws, and cannot go beyond them.

But these acts of Congress do not, and were not intended to, operate beyond the limits of the United States; and as the patentee's right of property and exclusive use is derived from them, they cannot extend beyond the limits to which the law itself is confined. And the use of it outside of the jurisdiction of the United States is not an infringement of his rights, and he has no claim to any compensation for the profit or advantage the party may derive from it.

The chief and almost only advantage which the defendant derived from the use of this improvement was on the high seas, and in other places out of the jurisdiction of the United States. The plea avers that it was placed on her to fit her for sea. If it had been manufactured on her deck while she was lying in the port of Boston, or if the captain had sold it there, he would undoubtedly have trespassed upon



## Opinion of the court.

the rights of the plaintiff, and would have been justly answerable for the profit and advantage he thereby obtained; for, by coming in competition with the plaintiff, where the plaintiff was entitled to the exclusive use, he thereby diminished the value of his property. Justice, therefore, as well as the act of Congress, would require that he should compensate the patentee for the injury he sustained, and the benefit and advantage which he (the defendant) derived from the invention.

But so far as the mere use is concerned, the vessel could hardly be said to use it while she was at anchor in the port, or lay at the wharf. It was certainly of no value to her while she was in the harbor; and the only use made of it, which can be supposed to interfere with the rights of the plaintiff, was in navigating the vessel into and out of the harbor, when she arrived or was about to depart, and while she was within the jurisdiction of the United States. Now, it is obvious that the plaintiff sustained no damage, and the defendant derived no material advantage, from the use of an improvement of this kind by a foreign vessel in a single voyage to the United States, or from occasional voyages in the ordinary pursuits of commerce; or if any damage is sustained on the one side, or any profit or advantage gained on the other, it is so minute that it is incapable of any appreciable value.

But it seems to be supposed that this user of the improvement was, by legal intendment, a trespass upon the rights of the plaintiff; and that although no real damage was sustained by the plaintiff, and no profit or advantage gained by the defendant, the law presumes a damage, and that the action may be maintained on that ground. In other words, that there is a technical damage, in the eye of the law, although none has really been sustained.

This view of the subject, however, presupposes that the Patent Laws embrace improvements on foreign ships, lawfully made in their own country, which have been patented here. But that is the question in controversy. And the court is of opinion that cases of that kind were not in the contemplation of Congress in enacting the Patent Laws, and cannot, upon any sound construction, be regarded as embraced in them. For such a construction would be inconsistent with the principles that lie at the foundation of these laws; and instead of conferring legal rights on the inventor, in order to do equal justice between him and those who profit by his invention, they would confer a power to exact damages where no real damage had been sustained, and would, moreover, seriously embarrass the commerce of the country with foreign nations. We think these laws ought to be

construed in the spirit in which they were made—that is, as founded in justice—and should not be strained by technical constructions to reach cases which Congress evidently could not have contemplated, without departing from the principle upon which they were legislating, and going far beyond the object they intended to accomplish.

The construction claimed by the plaintiff would confer on patentees not only rights of property, but also political power, and enable them to embarrass the treaty-making power in its negotiations with foreign nations, and also to interfere with the legislation of Congress when exercising its constitutional power to regulate commerce. And if a treaty should be negotiated with a foreign nation, by which the vessels of each party were to be freely admitted into the ports of the other, upon equal terms with its own, upon the payment of the ordinary port charges, and the foreign government faithfully carried it into execution, yet the government of the United States would find itself unable to fulfill its obligations if the foreign ship had about her, in her construction or equipment, anything for which a patent had been granted; and after paying the port and other charges to which she was subject by the treaty, the master would be met with a further demand, the amount of which was not even regulated by law, but depended upon the will of a private individual.

And it will be remembered that the demand, if well founded in the Patent Laws, could not be controlled or put aside by the treaty; for, by the laws of the United States, the rights of a party under a patent are his private property; and, by the Constitution of the United States, private property cannot be taken for public use without just compensation. And in the case I have stated, the government would be unable to carry into effect its treaty stipulations without the consent of the patentee, unless it resorted to its right of eminent domain, and went through the tedious and expensive process of condemning so much of the right of property of the patentee as related to foreign vessels, and paying him such a compensation therefor as should be awarded to him by the proper tribunal. The same difficulty would exist in executing a law of Congress in relation to foreign ships and vessels trading to this country. And it is impossible to suppose that Congress, in passing these laws, could have intended to confer on the patentee a right of private property which would in effect enable him to exercise political power, and which the government would be obliged to regain by purchase, or by the power of its eminent domain, before it could fully and freely exercise the great power of regulating commerce, in which the whole nation has an interest. The Patent Laws were passed to accomplish a different purpose, and with an eye

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to a different object; and the right to interfere in foreign intercourse, or with foreign ships visiting our ports, was evidently not in the mind of the legislature, nor intended to be granted to the patentee.

Congress may unquestionably, under its power to regulate commerce, prohibit any foreign ship from entering our ports, which, in its construction or equipment, uses any improvement patented in this country, or may prescribe the terms and regulations upon which such vessel shall be allowed to enter. Yet it may, perhaps, be doubted whether Congress could by law confer on an individual, or individuals, a right which would in any degree impair the constitutional powers of the legislative or executive departments of the government, or which might put it in their power to embarrass our commerce and intercourse with foreign nations, or endanger our amicable relations. But however that may be, we are satisfied that no sound rule of interpretation would justify the court in giving to the general words used in the Patent Laws the extended construction claimed by the plaintiff, in a case like this, where public rights and the interests of the whole community are concerned.

The case of *Caldwell v. Flissengen*, 9 Hare, 416, 9 Eng. L. and Eq., 51, and the statute passed by the British Parliament in consequence of that decision, have been referred to and relied on in the argument. The reasoning of the vice-chancellor is certainly entitled to much respect, and it is not for this court to question the correctness of the decision, or the construction given to the statute of Henry VIII.

But we must interpret our Patent Laws with reference to our own Constitution and laws and judicial decisions. And the court are of opinion that the rights of property and exclusive use granted to a patentee do not extend to a foreign vessel lawfully entering one of our ports; and that the use of such improvement, in the construction, fitting out, or equipment of such vessel, while she is coming into or going out of a port of the United States, is not an infringement of the right of an American patentee, provided it was placed upon her in a foreign port, and authorized by the laws of the country to which she belongs.

In this view of the subject, it is unnecessary to say anything in relation to the second plea of the defendant, since the matters relied on in the first are sufficient to bar the plaintiff of his action, without the aid of the additional averments contained in the second.

The judgment of the Circuit Court must therefore be affirmed.

**AFFIRMED.**

ISAAC HARTSHORN AND DANIEL HAYWARD, PLAINTIFFS IN ERROR, v.  
HORACE H. DAY.

(19 Howard, 211.)

1. Where a patentee is about to apply for a renewal of his patent, and agrees with another person that, in case of success, he will assign to him the renewed patent, and the patent is renewed, such an agreement is valid, and conveys to the assignee an equitable title, which can be converted into a legal title by paying, or offering to pay, the stipulated consideration.
2. An agreement between Chaffee, the patentee, and Judson, after the renewal, reciting that the latter had stipulated to pay the expenses of the renewal and make an allowance to the patentee of \$1,200 a year, during the renewed term, and then declaring: "Now, I (Chaffee) do hereby, in consideration of the premises, and to place my patent so that in case of my death, or other accident or event, it may inure to the benefit of Charles Goodyear, and those who hold a right to the use of said patent, under and in connection with his licensees, &c., nominate, constitute, and appoint said William Judson my trustee and attorney irrevocable, to hold said patent and have the control thereof, so as no one shall have a license to use said patent or invention, &c., other than those who had a right when said patent was extended, without the written consent of said Judson, &c.,"—passed the entire ownership in the patent, legal and equitable, to Judson, for the benefit of Goodyear and those holding rights under him.
3. If this annuity was not regularly paid, the original patentee had no right to revoke the power of attorney, and assign the patent to another party. His right to the annuity rested in covenant, for a breach of which he had an adequate remedy at law.
4. Evidence tending to show that the agreement between the patentee and the attorney had been produced by the fraudulent representations of the latter, in respect to transactions out of which the agreement arose, ought not to have been received, it being a sealed instrument.
5. In a court of law, between parties or privies, evidence of fraud is admissible only where it goes to the question whether or not the instrument ever had any legal existence. But it was especially proper to exclude it in this case, where the agreement had been partly executed, and rights of long standing had grown up under it.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Rhode Island.

It was an action brought by Day against Hartshorn and Hayward, for the violation of a patent for the preparation and application of India-rubber to cloths, granted to E. M. Chaffee in 1836, and renewed for seven years in 1850. Day claimed under an assignment of this patent from Chaffee, on the 1st of July, 1853. The defenses taken by Hartshorn and Hayward are stated in the opinion of the court, in which there is also a succinct narrative of the whole case.

The defendants below first pleaded four special pleas, which were

## Argument for the plaintiffs in error.

overruled upon demurrer. They then gave notice of eleven defenses, assailing the validity of the patent. The record was very voluminous, being upwards of a thousand printed pages. One hundred and thirty-five exceptions were taken during the progress of the trial, which lasted for six weeks. After the testimony was closed, the counsel for the defendants offered seventy-four propositions to the court, by way of instruction to the jury, and six supplemental ones, with regard to the fraud alleged to have been practiced upon Chaffee by Judson. The court then charged the jury as contained in fifteen printed pages of the record, and the case came up to this court upon the following exception :

The court refused to instruct the jury as requested by the defendant's counsel, except so far as the propositions presented by them were adopted or approved in the charge as made, and refused to charge otherwise than as the jury had been instructed. The defendant's counsel excepted to such refusals respectively, and also to the refusal of said court as to each of said requests. They also excepted to each instruction given by the court contrary to such requests, or either of them.

All this vast mass of matter was open to argument in this court.

It was argued by *Mr. O' Connor*, upon a brief filed by himself and *Mr. Brady*, for the plaintiffs in error, and by *Mr. Richardson* and *Mr. Jenckes*, for the defendant, upon which side, also, a printed argument was filed by *Mr. Gillet*.

There is only room to notice the general points taken by the respective counsel, omitting all subdivisions and illustrations. These would occupy half a volume. The points made on behalf of the plaintiffs in error were the following :

*First Point.*—The agreement of May 23, 1850, was a valid executory agreement by Chaffee to sell and convey to Goodyear the renewed patent now in question, in case such a patent should issue ; and, upon its issue, the equitable ownership thereof vested in Goodyear, subject only to the license reserved to Chaffee to use it in his own business. Curtis on Patents, secs. 195, 196.

*Second Point.*—Chaffee having, by the agreement of September 5, 1850, without notice to Goodyear, without his consent, and, as it would appear, against his will, made another deposition of the patent, and having thereby put it entirely out of his (Chaffee's) power to execute a formal assignment to Goodyear, and thus entitle himself to the payment of the \$1,500 by Goodyear, which formed the only

condition precedent to a complete investiture of Goodyear with at least the whole equitable ownership of the patent, he (Chaffee) and Day, his assignee, are precluded from availing themselves of such non-payment by Goodyear as an objection to the use of the patented invention by Goodyear and his licensees. *Hockster v. Delatour*, 2 Ell. & Black., 688, and cases cited.

*Third Point.*—The agreement between Chaffee and Judson, dated September 5, 1850, construed by itself alone, or in connection with the supplement thereto, dated November 12, 1851, and whether read, as it rightfully may be, in the light of surrounding and attending circumstances, or without such aid, (6 Peters, 68,) was, on the part of Chaffee, an executed contract. No further act of any kind was to be performed on his part; and as it contained no condition subsequent, nor any clause of cesser, nor any reservation of power to rescind for any cause, the interest vested by it in Judson and his *cestuis que trust* could not be divested by Judson's omission to make prompt and punctual payments of the annuity. *Brooks et al. v. Stolly*, 3 McLean, 526; *Woodworth v. Weed*, 1 Blatchf., 165.

*Fourth Point.*—Although it is not deemed material whether the interest acquired by Judson under the agreements between him and Chaffee was of an equitable or legal character, it is submitted that the whole legal title to the patent was thereby vested in Judson, subject to the license reserved to Chaffee to use the invention in his own business.

*Fifth Point.*—If the grant or agreement set forth in the paper dated September 5, 1850, is to be regarded as having been authenticated by the seal of Chaffee, and the actual execution by him, when of sound mind, of full age, and with knowledge of its contents, was established, neither Chaffee nor Day, the plaintiff, who was his assignee and privy in estate, could be permitted to allege or prove, in a court of common law, for the purpose of defeating such grant or agreement, or for the purpose of varying its effect, that Chaffee was induced to execute it by threats of a lawsuit, or of hostility, or by false, deceitful, or fraudulent representations.

*Sixth Point.*—The court below erred in admitting the evidence of Woodman and Chaffee, touching the alleged fraudulent representations, and also in submitting the allegation of fraud to the jury, notwithstanding Woodman's professed non-recollection that the instrument bore a seal when executed, and his asserted but groundless disbelief of that fact.

*Seventh Point.*—Independently of the positions assumed in the preceding fifth and sixth points, the court erred in submitting it to the

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Argument for the defendant in error.

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jury, to find that the instrument of September 5, 1850, was obtained by fraud, because there was no legal evidence in the case to support that allegation.

(The other points related to the pleas and demurrers.)

The points made on behalf of the defendant in error are taken from the brief of *Mr. Jenckes*, omitting all except those which relate to the power of Chaffee to revoke the power of attorney to Judson, and to assign the patent to Day.

I. The paper of the 5th of September, 1850, supposing it to have been untainted with fraud, conveyed no interest in the extended patent to Judson, or to Goodyear and his licensees. There is no word of grant or conveyance in it. It does not purport to give a license directly to Goodyear or his licensees. It gives Judson no power to grant licenses to any one.

II. The paper of the 5th of September, 1850, offered a license to no persons except those who had a right to use the Chaffee patent at the time of its extension.

Hartshorn had no license to use the inventions of either Goodyear or Chaffee during the original term of the Chaffee patent. His license to use Goodyear's inventions was given on the 1st of February, 1851.

III. The legal title of the patent remained in Chaffee, and any action at law for an infringement must have been brought in his name, before his assignment to the defendant in error.

IV. The instrument bearing date November 12, 1851, being between the same parties, and having relation to the same subject-matter, and purporting to be made for the purpose of correcting errors and omissions in the instrument of September 5, 1850, the two must be taken together as one instrument, and be so construed.

V. This instrument makes clear what was of doubtful construction in the former paper, and defines and limits the power of Judson, and the rights and interests which Goodyear and his licensees were to receive, and sets forth the conditions on which they were to receive them.

Judson is, for the first time, empowered to grant licenses as Chaffee's attorney, and Goodyear and his licensees are to have licenses through Judson, solely upon the condition of their severally contributing their share of the amount due Judson for services and expenses.

Judson was not empowered to license any others but the Goodyear licensees.

With respect to all other persons, the power to license was annexed to the legal title, which remained in Chaffee. Judson was author-

ized to sue infringers, but he was not required to do so. If the Goodyear licensees should not comply with the condition on which they were to receive a license to use the Chaffee patent, they might be sued as infringers, and Judson could reimburse himself out of the damages, or by compromising the suit by giving them a license on the terms required. Chaffee had a right to impose this or any other condition, and he was interested in having this condition performed, as he would thereby be relieved from his debt to Judson.

VI. So far as regards the rights of Chaffee, Goodyear and his licensees, and Judson, this instrument is a substitute for the provisions respecting the same subject-matter in that of September 5, 1850.

These parties are bound by the facts recited in it, or which are necessarily to be inferred from it.

VII. Neither of these instruments gives Judson any interest in the patent itself, or in the profits of the patent, nor do they give him a right to use it, or to license others to use it, except upon conditions precedent, clearly and distinctly specified. Chaffee intended to give him security for the debt due him, and pointed out the fund from which the debt was to be paid, if the parties named should keep their agreement; and Judson took for his security a mere power to collect his dues out of this fund by selling licenses, or by suing for damages. The only interest which Judson took was in the money which might be produced by licenses or by suit, and to the extent of his claim for money advanced for services and expenses.

VIII. This instrument of November 12, 1851, was also executory, and is governed by the rules of law applicable to contracts executory in their nature, and to powers.

So far as the licenses were concerned, Chaffee was the contracting party on the one part, and Goodyear and his licensees on the other. The contract was not executed until the licensees had complied with the conditions under which they were to have a license, and Chaffee parted with nothing until such performance by them. If they neglected or refused to comply, his right of rescission was perfect.

So far as Judson was concerned, he held merely a power, from the proceeds of the execution of which he was to be paid; and to that extent the power operated as a security, and such power was revocable at any time, upon payment of the amount of the debt.

Powers to sell on mortgages are declared to be irrevocable in terms, but the deed and power together are cancelled by payment of the mortgage debt.

A power taken for security is revocable by the death of the grantor of the power. *Hunt v. Rousmaniere's Executors*, 8 Wheat., 174.



It is also revocable by the party giving it. *Mansfield v. Mansfield*, 6 Conn., 559.

In this case, the principles of the former case are adopted and carried out to their legitimate conclusions.

A power is irrevocable only when there is an express stipulation that it shall be irrevocable, *and* when the agent has an interest in its execution. Both of these circumstances must concur. Story on Agency, sec. 476.

The interest ceased when Judson was offered the money for all his disbursements and services. There is no stipulation in the power of the 12th of November, 1851, that it shall be irrevocable.

IX. If the paper of 5th of September, 1850, be construed to give a license directly to Goodyear and his licensees, upon their paying the expenses and annuity, then such license is revocable if the conditions be not performed.

The instrument contains no words of grant or conveyance known to the common law. There are no covenants which would create an estoppel.

The Goodyear licensees obtained nothing more than a license, not connected with any grant, or made part of any grant. Such a license is revocable at common law. *Thomas v. Lovell*, Vaughan, 351.

"A dispensation or license properly passeth no interest, nor alters nor transfers property in anything, but only makes an action lawful which without it would have been unlawful." *Wood v. Ledbitter*, 13 M. & W., 843.

"A license is in its nature revocable."

X. Hartshorn & Co. were not within the class of persons described in the paper of the 5th of September, 1850, nor in the class to whom Judson was authorized to give licenses by the paper of the 12th of November, 1851.

XI. The question of the performance of the condition of the papers of September 5, 1850, and November 12, 1851, after the papers had been construed by the court, was a question of fact for the jury.

XII. If the jury had found that there was a failure on the part of Judson and of Goodyear and his licensees to perform their part of the agreement of September 5, 1850; that the annuity had not been paid; that the Shoe Associates knew of the non-payment; that Judson was the agent of Goodyear and his licensees in making the paper of 12th of November, 1851, and of the Shoe Associates in all matters relating to the Chaffee patent since its extension; and that there had been an offer in good faith to repay Judson all that had been expended by himself or advanced by the Shoe Associates, on account of

this extended patent,—then, upon these facts, the revocation of the powers given to Judson, and the rescission of those contracts, was proper on the part of Chaffee.

The instrument of revocation, the tender of all sums due to Judson, and the notice to Hartshorn & Co. were sufficient.

XIII. The title did not pass from Chaffee by the contracts of May 23, 1850, September 5, 1850, and November 12, 1851, in connection with the instrument executed between Goodyear and his licensees, dated July 1, 1848, in consideration of Judson's agreement in the paper of September 5, 1850, according to the prayer for instruction to the jury, which is made the subject of exception 1.

XIV. One test of the right of rescission or revocation, is to inquire whether the contract is one that a court of equity would specifically enforce, under the circumstances existing at the time the rescission or revocation is sought to be made.

"The rules of law relating to specific performance, and those applied to the rescission of contracts, although not identically the same, have a near affinity to each other." *Boyce's Executors v. Grundy*, 3 Peters, 210, 216.

The remaining points are omitted.

Mr. Justice NELSON delivered the opinion of the court.

This is a writ of error to the judgment of the Circuit Court of the United States, holden by the district judge in and for the District of Rhode Island.

The action was brought by Day against the defendants below, for an alleged infringement of a patent for the preparation and application of India-rubber to cloths, granted to E. M. Chaffee, August 31, 1836, and renewed for seven years from the 31st August, 1850. The plaintiff claimed to be the assignee of the patent from Chaffee. The defendants sought to protect themselves under a license derived from Charles Goodyear, whom they insisted was the owner, and not Day, of the renewed patent. Goodyear became the owner of the unexpired term of the original patent on the 28th July, 1844, and on the same day granted to certain persons, called "The Shoe Associates," the exclusive use of all his improvements in the manufacture of India-rubber, patented or to be patented, during the term of any patents or renewals which he might own, or in which he might be interested, "so far as the same are, or may be, applicable to the manufacture of boots and shoes."

The defendants claimed a license under the Shoe Associates.

Chaffee, the original patentee, made application to the Commis-

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sioner of Patents, the 22d May, 1850, for the renewal of his patent, in which he states that the then present owners were willing and desirous that it should be renewed, and in that event that they ought to make him further compensation for the invention. And on the next day, 23d May, 1850, he entered into an agreement with Goodyear, in which he stipulated to convey to him the patent, on its renewal for the extended term, in consideration of three thousand dollars.

There seems to have been some agreement or understanding that the then owners of the patent, and their licensees, should be at the expense of the renewal.

William Judson had become interested in one-eighth of the patent in 1846, by an assignment from Goodyear; and in 1848, he, in conjunction with Seth P. Staples, was appointed by Goodyear his attorney and agent, in taking out, renewing, extending, and defending his patents; and a fund was provided by Goodyear for defraying the expenses of these proceedings, and placed in the hands of Judson. By the consent of Goodyear, Judson subsequently became his sole agent and trustee of the fund for the purposes mentioned.

The patent was renewed, in pursuance of the application, on the 30th August, 1850. Soon after this renewal, to wit, on the 5th September, 1850, an agreement was entered into between Chaffee and Judson, which recites the renewal, and that the expenses were large, and also that at the time of the renewal the patent was held by Goodyear for the benefit of himself and his licensees; and, further, that he had agreed with Chaffee, for himself and those using the patent under him, that they would be at the expense of the extension, and make an allowance to him (Chaffee) of \$1,200 per annum, payable quarterly, during the period of the extension; and reciting also that Judson had had the management of the application for the renewal, and had paid, and became liable to pay, the expenses thereof, and had agreed to guarantee the payment of the annuity of \$1,200; and the agreement then provided as follows: "Now, I (Chaffee) do hereby, in consideration of the premises, and to place my patent so that in case of my death, or other accident or event, it may inure to the benefit of said Charles Goodyear, and those who hold a right to the use of said patent, under and in connection with his licensees, according to the understanding of the parties interested, nominate, constitute, and appoint said William Judson my trustee and attorney irrevocable, to hold said patent and have the control thereof, so as no one shall have a license to use said patent or invention, or the improvements secured thereby, other than those who had a right to use the

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same when said patent was extended, without the written consent of said Judson first had and obtained."

At the close of the agreement, Judson stipulates with Chaffee to pay all the expenses of the renewal, and also the annuity of \$1,200; and also to be at all the expense of sustaining and defending the patent; and Chaffee reserves to himself the right to use the improvement in his own business.

This contract was entered into without the privity of Goodyear, and changed materially the terms and conditions of that made by him with Chaffee on the 23d May. He was at first dissatisfied with the change when it came to his notice, but afterwards acquiesced.

The contract continued in operation down to the 12th November, 1851, when a modification of the same took place.

This last contract recites that there was an omission in that of 6th September, in not stating that if the said licensees continued to use the improvements, they should pay their just proportion of the expenses and services in obtaining the renewal, which it was intended they should pay to Judson; and recites also that there was no stipulation on the part of Judson to pay Chaffee \$1,500 per annum, as claimed by him; and it is then agreed that the licensees shall pay their share of the expenses to Judson, as a condition to the granting of a license by him to them; and that, on the payment of such share of the expenses, a license shall be granted to them. And it was further agreed, that Judson should pay Chaffee the \$1,500 per annum; and also that Judson might use Chaffee's name in the prosecution of infringements of the patent, or for any other purpose in relation to the use of it, he holding Chaffee harmless from all costs, &c., and he (Judson) to have all the benefits to be derived from said suits.

It will be perceived, that the only provision in this agreement differing from that of 6th September, in which Chaffee has any interest, is the one providing for an annuity of \$1,500, instead of the \$1,200. All the other provisions are for the benefit of Judson. This annuity was paid down to the 1st December, 1852, when some difficulty arose between Judson and Chaffee, and the payment ceased.

And on the 1st July thereafter, Chaffee undertook, in consequence of this default, to revoke and annul the power and control of Judson over the patent, and to forbid his acting in any way or manner under the agreements of the 6th September and of the 12th November, above referred to; and on the same day, for the consideration of \$11,000, assigned the renewed patent to Day, the plaintiff in this suit. Day, on the 2d July, 1853, gave notice to Judson of the assignment, offering to pay, at the same time, all sums there might be due

him, if any there were, for moneys advanced in procuring the extension of the patent, or in any other way paid for Chaffee on account of said patent. The above is the substance of the case, as appears from the written agreements of the parties in the record. The questions involved turn essentially upon the points—

1. As to the operation and effect to be given to the three agreements which have been referred to, and especially of that of the 6th September, 1850, between Chaffee and Judson; and

2. The force and effect of the attempted rescindment of these agreements by Chaffee, on the 1st July, 1853, on account of the neglect or refusal of Judson to pay the annuity of \$1,500.

1. It is not important to examine particularly the agreement between Goodyear and Chaffee of 23d of May, as that was, in effect, superseded by the one entered into with Judson, the 6th of September, to which Goodyear afterwards assented.

It is important only as leading to the latter agreement, and may therefore assist in explaining its provisions.

By this first agreement, Chaffee bound himself to assign to Goodyear the renewed patent, as soon as it was obtained, for the consideration of \$3,000. Goodyear became thus equitably entitled to the entire interest in the patent during the extended term, and could have invested himself with the legal title on the payment, or offer to pay the three thousand dollars, had he not subsequently acquiesced in the modification of it with Judson. Judson was the owner, jointly with Goodyear, of one-eighth of the patent. He was also the agent and attorney of Goodyear, generally, in his applications for patents, in obtaining renewals, and in the litigation growing out of the business; and was the trustee of a fund provided by Goodyear to meet the expenses. It was, doubtless, on account of this interest of Judson in the improvement, and his general authority from Goodyear in the management of his patent concerns, that led him to enter into the new arrangement with Chaffee, of the 6th September, in the absence of his principal. Goodyear might have repudiated it, and insisted upon the fulfillment of the first agreement. He thought fit, however, after a full knowledge of the facts, to acquiesce; and his rights, therefore, and those claiming under him, must depend upon this second agreement.

In respect to this agreement, whether the title which passed from Chaffee, in the renewed patent to Judson, was legal or equitable, the court is of opinion that the entire interest and ownership in the same passed to him, for the benefit of Goodyear and those holding rights and licenses under him. The instrument is very inartificially drawn,

but the intent and object of it cannot be mistaken. Chaffee, in consideration of the premises, which included the annuity of \$1,200, "and [in his own language] to place my [his] patent so that in case of death, or other accident or event, it [the patent] may inure to the benefit of said Charles Goodyear, and those who hold a right to the use of said patent, under and in connection with his licensees," &c., nominates and appoints "said William Judson my trustee and attorney irrevocable, to hold said patent and have the control thereof, so that no one shall have a license, &c., other than those who had a right to use the same when said patent was extended, without the written consent of said Judson;" and, at the close of the agreement, he reserves the right to use the improvement in his own business. At this time, as we have seen, Judson was the owner of one-eighth of the patent, and was the general agent and attorney of Goodyear in all his patent business transactions. It is apparent that the only interest in the patent left in Chaffee was the right reserved for his own personal use. The annuity and indemnity against the expenses of the renewal were the compensation received by him for parting with the improvement. The contract of the 12th of November has no material bearing upon this part of the case. Most of the provisions were for the benefit of Judson, in relation to the licensees under Goodyear. The only provision important to Chaffee is the stipulation for the increased annuity of \$1,500.

2. Then, as to the attempted rescindment of the contracts. The agreement of 6th of September had been in force from its date down to the 1st of July, 1853, a period of two years and nearly ten months. During all this time, the licensees of Goodyear at the date of the renewal of the patent, and those whom Judson may have granted a license to since the renewal, had a right to use the improvement, and especially the Shoe Associates, referred to in their agreement with Goodyear, 1st of July, 1848. Besides this stipulation with Goodyear, their right was expressly recognized by Chaffee himself, in the agreement with Judson of 6th of September.

The effect of the rescindment as claimed, and which would be necessary to enable the plaintiff to succeed in his action against the defendants, would be to break up the business of these licensees, by divesting them of their rights under this agreement—rights acquired under it from all parties connected with or concerned in the patent, and especially from Chaffee, the patentee, who placed it in the hands of Judson, for the benefit of Goodyear and those holding under him. The effect would also be to deprive Goodyear or Judson, or whichever of them had paid the expenses of obtaining the renewal, of the equiv-

alent for those expenses, except as they might have a personal remedy against Chaffee. To the extent above stated, the agreement of the 6th of September was already executed, and, in respect to parties concerned, the abrogation would work the most serious consequences.

As we have already said, the ground upon which the right to put an end to the agreement is the refusal to pay the annuity of \$1,500 after December, 1852. Judson proposed to Chaffee to resume the payment in June, 1853, which was declined; but we attach no importance to this fact, especially as we are in a court of law. But, in looking into the agreements of the 6th of September, and also the one of the 12th of November, the court is of opinion that the payment of the annuity was not a condition to the vesting of the interest in the patent in Judson, and of course that the omission or refusal to pay did not give to Chaffee a right to rescind the contract, nor have the effect to remit him to his interest as patentee. The right to the annuity rested in covenant, under the agreement of the 12th of November. One of the objects of that agreement was to obtain from Judson this covenant. From the terms and intent of the agreement, the remedy for the breach could rest only upon the personal obligation of Judson, as, by the previous one of the 6th of September, the interest in the patent had passed to Goodyear and his licensees, and no default or act of Judson could affect them. Chaffee chose to be satisfied with the covenant of Judson, without stipulation or condition as it respected the other parties, and he must be content with it.

The cases of *Brooks v. Stolly*, 3 McLean, 526, and *Woodworth v. Weed*, 1 Blatchford, 165, have no application to this case.

The attempt to rescind the contracts, being thus wholly inoperative and void, in the opinion of the court, of course no interest in the patent passed to Day, under the assignment of the 1st of July, 1853.

Evidence was given on the trial in the court below, for the purpose of proving that the agreement of the 6th of September was procured from Chaffee by the fraudulent representations of Judson, which was objected to, but admitted.

The general rule is, that, in an action upon a sealed instrument in a court of law, failure of consideration, or fraud in the consideration, for the purpose of avoiding the obligation, is not admissible as between parties and privies to the deed; and more especially where there has been a part execution of the contract. The difficulties are in adjusting the rights and equities of the parties in a court of law; and hence, in the States where the two systems of jurisprudence prevail, of equity and the common law, a court of law refuses to open the question of fraud in the consideration, or in the transaction out of

## Opinion of the court.

which the consideration arises, in a suit upon the sealed instrument, but turns the party over to a court of equity, where the instrument can be set aside upon such terms as, under all the circumstances, may be equitable and just between the parties. A court of law can hold no middle course; the question is limited to the validity or invalidity of the deed.

Fraud in the execution of the instrument has always been admitted in a court of law, as where it has been misread, or some other fraud or imposition has been practiced upon the party in procuring his signature and seal. The fraud in this aspect goes to the question whether or not the instrument ever had any legal existence. 2 J. R., 177; 13 Id., 430; 5 Cow., 506; 4 Wend., 471; 6 Munf., 358; 2 Rand., 426; 10 S. & R., 25; 14 Id., 208; 1 Ala., 100; 7 Mo., 424; 4 Dev. & Bat., 436; C. and H., Notes, part 2, p. 615, note 306, ed. Gould & Banks, 1850.

It is said that fraud vitiates all contracts, and even records, which is doubtless true in a general sense. But it must be reached in some regular and authoritative mode; and this may depend upon the forum in which it is presented, and also upon the parties to the litigation. A record of judgment may be avoided for fraud, but not between the parties or privies in a court of law.

The case in hand illustrates the impropriety and injustice of admitting evidence of fraud to defeat agreements of the character in question in a court of law. We have a record before us of 1,055 closely-printed pages of evidence submitted to the jury, and a trial of the duration of some six weeks. Goodyear and his licensees had acquired vested and valuable rights under the agreements in this patent, and who were in no way privy to, or connected with, the alleged fraud, nor parties to this suit; and yet it is assumed, and without the assumption the fraud would be immaterial, that the effect of avoiding the agreements would be to abrogate these rights. They had been in the enjoyment of them for nearly three years, and may have invested large amounts of capital in the confidence of their validity. They were derived from Chaffee himself, the patentee of the improvement. A court of equity, on an application by him set to aside the agreements on the ground of fraud, would have required that these third parties in interest should have been made parties to the suit, and would have protected their rights, or secured them against loss, if it interfered at all, upon the commonest principles of equity jurisprudence.

Some slight evidence was given in the court below upon the question whether the agreement of the 6th of September was sealed at



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the time of the execution. But the instrument produced was sealed, and is recited in the subsequent agreement of the 12th of November as an agreement signed and sealed by the parties.

A question was also made as to the authority of the Shoe Associates to grant a license to the defendants. But they held under Goodyear the right to the exclusive use of the improvement for the manufacture of boots and shoes. They were competent, therefore, to confer the right upon the defendants. Besides, the point is not material in the view the court have taken of the case, as upon that view no interest in the patent vested in the plaintiff under the assignment from Chaffee.

It will be seen, by a reference to the bill of exceptions, that upon our conclusions in respect to several points raised in the case, the rulings in the court below were erroneous, and consequently the judgment must be reversed, and a *venire de novo* awarded.

## ISAAC BROWN, APPELLANT, v. JOSEPH P. SHANNON ET AL.

(20 Howard, 55.)

1. Where a bill is filed to enforce the specific execution of a contract in relation to the use of a patent-right, this court has no appellate jurisdiction, unless the matter in controversy exceeds two thousand dollars.
2. The jurisdiction, where the bill is founded upon a contract, differs materially from the jurisdiction on a bill to prevent the infringement of the monopoly of the patentee, or of those claiming under him by legal assignments, and to protect them in their rights to the exclusive use.
3. The penalty of the bond taken, when an injunction is awarded, is no evidence of the amount or value in dispute.

THIS was an appeal from the Circuit Court of the United States for the District of Maryland.

The case is stated in the opinion of the court.

It was argued by *Mr. Schley*, for the appellant, and submitted on a printed argument by *Mr. Latrobe* and *Mr. Gwinn*, for the defendants.

Mr. Chief Justice TANEY delivered the opinion of the court.

This is an appeal from the decree of the Circuit Court for the District of Maryland.

The bill was filed by Joseph P. Shannon & Company, Gelston & Matthews, Lapouraille & Maughlin, and Griffiss & Cate, who composed four different partnership firms in the city of Baltimore, sep-

## Opinion of the court.

arately engaged in the business of planing, who all joined in the bill of complaint against Brown, the appellant, praying that he might be enjoined from the use of certain planing-machines, mentioned in the bill, in the city of Baltimore. Upon the hearing, a perpetual injunction was granted accordingly, and from that decree this appeal was taken.

From the manner in which the bill is framed, there is some difficulty in determining whether the complainants are seeking the aid of this court to prohibit the infringement of a patent-right assigned to them, or to enforce the specific execution of two contracts with the appellant, exhibited with the bill; for the right claimed under the patent, and the right claimed under the contracts, are so mingled together in the statements and allegations of the complainants, as to leave some doubt upon that point. And the first question, therefore, for this court to determine is, upon which of these two grounds does the bill seek for relief? The jurisdiction of the Circuit Court in the one case is materially different from its jurisdiction in the other; and while this court can exercise no appellate power in a case arising under contracts like those exhibited, unless the amount or value of the matter in controversy exceeds two thousand dollars, it may yet lawfully exercise its appellate jurisdiction when a far less amount is in dispute, if the party is proceeding, either at law or in equity, for the infringement of a patent-right to which he claims to be entitled. Upon looking, however, carefully into the bill, we think it must be regarded and treated as a proceeding to enforce the specific execution of the contracts referred to, and not as one to protect the complainants in the exclusive enjoyment of a patent-right. It states that three of the partnership firms named as complainants—that is to say, Joseph P. Shannon & Company, Gelston & Matthews, and Lapouraille & Maughlin—were, by regular assignments, entitled to the exclusive use of Woodworth's planing-machine in the State of Maryland, east of the Blue Ridge; that the appellant had used these machines in the city of Baltimore without any right derived from the patentee, and that in consequence of this infringement of their rights various suits and controversies had taken place between them and Brown, who claimed the right to use the machines in question as the assignee of a patent of Emmons. The bill then proceeds to state, that in order to put an end to these controversies and suits, these appellees and the appellant entered into the contract of the 19th of January, 1853, which is exhibited with the bill.

By this contract, the portion of the appellees of which we are now speaking, and the appellant, agreed that each of the said three part-

nership firms and the appellant should have the right to use the Woodworth patent at one establishment, anywhere within the territorial limits above mentioned, not exceeding five machines at such establishment; and that each of the said parties should also have the right to use Emmons' patent.

There are other stipulations in this agreement, which it is not material to state for the purposes of this opinion.

The bill further states that Brown afterwards, on the 15th of June, 1853, assigned to Griffiss & Cate, the other complainant, all his right to use the Woodworth patent, which right he had derived from the contract before mentioned, and also the right to use the Emmons patent, the right to which he had derived from the administrator of Emmons. This contract states that the assignment was made in consideration of fifteen hundred dollars paid the appellant by Griffiss & Cate. And the complainants allege that after this assignment Brown continued to use the said five machines in his establishment in Baltimore, although he had no right to do so, as they were all Woodworth's planing-machines; and that he is not only a wrong-doer in using a patented invention without a license, and as such liable to be restrained by a court of equity, but that such use is a fraud upon the parties to each of the two contracts into which he had entered as above stated; that the object of the contract of January 19, 1853, was to restrain the use of the Woodworth machine and the Emmons machine, so far as that right was to be used, to four establishments in the city of Baltimore, with the limited number of machines in each, and that the use of them by Brown, after he had substituted Griffiss & Cate in his place, was a fraud upon this contract, from the binding operation of which he could not withdraw himself, and a fraud also upon his contract with Griffiss & Cate. And the gravamen of the bill, and the ground upon which relief is sought, is summed up, in the paragraph immediately preceding the prayer for relief, in the following words:

"And your orators are further advised that the misconduct of the said Brown in the premises is a fraud upon the parties to the agreement of the 19th of January, 1853, as well as upon the parties to the agreement of the 15th of June, 1853, which it is the peculiar province of a court of equity to restrain."

It is to prevent the fraudulent violation of these contracts, therefore, that the complainants seek the aid of the court, and ask for an injunction; and it being a proceeding founded on a contract between the parties, this court has no appellate power, unless the matter in controversy is of the value of more than two thousand dollars. Now,

the matter in controversy is the right of the appellants to use these five machines while the Woodworth patent continued, that is, until the 29th of December, 1856.

But it appears by the record that Brown sold this right to Griffiss & Cate for \$1,500. He admits in his answer that he sold and assigned it for that sum; nor does he suggest that it was worth more. The establishment of Griffiss & Cate, like that of the appellant, was in the city of Baltimore. And if \$1,500 was the just value of the right in controversy on the 15th of June, 1853, there is no reason for supposing that it was worth more on the 10th of October in that year, when this bill was filed, or at any time since. On the contrary, the period for the duration of the right under the contract was daily diminishing as the termination of the patent was approaching, and a diminution on the value of the right would be a natural and necessary consequence. It is evident, therefore, that the value of the matter in controversy is not sufficient to give appellate jurisdiction to this court.

It has, however, been suggested, in the argument at the bar, that the value may be estimated by referring to the penalty of the bond taken by the Circuit Court when the injunction was granted. But this rule would be entirely too vague and uncertain for judicial purposes. It is the practice of all courts, in taking bonds of this description, to prescribe a penalty more than enough to cover all possible damages which the respondent may sustain by reason of the injunction. There was nothing before the Circuit Court when the penalty in this case was prescribed but the bill of the complainants; and although the bill disclosed a controversy where the matter in dispute was worth in the market but \$1,500, yet when the answer came in, and testimony was taken, it might show that the matter in dispute was of far greater value. The court could not foresee whether this would be the case or not, and hence the necessity and propriety of prescribing a penalty that would cover all possible contingencies. The respondent, however, as we have said, admits that he sold the privilege now in dispute for the sum mentioned in the bill, and does not say that it was worth more, or was of greater value in his hands than in those of Griffiss & Cate. The sum mentioned in the bill, and for which the privilege in question was sold by the appellant, must therefore be taken as the true value of the matter in controversy, and being less than \$2,000, whatever errors may be apparent in the proceedings and decree of the court below, we have yet no power under the act of Congress to revise and correct them, and the appeal must be dismissed for want of jurisdiction in this court.

## WILLIAM B. DEAN, APPELLANT, v. NATHAN MASON ET AL.

(20 Howard, 198.)

1. In suits for the infringement of a patent-right, the rule of damages is the amount which the infringer actually realized in profits,—not what he might have made by reasonable diligence.
2. After a bill is taken *pro confesso* in the Circuit Court, a motion to allow an answer to be filed is addressed to the discretion of the court; and from a refusal so to do, an appeal does not lie to this court.
3. A motion to dismiss the complainant's bill, upon the ground that he had parted with his interest, was properly overruled, because such assignment was not made until after the time when the computation of profits ended.

THIS was an appeal from the Circuit Court of the United States for the District of Rhode Island.

The bill was filed by Nathan Mason, of the city of Providence, in said district, planer of boards; Charles D. Gould, of Albany, in the State of New York; William W. Woodworth, of Hyde Park, in the Northern District of New York, as he is administrator of William Woodworth, late of the city of New York, gentleman, deceased, and as he is grantee of certain exclusive privileges under and pursuant to an act of Congress, as is hereinafter fully set forth; James G. Wilson, formerly of the city of Philadelphia, and now of Hastings, in the State of New York, gentleman; and Richard Borden and Jefferson Borden, both of the town of Fall River, and District of Massachusetts, against Dean, of the city of Providence.

The facts of the case are stated in the opinion of the court.

It was argued by *Mr. Jenckes*, for the appellant, and by *Mr. Payne*, for the appellees, upon which side there was also a brief filed by *Mr. B. R. Curtis* and *Mr. Payne*.

*Mr. Jenckes* made the following points:

1st. The rule laid down by the court in both decretal orders, for the computation of profits, is erroneous. It is not in accordance with the prayer of the bill, or with the rule of law in such cases, as established by this court. The rule should have been to take an account of the actual gains and profits of the appellant, during the time his machines were in operation. This point has received an express adjudication in this court.

"In a suit in equity, for an injunction and account of profits of a patented machine, the defendant is accountable only for what profits he *actually made*,—not for what, by diligence and skill, he might have received." *Livingston et al. v. Woodworth et al.*, 15 How., 546.

2d. The court below was in error in refusing leave to the defendant to answer on the motion to set aside the decree *pro confesso*, and allow the defendant to answer.

3d. The court below should have dismissed the complainants' bill, upon the proof that they had parted with all their interest in the subject-matter of the suit.

4th. The court below was in error in refusing leave for the filing of a supplemental bill in favor of Baker & Smith.

They had clearly succeeded to the complainants' title, and their proposed bill contains averments, verified by their oaths, which entitled them to the relief prayed for. The defendant below had started his machines, and was using them to the injury of the owners of the patent. No process of contempt could be moved for by the complainant Mason, for he had parted with his interest. The proposed parties complainant, Baker & Smith, were entitled to the benefit of what had been done on the title which they had acquired. Story Eq. Pl., secs. 339, 349, 351; Calvert on Parties to Suits in Eq., pp. 99, 100.

The fact that an interlocutory decree had been entered upon Mason's title did not bar his grantees who had purchased that title. A supplemental bill may be filed as well after as before a decree. Story Eq. Pl., sec. 338. In this case it was proposed to be filed "in aid of the decree, that it might be carried fully into execution."

If the supplemental bill had been filed, the defendant below would have been entitled to answer both the original and supplemental bills, and his full defense to this suit would thus have been made to appear. The hearing upon the decree prayed for would have necessarily led to an inquiry into the propriety of the decree sought to be enforced; and the court below could then have followed the decision of this court in *Bloomer v. McQuewan*, and dismissed the bill, as the Circuit Court in the case of *Perkins v. Fourniquet* reversed its interlocutory decree after the adverse decision of this court in a similar case. See 1 Barb. Ch. R., 363, *et seq.*

5th. These questions are all proper to be discussed on appeal. This point has received the direct adjudication of this court.

"An appeal in equity brings up all the questions decided in the court below to the prejudice of the appellant." *Buckingham v. McLean*, 13 How., 150.

The counsel for the appellees made the following points:

1st. With respect to the motion to strike out the decree *pro confesso*, and allow the defendant to answer.

## Argument for the appellees.

The decision of the motion to open the decree and allow an answer to be filed, even when made at the proper term, rests in the sound discretion of the Circuit Court, and is not subject to reëxamination here. *Wylie v. Coxe*, 14 How., 1, is directly in point. If further authorities are needful, *The Marine Insurance Company v. Hodgson*, 6 Cranch, 206, where the refusal of the Circuit Court to allow a plea to be filed; *United States v. Evans*, 5 Cranch, 280; and *Welch v. Mandeville*, 7 Cranch, 192, where its refusal to reinstate the plaintiff were in question, show that this court cannot review such decisions of the Circuit Court.

A reference to the nineteenth rule for the practice of the Circuit Courts in equity will show how entirely the allowance or refusal of this motion, if made in time, rests in the discretion of the Circuit Court.

2d. As to the motion to dismiss the bill.

Such a motion, based upon facts *dehors* the record, was wholly irregular, and could not be allowed.

And it may be added that, even if regular, and the facts upon which it was alleged to rest had been shown, they constituted no objection to a final decree.

A transfer of the title by each of the plaintiffs, *pendente lite*, cannot affect the rights of the defendant. *Eades v. Harris*, 1 Young and Col. N. R., 230. Certainly it could not do so in this case; for the allegation is, that Mason parted with his title in April, 1852, (see page 122,) and the account of the profits comes down only to the 29th of August, 1851. See pages 56, first paragraph, and 101, fourth paragraph.

3d. As to the interlocutory decree, by which the cause was referred to the master to take an account.

We submit that the appellant cannot now take an objection to that decree.

The nineteenth rule expressly provides, that a decree founded upon an order taking a bill for confessed, shall be absolute at the close of the term at which the decree is entered. If this defendant, who admits that he was actually cognizant of all the proceedings, and that he intentionally allowed them to take place, intended to object to a direction given to the master, he should have appeared and objected then, before the proceedings were had in the master's office. At all events, he might, and should, when the master's report came on for confirmation, have taken his objection. Having suffered all these opportunities to pass, he cannot now, for the first time, take the objection in the appellate court.

But if this court should think otherwise, we submit that whatever error existed in the directions given to the master, it was cured by the proceedings which actually took place.

The appellant rendered an account to the master of his receipts, and of the allowances he claimed. His account of his actual receipts was not questioned, and was taken by the master as the basis of his report. The dispute arose upon the allowances, the principal items of which were rents, fuel, labor, carting, oil, and repairs. If the appellant had carried on the business of planing only, these items would have been capable of being distinctly vouched and liquidated. But in point of fact, his planing business was carried on upon the same premises, and by the same power and labor, which were used for much other machinery. The expenses of the planing business were therefore not liquidated and distinct items.

They were necessarily to be arrived at only by estimates, based on a view of the whole business, and of the proportionate cost of this part of it. The master, therefore, went into an examination of the entire cost of the several items of expense, and of the just proportion of it which belonged to the planing business.

It is difficult, without a perusal of both his reports, and of the exceptions taken to them, and of the decrees of the court thereon, to obtain a correct view of his action; but we submit that such a perusal will show that no speculative rule of profits was applied by him; that estimates were not resorted to, save in reference to the expenses where they were absolutely necessary; and that the results of the proceedings before him were these: that the appellant was charged only with what he admitted he actually received, and was allowed all which, upon a fair view of the evidence, it appeared he had actually expended in this part of his business. By reference to the items stated by the master at the foot of page 55, and an examination of the preceding part of the report, in which he shows how he arrived at each of those items, and also by reference to his subsequent report, page 98, as to some of them which he had been required to reexamine, we submit it appears that the balance which he reported was a balance of actual profits; and that therefore it became wholly immaterial that he might have found possible profits. So the appellant seems to have considered; for at no time, nor in any form, did he object that possible profits had been charged.

In *McMicken v. Perin*, 18 How., 507, where a bill was taken *pro confesso*, and at the same term a decree of reference was made, it was objected that the master had not allowed to the appellant the amount *admitted by the bill to be due to him*. But as no exception had



been taken to the master's report, this court refused to reverse the decree. Certainly, it is not more apparent on this record than it was on that, that the master's report is erroneous; and if an exception was indispensable then, why not here?

Mr. Justice McLEAN delivered the opinion of the court.

This is an appeal from the Circuit Court for the District of Rhode Island.

A bill was filed in this case by Mason *et al.*, claiming to be owners of a territorial right to the exclusive use of the Woodworth patent for planing boards, charging the defendant with using three of the machines in the city of Providence, in violation of the complainants' right. The suit was commenced the first year of the extension of that patent by Congress, and the three machines which were sought to be enjoined, were those used during the first extended term of the patent, under a license from its owners. A preliminary injunction was granted.

At the June Term, 1851, of the Circuit Court, a decree *pro confesso* was entered against the defendant, and he was perpetually enjoined. The case was referred to a master, to take an account of the profits or income derived by the defendant, or which by reasonable diligence might have been realized by him, from the use made of the three machines.

Exceptions were taken to the first report of the master, and it was referred to him again under the same instructions.

Before the second report of the master, a motion was submitted to the court by the defendant to set aside the decree *pro confesso*, and for leave to answer the bill, on the ground that the Supreme Court, in the case of *Bloomer v. McQuewan et al.*, 14 Howard, 539, had held, in a case similar to this, that the licensee's privilege continued under the extension of the patent by Congress, the same as under prior extensions; but the court refused the motion; consequently the appeal does not bring before us any question under the last extension of the patent.

At the November Term, 1854, the master made his second and final report, in which he stated the sum of \$2,566.46 as the amount of profits which the defendant, by reasonable diligence, might have derived from the use made by him of such patented machines, and the sales of the products thereof, during the period covered by the suit.

The decree was entered, on the report of the master, for the estimated amount of profits which the defendant, with reasonable dili-

## Opinion of the court.

gence, might have realized,—not what, in fact, he did realize. This instruction was erroneous. The rule in such a case is the amount of profits received by the unlawful use of the machines, as this, in general, is the damage done to the owner of the patent. It takes away the motive of the infringer of patented rights, by requiring him to pay the profits of his labor to the owner of the patent. Generally, this is sufficient to protect the rights of the owner; but where the wrong has been done under aggravated circumstances, the court has the power, under the statute, to punish it adequately, by an increase of the damages.

The injury done is measured by the supply of planed boards thrown upon the market, which lessens so much the demand. But if the liability of an infringer is to be increased by an estimate of the work he might do with great diligence, he will be more likely to exceed the estimate than fall below it. This policy would increase the evil of the wrong-doer, without benefit to any one. In *Livingston et al. v. Woodworth et al.*, 15 How., 546, the true rule of damages in such cases is laid down.

It is contended the court erred in refusing leave to the defendant to answer, on the motion made at June Term, 1853.

A motion to amend, or file an answer after default, is generally addressed to the discretion of the court. Under some circumstances, the court, for the purposes of justice, will go great lengths in opening a default and allowing a plea to be filed. But this is done or refused by the court in the exercise of its discretion, which is not subject to the revision of this court.

In the case before us, the motion to file an answer was not made until after the decree *pro confesso* had been entered, and a reference made to a master for an account. This was more than three years after the bill was filed. Whether the Circuit Court refused the motion on the ground of delay, or a want of merits in the cause assigned, does not appear; but it is sufficient to say, that on such grounds the decree cannot be reversed.

The motion to dismiss the complainants' bill, upon proof that they had parted with all their interest in the subject-matter of the suit, was properly overruled. The allegation is, that Mason parted with his title in April, 1852, and the account of the profits is brought down only to the 29th of August, 1851. The right asserted in this action was not affected by the conveyance of Mason to Baker & Smith.

The refusal of the Circuit Court to permit a supplemental bill to be filed by Baker & Smith, was, under the circumstances, a matter of discretion in the court; and it affords no ground for the reversal

## Statement of the case.

of the decree. It is not perceived what interest these assignees could have in a suit for an infringement of the patent before their right accrued; and any attempt to make them parties, with the view to benefit the defendants in the pending suit, was unsustainable.

For the reasons assigned, the decree for damages must be reversed, at the costs of the defendants in error, as founded on an erroneous estimate; and the cause is remanded to the Circuit Court, with instructions to enter a decree for the amount of the profits realized by the defendant from the wrongful use of the patent.

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EDWIN M. CHAFFEE, TRUSTEE OF HORACE H. DAY, PLAINTIFF IN ERROR,  
v. NATHANIEL HAYWARD. HORACE H. DAY, PLAINTIFF IN ERROR,  
v. NATHANIEL HAYWARD.

(20 Howard, 208.)

1. By the judiciary act of 1789, no civil suit shall be brought against an inhabitant of the United States by an original process in any other district than that whereof he is an inhabitant, or in which he shall be found at the time of serving the writ.
2. This provision of law is not changed by any subsequent process act, or by the law giving jurisdiction to Circuit Courts in patent cases, without regard to citizenship.
3. Therefore, where a suit was commenced for an infringement of a patent-right, and process was served by attaching the property of an absent defendant, this was not sufficient to give the court jurisdiction.
4. The defect of an irregular citation (being signed by the clerk of the court, and not by the judge who allowed the writ of error) is cured by an appearance in this court; so that a motion to dismiss the writ, when made at the term succeeding that at which the appearance was entered, comes too late.

THESE cases were brought up by writ of error from the Circuit Court of the United States for the District of Rhode Island.

At an early day of the term, *Mr. Pitman*, counsel for the defendant in error, moved to dismiss the writs of error, upon the ground stated below, and filed the following affidavit in support of the motion:

*Supreme Court of the United States.*

[No. 51. December Term, 1857.]

EDWIN M. CHAFFEE, (Trustee of Horace H. Day,)	}
Plaintiff in Error,	
v.	
NATHANIEL HAYWARD.	

The defendant in error in this cause moves that this cause be dismissed, the citation herein having been signed by the clerk of the

## Statement of the case.

Circuit Court, and not by the judge, as required by law. By his attorney.

JOSEPH S. PITMAN.

I, Joseph S. Pitman, of the city and county of Providence, and State of Rhode Island, &c., attorney at law, on oath say, that I am and have been associated with Charles S. Bradley, Esq., in the defense of the above cause; that he is the junior counsel in said cause; that he left the city of Providence for Europe on the 1st or 2d day of December, 1856; that we had no consultation respecting the management of said cause before his departure, Mr. Bradley expecting to return by the 1st of March, 1857; that after his departure I caused an appearance to be entered in said cause, and did not file a motion for the dismissal of said cause at the last term, because I did not wish to decide on the expediency of that motion without consultation with him; that I expected he would return in season for such consultation, either before the court adjourned, or that I should have opportunity to make that motion after consultation with him at an adjourned term of this court, which I supposed would be held as at the December Term, 1856; that, to my surprise, this court adjourned about the 7th day of March, and the opportunity was lost, as Mr. Bradley did not return to this country until the 24th of March, 1857.

JOSEPH S. PITMAN.

## RHODE ISLAND DISTRICT,

*Clerk's Office, Circuit Court of the United States.* } ss:

On this 19th day of December, A. D. 1857, came the above-named Joseph S. Pitman, and made oath that the foregoing statements are true. Before me.

Witness my hand and official seal, at Providence.

[SEAL.]

HENRY PITMAN,

*Clerk Circuit Court U. S., R. I. Dist.*

Upon which motion Mr. Chief Justice TANEY delivered the opinion of the court.

In this case, a judgment in favor of the defendant in error was rendered in the Circuit Court of the United States for the District of Rhode Island, at its June Term, 1856. The plaintiff sued out a writ of error on the 27th of October, 1856, returnable to the December Term of this court then next following; but the citation to the defendant was signed by the clerk of the court, and not by the judge who allowed the writ of error.

In pursuance of this writ of error, the record was filed here and the case docketed on the 24th of November, 1856; and on the 4th of December the defendant appeared by counsel in this court.

## Statement of the case.

A motion has been made at the present term to dismiss the case; because the citation is signed by the clerk, and not by the judge.

The citation is undoubtedly irregular in this respect, and the defendant in error was not bound to appear under it. And if a motion had been made at the last term, within a reasonable time, to dismiss the case upon this ground, it would have been dismissed. But the appearance of the party in this court, without making a motion to dismiss during the first term, is a waiver of any irregularity in the citation, and is an admission that he has received notice to appear to the writ of error. This point was decided in the cases of *McDonogh v. Millaudon*, 3 How., 693; *United States v. Yulee*, 6 How., 605, and *Buckingham et al. v. McLean et al.*, 13 How., 150. And these cases have been recognized and affirmed in the case of *Carroll et al. v. Dorsey et al.*, decided at the present term.

Indeed, any other rule would be unjust to a plaintiff in error, and is not required for the protection of the defendant. The latter is not bound to appear, unless he is legally cited, except for the purpose of moving to dismiss. He knows, or must be presumed to know, whether the notice which the law requires has been served on him or not. And if the objection is made at the first term, the plaintiff, by a new writ and proper citation, might bring up the case to the succeeding term. But if the defendant does not, by motion at the first term, apprise him of the irregularity of his proceeding in this respect, and of his intention to take advantage of it, the plaintiff is put off his guard by the defendant's appearance; and if the motion is permitted at the second term, he will be delayed an entire year in the prosecution of his suit, whenever it is the interest of a defendant in error to delay and harass his adversary.

An affidavit has been filed by one of the counsel for the defendant in error, stating that he is the junior counsel in the case, and that he did not make the motion at the last term, because the senior counsel was absent in Europe, and the deponent did not wish to decide on the expediency of the motion to dismiss without consulting him; that he expected him to return before the term ended; but the court adjourned sooner than he anticipated, and the senior counsel did not return until the court had finally adjourned to the next term.

The facts stated in this affidavit cannot influence the decision of the motion. The absence of one or of all the counsel employed by one party, in pursuit of other business, furnishes no ground for delaying a case in this court, without the consent of the adverse party.

The motion comes too late, and is therefore overruled. .

DAY	} No. 52.
v.	
HAYWARD.	

The motion to dismiss in this case stands on the same ground with that of Chaffee, trustee of *Day v. Hayward*, just disposed of; and must, for the reasons assigned in that case, be also overruled.

When the case came up for argument, it was submitted on printed argument by *Mr. Jenckes*, for the plaintiff in error, and argued orally by *Mr. Bradley* and *Mr. Pitman*, for the defendant.

*Mr. Jenckes* made the following points:

*Point I.* The Circuit Court for the District of Rhode Island, having jurisdiction of the subject-matter, may issue its process in the same form, and the process itself may be served in the same manner as process issuing from the Supreme Court of that State for any cause of action within its common-law jurisdiction. Process act of May 8, 1792, sec. 2, Stats. at Large, I, 276.

If the service was good by the laws of that State as they were at the date of the passage of the process act, then it is good under the laws of the United States.

1. The form of the writs in these cases and the modes of proceedings to bring the defendant before the court, were strictly in accordance with the law of Rhode Island. Public Laws of Rhode Island, Digest of 1844, pp. 110, 113, 115.

The statute law of Rhode Island regulating attachments on original writ was the same in 1789 as in 1855. See Digest of 1767, p. 12; Digest of 1798, p. 201. In all the statutes authorizing attachments of personal property, the same provision is found which is contained in the Digest of 1844, p. 113, sec. 3: "When any attachment is made in manner aforesaid, the same shall be sufficient to bring the cause to trial." Neither in the case of attachment of personal property nor of real estate (p. 115, sec. 11) is there any provision for personal service on the defendant. In the case of personal estate, a copy of the writ must be left at the defendant's usual place of abode, (p. 113, sec. 3,) and in the case of real estate, with the person in possession of the land, and with the clerk of the town where the land lies. P. 115, sec. 11. Such service (p. 113, sec. 3) is expressly declared sufficient to bring the cause to trial. In case of real estate, the execution runs against the property attached. P. 11, sec. 115.

2. The above-cited statutes of Rhode Island show that the service of the process in a case in the Supreme Court of that State, made in the same manner as in this case, would have been sufficient to com-

## Argument for the plaintiff in error.

pel the attendance of the defendant, for the purpose of giving that court jurisdiction of the cause, and to form the basis of a judgment by default in case of his non-appearance.

*Point II.* The eleventh section of the judiciary act of 1789 does not prohibit the taking of jurisdiction over this cause.

The provisions of that section apply to the cases of jurisdiction founded on the citizenship of the parties. There is no reference in that section to suits at common law, in which the Circuit Courts have jurisdiction over the parties by reason of their exclusive jurisdiction over the subject-matter. Most of the cases decided under that statute were cases where the jurisdiction depended solely on the citizenship of the parties, and were within the letter of the prohibition. *Picquet v. Swan*, 5 Mason, 561; *Richmond v. Dreyfous*, 1 Sumner, 131; *Toland v. Sprague*, 12 Peters, 300.

The case of *Day v. The Newark India-Rubber Manufacturing Company*, 1 Blatchford, 628, was rightly decided, inasmuch as the mode of proceeding adopted in the commencement of that suit had not been adopted by the Circuit Court in New York; and it is submitted that it was not necessary to construe the eleventh section of the judiciary act as extending to a class of cases not referred to in that statute, and in which the jurisdiction does not depend on citizenship.

It is submitted that the Circuit Court in Rhode Island takes jurisdiction of cases under the Patent Laws, in the same manner that the Supreme Court of that State takes jurisdiction of any transitory action, and may use the same process to compel the appearance of the defendant that could have been used by the State court at the date of the passage of the process act.

An objection to this view, taken by Mr. Justice Story, in *Picquet v. Swan*, is that the process act was not intended to enlarge the jurisdiction of the Circuit Courts as defined by the judiciary act. This objection is not tenable in a patent cause, because the jurisdiction of the court is enlarged by the Patent Laws, and the process acts are to be applied for the purpose of carrying into effect the jurisdiction so conferred, as well as that founded on citizenship.

*Point III.* This is a case of attachment of specific property, real and personal, which, by the Rhode Island statute at the date of the process act, is made a sufficient service to bring the cause to trial, and therein differs from all the cases decided under the eleventh section of the judiciary act, which were cases of foreign attachment. In *Picquet v. Swan*, there was an attempt to attach the real estate of the defendant, but this attempted service was declared, by Judge Story, "defective and nugatory." The statute of Rhode Island in effect

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declares that a defendant is to be found in that State for the purposes of the jurisdiction of its courts, by his visible personal and real property, which can be seized and levied on by the sheriff. The decisions of the courts of the United States, in cases where the jurisdiction rests exclusively on citizenship, declare that a defendant is not found in a district where one of his debtors resides. There is no conflict in maintaining both propositions.

If specific property cannot be attached when the owner resides out of the district, then an assignee under the bankrupt laws would be deprived of his remedy against a debtor of the bankrupt, in the Circuit Court of the district where his property might be found, although that court has jurisdiction of the subject-matter of the suit.

So, also, it would be impossible to commence a suit at law against an American residing abroad for infringing a patent for a product by sales in this country, although he might have here warehouses full of goods.

*Point IV.* If the dictum in *Toland v. Sprague*, "that even in case of a person being amenable to process *in personam*, an attachment against his property cannot be issued against him, except as a part of or together with process to be served upon his person," is to be established as a rule for the service of process from the courts of the United States in all cases, then it is not possible to obtain security for a debt by attachment on original process from the Circuit Court in the District of Rhode Island.

An attachment cannot be made on original writ if the debtor be within the marshal's precinct. He can attach goods and chattels only when he "cannot find the body of the defendant within his precinct," (Digest of 1844, p. 113, sec. 3,) and real estate can be attached only when "the defendant's body or personal estate cannot be found within the State." P. 115, sec. 11; Digest of 1857, pp. 438, 439, secs. 4, 5, 15. No provision is made in either case for personal service on the defendant. A copy of the writ is to be left at his last and usual place of abode, if he has any in the State, and if not, notice is to be given by advertisement. But the form of the writ is such that if personal service can be made, no attachment can be made; and when an attachment is made, no personal service is required or expected.

Many judgments have been rendered in the Circuit Court of Rhode Island in suits commenced by attachment against citizens of Rhode Island who have been absent, in the belief that the process of that court was to be served like the process of the State courts, and with like effect. Property has been sold, and titles to real estate have passed, upon sales made on executions issued on judgments obtained



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by default. A decision against the validity of such attachments would not only unsettle the titles to property thus acquired, but would deprive suitors in the Circuit Court of the United States for that district of the most valuable portion of their remedial process against their debtors.

The counsel for the defendant in error referred to the following authorities:

No civil suit can be brought in a Circuit Court against the defendant in any district whereof he is not an inhabitant, or is not found at the date of the alleged service of the writ. Judiciary Act of 1789, 1 Stats. at Large, p. 79, sec. 11; *Hollingsworth v. Adams*, 2 Dallas, 396; *Pollard v. Dwight*, 4 Cranch, 424; *Picquet v. Swan*, 5 Mason, 35, 48, 50; *Richmond v. Dreyfous*, 1 Sumner, 131, 132; *Harrison et al. v. Rowan et ux*, 1 Pet., 489; *Toland v. Sprague*, 12 Pet. 300, 328, 330; *Com. and R. R. Bank of Vicksburg v. Slocumb et al.*, 14 Pet., 60; *Levy v. Fitzpatrick*, 15 Pet., 171; *Louisville R. R. Co. v. Letson*, 2 How., 556, 557; *Herndon v. Ridgway*, 17 How., 424; *Sadlier v. Fallon*, 2 Curtis, 579, 581.

The law has been equally well settled in relation to service of process in patent suits. *Horace H. Day v. The Newark India-Rubber Manufacturing Company*, 1 Blatchf., 629; *Saddler et al. v. Hudson et al.*, 2 Curtis, 6.

Mr. Justice CATRON delivered the opinion of the court.

The question of law decided below, and which we are called on to revise, arises on the following facts: On the 22d day of October, 1855, the plaintiff in error sued out a writ in the Circuit Court of the United States for the Rhode Island District, against Nathaniel Hayward, styling him as "of Colechester, in the State of Connecticut, commorant of Providence, in the State of Rhode Island," for the recovery of damages alleged to have been sustained by the plaintiff in error, by reason of an alleged infringement of a patent-right claimed by said plaintiff.

On the same day, the marshal of the Rhode Island District made return on the writ, that "for want of the body of the within defendant to be by me found within my district, I have attached," &c., (enumerating certain real estate lying in the city of Providence, in the State of Rhode Island,) and a still further return of having made further service of the writ by attaching all the personal estate of the defendant in the India-rubber factory of Hartshorn & Co., and in the store or warehouse No. 7 Dorrance-street stores, &c., and "have left true and attested copies of this writ, with my doings thereon, with

the city clerk of the city of Providence, and with John Sweet and William E. Himes, they being in possession of the premises, the defendant having no known place of abode within my district."

At the November Term of the court a declaration was filed, containing the allegations of citizenship of the plaintiff and defendant, and that the defendant was commorant of Providence, as in the writ; and at the same term the defendant, in his own proper person, pleaded to the jurisdiction of the court that he was at the time of the pretended service of the writ, and is, an inhabitant of the District of Connecticut, and not an inhabitant of the District of Rhode Island, nor was he at the time of the pretended service of the writ within the District of Rhode Island; praying the judgment of the court, whether it can or will take cognizance of the action against him.

To this plea the plaintiff, by his attorney, filed a general demurrer, on which the cause was heard, and at the June Term the court overruled the demurrer and dismissed the case for want of jurisdiction; upon which the plaintiff sued out a writ of error.

By the eleventh section of the judiciary act of 1789, it is provided: "That no civil suit in a Circuit or District Court shall be brought against an inhabitant of the United States by any original process in any other district than that whereof he is an inhabitant, or in which he shall be found at the time of serving the writ."

It has been several times held by this court as the true construction of the foregoing section, that jurisdiction of the person of a defendant, who is an inhabitant of another State, can only be obtained, in a civil action, by service of process on his person within the district where the suit is instituted; and that no jurisdiction can be acquired by attaching property of a non-resident defendant, pursuant to a State attachment law. The doctrine announced to this effect, in the case of *Toland v. Sprague*, in 1838, 12 Peters, 327, has been uniformly followed since, both by this court and at the circuits. 15 Pet., 171; 17 How., 424.

It is insisted, however, for the plaintiff, that these rulings were had in cases arising where the jurisdiction depended on citizenship; whereas here the suit is founded on an act of Congress conferring jurisdiction on the Circuit Courts of the United States in suits by inventors against those who infringe their letters patent, including all cases, both at law and in equity, arising under the Patent Laws, without regard to citizenship of the parties or the amount in controversy, and therefore the eleventh section of the judiciary act does not apply, but the process acts of the State where the suit is brought must govern, and that the act of Congress of May 8, 1792, so declares.

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The second section of that act provides that the forms and modes of proceeding in suits at common law shall be the same as are now used in the Federal courts, respectively, pursuant to the act of 1789, ch. 21, known as the process act of that year.

This act (sec. 2) declares, that until further provision shall be made, and except where by this act "*or other statutes of the United States is otherwise provided,*" the forms of writs and executions, and modes of process in suits at common law, shall be the same in each State, respectively, as are now used or allowed in the Supreme Court of the same. This was to be the mode of process, unless provision had been made by Congress; and, to the extent that Congress had provided, the State laws should not operate.

Now, the only statute of the United States then existing, regulating practice, was the judiciary act of 1789, ch. 20, which is above recited. The eleventh section is excepted out of and stands unaffected by the subsequent process acts, and is as applicable in this case as it was to those where jurisdiction depended on citizenship. It applies in its terms to *all* civil suits; it makes no exception, nor can the courts of justice make any.

The judicial power extends to all cases in law and equity arising under the Constitution and laws of the United States, and it is pursuant to this clause of the Constitution that the United States courts are vested with power to execute the laws respecting inventors and patented inventions; but where suits are to be brought is left to the general law, to wit, to the eleventh section of the judiciary act, which requires personal service of process within the district where the suit is brought, if the defendant be an inhabitant of another State.

This case, and that of *Day* against *Hayward*, depend on the same grounds of jurisdiction, and were both correctly decided in the Circuit Court; and the judgment in each is affirmed.

**AFFIRMED.**

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HORACE H. DAY, APPELLANT, v. THE UNION INDIA-RUBBER COMPANY.

(20 Howard, 216.)

The party defendants in the present suit have as much right to manufacture various articles of India-rubber under Chaffee's patent, as the licensees in the case of *Hartshorn v. Day*, 19 How., 211.

THIS was an appeal from the Circuit Court of the United States for the Southern District of New York.

The case is stated in the opinion of the court.

## Opinion of the court.

It was argued by *Mr. Clarence A. Seward* and *Mr. Jenckes*, for the appellant, and by *Mr. Noyes*, for the appellees, upon which side there was also a brief by *Mr. Staples*.

Mr. Justice NELSON delivered the opinion of the court.

This is an appeal from a decree of the Circuit Court of the United States for the Southern District of New York.

The bill was filed in the court below by *Day*, as assignee of the patent of *Edwin M. Chaffee*, for a new improvement in preparing and applying India-rubber to cloth, &c., dated the 31st of August, 1836, and renewed for seven years from the 31st of August, 1850, against the defendants, for an alleged infringement during the running of the renewed term.

The questions involved in the case are substantially the same as those presented and decided in the case of *Hartshorn et al. v. Day*, at the last term, and reported in 19 Howard, 211. That was an action at law, brought by the same plaintiff, upon this patent, against the defendants, who were licensees under *Charles Goodyear*, for the manufacture of India-rubber boots and shoes. The defendants in the present case are licensees under *Goodyear*, for the manufacture of India-rubber cloth for various purposes. In both cases, the right to manufacture the article rested upon the authority of *Goodyear* to grant the license, as derived from *Chaffee*, the patentee.

The court held, in the case of *Hartshorn et al. v. Day*, that under the agreement of the 5th of September, 1850, between *Chaffee*, the patentee, and *William Judson*, the entire ownership in the patent, legal and equitable, passed to *Judson*, for the benefit of *Goodyear* and those holding rights under him, and on that ground decided in favor of the licensees.

Now, in this case the licenses under *Goodyear* to manufacture cloth of the description claimed are as broad and ample as were those to the defendants in the case just mentioned. *Goodyear* became the sole owner of the patent of *Chaffee* as early as 28th of June, 1844, and on the 18th of July following gave a license to the *Naugatuck India-Rubber Company*, to manufacture cloths, with certain exceptions, under all his patents,—those in which he was then interested, or in which he might thereafter be interested, issued or to be issued,—and also in all renewals of patents. He also gave a like extensive license, on the 28th of March, 1847, to *W. E. & John Rider*, for manufacturing of ships' letter and mail bags; and in February of the same year, a similar license to manufacture wearing apparel, &c., to *Jonathan Trotter*; and on the 1st of July, 1848, one to *Trotter*

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and W. Rider & Brother, for the manufacture of army and navy equipments, sheet rubber, &c. All these various licenses afterwards became consolidated in the Union India-Rubber Company, the defendants in this suit, and present therefore a complete defense to the suit, if Goodyear was the true owner of the Chaffee renewed patent. And this, as we have seen, has already been held in the case of *Hartshorn v. Day*.

Besides, in the agreement of the 5th of September, 1850, between Chaffee and Judson, it is expressly stated that the patent was conveyed to the latter, to secure it for the benefit of Goodyear and those holding rights to use it under and in connection with his licenses; and Judson was also directed to hold it for their benefit.

The license of the defendants, therefore, in this case, stands upon two grounds, either of which would seem to constitute a sufficient defense to the suit for infringement: First, authority from Goodyear, the owner of the renewed term of the patent; and second, the express recognition of Chaffee, the patentee, of the right of these parties, as licensees of Goodyear, to use the improvement. And we may add to these grounds of defense, that upon the interpretation of the court in the case of *Hartshorn v. Day*, of the several agreements relating to this patent, and especially that of 5th of September, 1850, Day took no interest in it under the assignment of Chaffee of 1st of July, 1853, he having previous to that time parted with all his interest for the benefit of Goodyear and his licensees.

Some evidence has been given in the case for the purpose of showing that the agreement of 5th of September was not sealed at the time of its execution, and that the seal must have been annexed afterwards without any authority. But it is too slight and uncertain to be entitled to any weight.

It has also been insisted that this instrument was procured by fraud from Chaffee, through the contrivance of Judson. But the evidence relied on is very general and unsatisfactory; and, besides, it is too late to set up any such ground of defense after Chaffee himself has carried the agreement into execution, and acted under it, receiving its benefits for some three years. And what is remarkable on this point, he is the chief witness to make out the alleged fraud.

It has also been urged that the licensees have not contributed to the fund for paying the expenses of the renewal of the patent. But this is a matter in which Chaffee had no interest. He has taken the indemnity of Judson against these expenses. The licensees were never liable to him for them.

Without pursuing the examination further, we are entirely satis-

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Argument for the motion to dismiss.

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fied, for the reasons above stated, that the decree below is right, and should be

AFFIRMED.

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HORACE C. SILSBY ET AL., APPELLANTS, v. ELISHA FOOTE.

(20 Howard, 290.)

Where an appeal from a decree is taken within ten days from the rendition of the decree, it is in time to operate as a *supersedas*; and so, also, if taken within ten days after the decree is settled and signed.

THIS was an appeal from the Circuit Court of the United States for the Northern District of New York, sitting as a court of equity.

There were two cases upon the docket with precisely the same caption, one numbered 54 and the other 106.

The case in question was the one numbered 106, which it was moved to dismiss, for the following reasons:

And the said appellee comes into court at the December Term thereof, 1857, and moves the said court to dismiss the appeal in this cause, docketed as No. 106 at the said term, upon the ground that there had been previously taken by the said appellants an appeal from the same portions of the decree made below which are appealed from in this cause, and which prior appeal is still pending and undetermined in this court; and such motion will be made upon the records filed in this cause and in cause No. 54 on the docket for December Term, 1857.

December 18, 1857.

R. H. GILLET,  
*of Counsel for Appellee.*

*Mr. Gillet's* argument was as follows:

Foote sued Silsby and others, in equity, in the Circuit Court for the Northern District of New York, for violating his patent. A final decree was rendered therein on the 28th day of August, 1856. On the 4th of September thereafter the defendants, by Samuel Blatchford, their solicitor, petitioned for an appeal from certain portions of the decree, which was allowed on the 6th of September by Mr. Justice Nelson, being within ten days of the date of the decree. Upon this appeal the record of the proceedings were sent, and have been printed, and the case stands as No. 54 on the docket for the present term. See Record in No. 54, Record, pp. 1, 3.

The decree was enrolled on the 11th day of December, 1856, on which day the same solicitor, in behalf of the defendants, presented

a second petition of appeal from the same portions of the decree, which appeal was allowed on the same day by N. K. Hall, district judge, and this appeal is now before the court at the present term as No. 106. See Record, pp. 1, 3.

A motion is now made by Foote, the appellee, to dismiss the last-mentioned appeal, of which due notice has been given.

The question presented is, which of the two periods is the one contemplated by the twenty-second section of the judiciary act of 1789, which provides "that *final* judgments and decrees may be removed and reaffirmed in the Supreme Court, and which shall not be done, however, except within five years after the *rendering* or *passing* the judgment or decree complained of." 1 U. S. L., 84, 85, sec. 22.

When was the decree passed: at the time of the hearing and actual decision, or when it was enrolled?

This question is answered by reference to the mode of doing business in a court of equity. The court sits and decides, and its clerk or other officer enters the same in the minutes of the proceedings of the court. This is the act of the court performing its highest judicial functions. All that follows, whether performed by the clerk or judge, is merely carrying out the judicial determination and authenticating it. The decision, or rendering, or passing has been made, and what is subsequently done is mere authentication.

"To enroll" means "to register; to enter on the rolls of chancery or other courts; to make a record." Bouvier, 1 vol., 469.

"Enrollment: the registering or entering on the rolls of Chancery, King's Bench, Common Pleas, or Exchequer, or by the clerk of the place of the record of the Quarter Sessions of any lawful," &c. Id., Inc. L. Dic.

Curtis, in his Commentaries, p. 234, speaks of the time when a decree is "pronounced" as the time from which the statute runs.

At page 534 he speaks of the "date of the final decree"; if appealed from in ten days thereafter it will operate as a *supersedeas*.

Appeals have been recognized on appeal before docketing or enrolling. In *Roy v. Law*, 3 Cranch, 179, a decree for a sale on a mortgage was held to be a final decree, which could be appealed from.

In *Whiting v. Bank of United States*, 13 Peters, 6, 15, the same decision was made.

Story, J., said the party had a right to appeal as soon "as the decree was pronounced." *Michoud v. Girod*, 4 How.; 503, proceeded upon the same ground.

In *Forgay v. Conrad*, 6 How., 201, 203, the above cases were cited and approved.

*Bank of the United States v. Daniel*, 12 Peters, 32, p. 52: the whole of the matter in dispute has reference to the date of the decree.

*Corning v. The Troy Iron and Nail Factory*, 15 How., pp. 451, 459, 465, 466, is a case to show that there can be no second appeal where the subject-matter has been removed from the court below.

In the present case the matters appealed from in December had been removed from the court below in September, and there was nothing left for the second appeal to act upon.

*Mr. Blatchford* opposed the motion.

This is a motion to dismiss No. 106, on the ground that a prior appeal has been taken in No. 54 from the same parts of the same final decree.

What is the decree?

The question is, which is regular?

If the appeal in 106 is irregular, it is because the appeal in 54 is regular. If the appeal in 106 is regular, then the appeal in 54 is irregular. The reasons for taking the two appeals were these: Practically, there is no difference to defendants, except as to the return in No. 106. See rules 31 and 32, as to complete record. The court will see why return was so made in 106. Cross-appeal in 158, return made in same manner. Taking 54 and 106 together, there is a complete record; and even though the court dismiss 54, they may consider the return in 54 as forming part of the return in 106, as the clerk says, in his return in 106, they do. And if the court deny the motion to dismiss 106, they will please consider us as moving to dismiss 54, which motion would of course be granted, if the motion to dismiss 106 is denied; and then as moving, if necessary, under rule 32, for a *certiorari* to complete the record in 106. We desire the court to dispose now of all questions of practice connected with these cases, so that if 106 stands for hearing, it may stand with a complete record. The defendants ought not to suffer for the clerk's mistake; but without a *certiorari* the court can order the record in 54 to remain here, and form a part of the record in 106, though the appeal in 54 is dismissed.

By page 22 of the judiciary act of 1789, as modified by page 2 of the act of March 3, 1803, ch. 40, an appeal from a final decree is to be taken within five years after *rendering or passing the judgment or decree complained of*.

By page 23, as so modified, the appeal is a *supersedeas*, and stays execution in cases only where the appeal is taken and a copy lodged for the adverse party within ten days (Sundays exclusive) *after ren-*



## Argument against the motion to dismiss.

*dering the judgment or passing the decree complained of*, until the expiration of which ten days execution shall not issue in any case where an appeal may be a *supersedeas*.

What is the *passing* of the decree?

Under page 23, we think it is the recording and enrolling of the decree in such shape that the party entitled to execution on it can immediately issue his execution. The party is to be stayed for having his execution for ten days after the time when he would otherwise be entitled to it, and the ten days do not begin to run till he would be at liberty, but for this stay, to issue his execution.

Therefore, taking pages 22 and 23 together, the decree is *passed* when it is in such a state that an execution can be issued on it, if there be no stay by appeal.

How it is as to the decree, see pages 10 and 11 of No. 106.

Award to pay certain sums, and interest and costs *to be taxed*, and interest, then execution is given for *such costs* and for the *sums decreed*. He cannot have any execution till his costs are taxed. This is by the decree itself.

But beyond that, by general equity practice, he can have no execution till the decree is signed and enrolled. Here the record says, page 11, that this final decree is *signed* and enrolled December 11, 1856, and the appeal in 106 was taken the same day.

Why can't he have execution till the decree is enrolled? Because till then the decree is open for rehearing, but after that it is not.

Rule 88 in equity says: "No rehearing shall be granted after the term at which the final decree of the court shall have been entered and *recorded*, if an appeal lies to the Supreme Court." *Entry* alone does not cut off rehearing. The decree must be recorded to cut off a rehearing. *Recording* is *enrolling*. Therefore there can be a rehearing till the decree is recorded or enrolled, and there can be no execution till a decree is enrolled. And the right to execution on the one side gives, under pages 22 and 23, the right to appeal on the other side, because the act manifestly contemplates that the decree is not passed till the right to execution under it is ripened; because the ten days spoken of in page 23 are to run from the passing of the decree, and during that ten days there is to be no execution. Hence, to make the provisions all harmonious, the right to issue execution, but for the stay, must be simultaneous with the passing of the decree.

Now, is it laid down in all the books that there can be no execution till enrollment, and that enrollment is necessary to make the decree a *record*? 1 Barb. Ch. Pr., 342; 2 Danl., (Perkins ed. of 1846,) 1220, 1221. It will not, till enrollment, be treated by other courts

as a record. The reason given is, because till then it is open for rehearing. Hence, in rule 88, the word recorded is used, which means *made a record* by enrollment.

Till enrolled, it can't be pleaded in bar to another suit for the same matter. Same reference as above.

In England the time for appeal runs two years from the enrollment. 3 Danl., 131.

Besides, under page 22, in connection with the act of December 12, 1794, on an appeal which is to be a stay, security is to be given for the amount recovered below, damages and costs. *Catlett v. Brodie*, 9 Wheat., 553. How can the amount recovered below, for which this security is to be given, be ascertained till the costs are taxed and the decree enrolled?

The views we maintain seem to follow from those announced by this court in *Forgay v. Conrad*, 6 How., 204: "When the decree directs the defendant to pay a certain sum of money to the complainant, and the complainant is entitled to have such decree carried immediately into execution, the decree must be regarded as a final one."

Here a sum of money is directed to be paid, but there can be no execution on the decree till the costs are taxed and the decree is signed and enrolled. Therefore, on the 28th of August, 1857, the plaintiff was not entitled to have the decree carried immediately into execution, and the appeal in 54 was irregular.

As to arguing the cross-appeal in 158 with the original appeal, whether it be 54 or 106, the record in 158 is not printed. We prefer to wait.

Plaintiff might have taken his cross-appeal as early at least as December 11, 1856. He waited till July, 1857. It is his own fault. We had to appeal, to stay execution.

Mr. Justice NELSON delivered the opinion of the court.

This is a motion to dismiss an appeal, docketed as No. 106, on the ground that a previous appeal, docketed No. 54, had been taken by the same parties, and from the same portions of the decree below. The final decision had been made by the court between the parties on the coming in of the master's report on the 28th of August, 1854, and an appeal duly taken on the 4th of September following. The decree was special in its terms, and was not settled or signed by the judge till the 11th of December, 1856, on which day the second appeal was taken. As the appellant desired to appeal within the ten days so as to stay execution, the second appeal was taken for abundant caution, as there might be a doubt from which period the ten

## Opinion of the court.

days should be counted, namely, the time of the final decision of the court, or of the signing and filing of the special decree in form.

By the twenty-second section of the judiciary act, modified\* by the second section of the act of March 3, 1803, an appeal from a final decree must be taken within five years after the *rendering* or *passing* of the judgment or decree complained of. And by the twenty-third section, as modified above, the appeal is a *supersedeas*, and stays execution in cases only where it is taken and a copy lodged for the adverse party within ten days (Sundays exclusive) after *rendering* the judgment or *passing* the decree complained of. The *time* to be taken as when the judgment or decree may be said to be rendered or passed may admit of some latitude, and may depend somewhat upon the usage and practice of the particular court. In the case of a simple judgment or decree, such as an affirmance or reversal, and the like, there would seem to be no difficulty in taking the appeal at any time within the ten days after the decision on the case was pronounced; but where the decree is special, and its terms to be settled, there is a propriety in waiting for its settlement before taking the appeal. Whether taken or not, may sometimes depend upon the decree as settled. In the second circuit, with the practice of which I am the most familiar, it is supposed by many of the profession that the proper time for taking the appeal in such a case is after the settlement of the decree. As this court, however, has always held that if an appeal is taken in court at the time of rendering the decision, or during the term, no citation is necessary, and as appeals are, perhaps, more frequently taken within the ten days after the decision is pronounced and entered on the minutes by the clerk, it may be admitted that when thus taken it is regular, and stays execution in the court below. And we are also of opinion, that if taken within ten days after the decree is settled and signed by the judge and filed with the clerk, that it is in time to stay the proceedings. The recognition of the two periods from which the ten days may be counted becomes necessary, on account of the difference in the modes of proceeding and practice in the different circuits. This question cannot arise in England, as the time for appeal runs two years from the enrollment of the decree. 3 Danl. Pr., 131. The time of enrollment cannot well be adopted by this court, as on many of the circuits it is understood, according to the practice, no enrollment of the decree takes place.

As, upon our view of the case presented on the motion, the first appeal was regular, the one taken and standing on the docket No. 106 should be

DISMISSED.

HORACE C. SILSBY, WASHBURN RACE, ABEL DOWNS, HENRY HENION,  
AND EDWARD MYNDERSE, APPELLANTS, v. ELISHA FOOTE.

(20 Howard, 378.)

1. Foote's patent declared good, for the combination of machinery used in "the application of the expansive and contracting power of a metallic rod, by different degrees of heat, to open and close a damper which governs the admission of air into a stove, in which such rod shall be acted upon directly by the heat of the stove or the fire which it contains."
2. The award by the Circuit Court of damages for an infringement of the patent affirmed by an equal division of this court, but the allowance of interest overruled.
3. Where a patentee claims more than he is entitled to, his patent may still be good for what is really his own, provided he enters a disclaimer for the surplus without any unreasonable delay. In this case, the patentee was allowed to recover damages for an infringement, but not to recover costs, agreeably to the provisions of the act of Congress of the 3d of March, 1837.

THIS was an appeal from the Circuit Court of the United States for the Northern District of New York, sitting as a court of equity.

In May, 1842, Foote obtained a patent for an improvement in regulating the draft or heat of stoves. The claim which he made was this:

What I claim as my invention, and desire to secure by letters patent, is the application of the expansive and contracting power of a metallic rod, by different degrees of heat, to open and close a damper which governs the admission of air into a stove, or other structure in which it may be used, by which a more perfect control over the heat is obtained than can be by a damper in the flue.

I also claim as my invention the mode above described of letting the heat of a stove, at any requisite degree by which different degrees of expansion are required, to open or close the damper.

I also claim the combination above described, by which the regulation of the heat of a stove, or other structure in which it may be used, is effected; and I also claim as my invention the mode above described of connecting the action of the metallic rods with the damper, so that the same may be disconnected when the damper shall have closed, and the heat shall continue to rise, &c.

ELISHA FOOTE, JR.

Afterwards, in March, 1847, he filed the following disclaimer:

"To the Commissioner of Patents: The petition of Elisha Foote, of Seneca Falls, in the county of Seneca and State of New York,

## Statement of the case.

respectfully represents, that your petitioner obtained letters patent of the United States for an improvement in regulating the draft of stoves, which letters patent are dated on the 26th day of May, 1842; that he has reason to believe, that, through inadvertence and mistake, the claim made in the specification of said letters patent—in the following words, to wit: ‘What I claim as my invention, and desire to secure by letters patent, is the application of the expansive and contracting power of a metallic rod, by different degrees of heat, to open and close a damper which governs the admission of air into a stove, or other structure in which it may be used, by which a more perfect control over the heat is obtained than can be by a damper in the flue’—is too broad, including that of which your petitioner was not the first inventor.

“Your petitioner, therefore, hereby enters his disclaimer to so much of said claim as extends the application of the expansive and contracting power of a metallic rod, by different degrees of heat, to any other use or purpose than that of regulating the heat of a stove, in which such rod shall be acted upon directly by the heat of the stove or the fire which it contains; which disclaimer is to operate to the extent of the interest in said letters patent vested in your petitioner, who has paid ten dollars into the treasury of the United States, agreeably to the requirements of the act of Congress in that case made and provided.”

This did not apply to the whole of his claim, but only to a part of it.

In 14 Howard, 218, will be found the report of a suit which Foote instituted against some of the present appellants. The judgment of the court below being affirmed by this court, that suit was brought to an end.

On the 9th of October, 1848, Foote filed his bill on the equity side of the Circuit Court against the present appellants, complaining that they continued their infringement upon his patent, praying for an injunction, an account, &c., &c. After other proceedings were had in the case, Mr. Justice Nelson (in vacation, viz., September, 1850) ordered an issue to be made up at law upon the first and third points of the claim, the second and fourth not being drawn into controversy. In June, 1851, the trial at law took place, which resulted in a verdict for the defendants.

Afterwards, the cause came before the court, on a hearing of the pleadings and proofs, and case made upon the trial of the feigned issues; and after hearing of counsel for the respective parties, the

court, on the 29th day of August, 1853, directed the following order to be entered :

*In Equity.*

“This cause having been heard on argument by counsel for the respective parties on the pleadings and proofs, and upon the case made since the trial of the feigned issue therein, and the court having considered the same, and being of the opinion that the complainant was the first and original inventor of the application of the expansion and contraction of the inflexible metallic rod to the regulation of the heat of stoves, as described and claimed in his patent, adjudge and decree that the defendants have infringed the said patent in making and vending the regulators of stoves, as charged in the said bill of complaint, and that the said complainant is entitled to have a perpetual injunction to restrain said defendants, their agents, servants, and all claiming or holding under or through them, from making, vending, or using, or in any manner disposing of any regulator or regulators of stoves, embracing the invention or improvements described in said letters patent, namely, any regulator in which the expansive and contracting power of an inflexible metallic rod, which expansion and contraction, if produced by changes in the heat of the stove regulated, shall be applied to the damper to regulate the heat thereof, and this notwithstanding the verdict of the jury upon the feigned issue, heretofore rendered on the trial of the same.

“And it is further adjudged and decreed, that the cause be referred to Augustus A. Boyce, Esq., the clerk of this court, to ascertain and report the number of regulators for stoves embracing the principle aforesaid that have been made, and also the number sold by the said defendants, or either of them, since the 23d day of March, 1847, and the damages complainant has sustained, or use and profits the defendants, or either of them, have derived by reason of such infringement, since the time last aforesaid; and, upon the coming in and confirmation of the said report, that said complainant have a decree and execution for the amount found due to him, and also for the costs in this suit, to be taxed.”

It appeared from the record that the court, on the trial of the feigned issues, instructed the jury that the first claim of the patentee was disproved by the prior construction of the Saxton stove, and that the patent must rest for its validity upon the other claims.

In June, 1854, the master made his report, which was very voluminous, and to which both parties filed numerous exceptions, some of which were overruled and others allowed by the court. The result of some of the rulings made a further reference to the master

## Statement of the case.

necessary, when both parties expressed a desire that the court should make the examination itself. This was accordingly done, when the following decree was passed, viz.:

“This court having accordingly made such examination and determination, it is further ordered, adjudged, and decreed, and this court, by virtue of the power and authority therein vested, doth further order, adjudge, determine, and decree, that the said defendants are respectively liable to the said complainant for the sums of money hereinafter set forth, in the manner hereinafter particularly mentioned, for their profits of the use by the said defendants, or such of them as are hereinafter particularly declared liable therefor, of the said invention of the complainant, described and secured to him by letters patent granted to the said complainant, as set forth in the bill of complaint in this cause, which use was unauthorized and an infringement and violation of the rights of the said complainant, under the said patent; that is to say, that the said defendant, Horace C. Silsby, either severally or jointly with others of said defendants, is liable for and chargeable with the sum of twenty-three thousand six hundred and forty-four dollars and twenty-two cents (\$23,644.22); that of the said last-mentioned sum the said defendant, Washburn Race, is in like manner liable for the sum of eighteen thousand one hundred and eighty-two dollars and six cents (\$18,182.06); that of the said first-mentioned sum the said defendant, Edward Mynderse, is in like manner liable for and chargeable with the sum of fifteen thousand nine hundred and sixteen dollars and twelve cents; and that of the said first-mentioned sum the said defendant, Henry Henson is liable for and chargeable with the sum of three thousand one hundred and fifty-four dollars and eighty-five cents; and that of the said first-mentioned sum the said defendant, Abel Downs, is liable for and chargeable with the said sum of three thousand two hundred and sixty-seven dollars and thirty-seven cents.

“And it is further ordered, adjudged, and decreed, and this court, by virtue of the power and authority therein vested, doth order, adjudge, and decree, that each of the said defendants pay to the said complainant the sum which such defendant is above declared and decreed to be liable for and chargeable with, and interest thereon, until such payment, or so much thereof as shall be necessary, together with the sums previously paid by the other defendants, to pay off and discharge the first-mentioned sum of twenty-three thousand six hundred and forty-four dollars and twenty-two cents, and interest thereon, from the entry of this decree; and the evidence in this cause not enabling the court now to determine with pre-

## Argument for the appellants.

cision the rights of such defendants as between themselves, in respect to the sums for which each of such defendants is liable to contribute to the other, it is further ordered and decreed, that the sums paid by or collected from the property of each defendant under this decree shall be first applied in payment and discharge of the amount, if any, for which said defendant is solely liable, and next to the payment and discharge of such amount, if any, as the said defendant and the least number of the other defendants is liable, in such manner as to give to the said complainant his just and full rights against each and all said defendants; and if any controversy or question shall arise in respect to the proper application of any moneys so paid or collected, either defendant or party may apply to this court, upon affidavit and due notice to the adverse party in interest, for instructions in respect to the application thereof, or the stay of further executions against any single defendant, or any portion of such defendants, on the ground that the whole sum for which he is hereby made liable has been paid by himself and other defendants jointly liable therefor.

“And it is further ordered, adjudged, and decreed that the said defendants pay to the said complainant his costs in this suit, to be taxed, with interest thereon from the taxation and allowance thereof until paid, and that he have executions for such costs, and for the sums above decreed to be paid him as aforesaid; but such execution against the defendants other than the said defendant, Horace C. Silsby, shall be only for such costs, and the amount for which such defendants are hereinbefore respectively declared to be liable.

“S. NELSON:

“N. K. HALL.”

From this decree the complainant and respondents both appealed; but as the case of the respondents' appeal came on first for argument, it only is noticed. Both cases were decided together.

The case was argued in this court by *Mr. Keller* and *Mr. Blatchford*, for the appellants, and by *Mr. Foote*, in proper person, for the appellee.

The counsel for the appellants directed their attention exclusively to the first claim of the patent, which was in fact the only one involved in the controversy. They denied—

1. The validity of the patent.
2. Its novelty.
3. Its utility.



## 4. The infringement and the liability of the defendants below.

The principal objection to the validity of the patent was the nature of the subject, which, it was contended, was exactly similar in its general character to the eighth claim of Morse, which this court decided to be invalid. *O'Reilly v. Morse*, 15 How., 62.

On the subject of the novelty of the invention, the counsel contended that the Saxton stove and Arnott improved stove were both prior in point of time, and in both of them the principle of the expansion and contraction of a metallic rod was applied to regulate a damper, by causing it to open and close according to the heat of the stove. But it is in vain to attempt to follow the counsel for the appellants in the various branches of their argument, which occupied nearly fifty pages of a printed brief.

*Mr. Foote* argued his own case, and thus explained his invention :

The complainant's invention consisted in the application of the expansive and contracting power of an inflexible metallic rod to regulate the heat of stoves. The great difficulty in making this application arose from the indispensable necessity of providing a detaching process. In the complainant's apparatus, after an increase of heat has entirely closed the damper, should the temperature, from any cause, continue to rise, the levers which communicate the action of the rod to the dampers disconnect themselves from it, and are free to move on to any extent to which the stove may be heated ; and on the heat's returning to the same point, they will reconnect themselves with the damper and resume their appropriate functions. In like manner, should the fuel burn out and the heat continue to fall, after the damper has been fully opened, the levers will become detached, until the temperature shall have been again restored to the desired degree.

The office of a regulator is to produce a uniform heat ; and to attain this object, it is necessary to give such increase of motion to the action of the rod, that a small change of heat, say from five to ten degrees, shall be sufficient to open or close the damper. Then slight variations from the desired point, operating upon the damper, keep very nearly a uniform temperature, sufficiently so for all practical purposes. Were it constructed otherwise, it might be a thermometer, to show the degree of heat, but would not be a regulator, to control it. But the variations of temperature in a common stove exceed one thousand degrees ; and unless provision was made for excessive changes, the apparatus would destroy itself. It could not be used for a stove regulator.

Several attempts had been made, previous to the complainant's in-

vention, to apply the inflexible rod as a regulator to some other purposes, where it was subjected to such changes only as take place in water, or atmospheric air, and where a detaching process was not deemed to be essential. But we have no evidence that such attempts were ever successful, or were anywhere in practical use, or had ever been known beyond the books in which they are described. But to the stove, with its excessive variations, it does not appear that any one ever attempted its application.

The efforts previously made to produce a stove regulator were in a different direction. When two thin, flexible, and elastic slips of metal, of unequal expansibilities, are soldered, or otherwise attached together, a change of heat, affecting one more than the other, produces a flexure or curvature of the instrument; and as its elasticity enabled it to yield to any excessive change, and obviated the necessity of a detaching process, its application to a stove was easy and apparent. But an insuperable difficulty was found in its use. When an elastic piece of metal is bent and heated, it takes a new form, or, as it is termed, "sets" into that position. The effect is gradual at moderate temperatures, and instantaneous at high. The instrument, besides, was necessarily made slight, in order to have the requisite flexibility; and although very useful for some purposes, its application to stoves was but a series of unsuccessful experiments.

All the difficulties were overcome in the complainant's application of the inflexible rod, and a really practical and effectual stove regulator was for the first time produced.

Mr. Justice NELSON delivered the opinion of the court.

This is an appeal from a decree of the Circuit Court of the United States for the Northern District of New York.

The bill was filed in the court below by Foote against the defendants for an alleged infringement of a patent for an improvement in regulating the draft or heat of stoves. The bill, among other things, set out a trial at law between the parties upon the patent, and a verdict for the plaintiff; that the defendants since the trial and verdict continued their infringement, and had even increased the business of making and vending the complainant's stove regulators.

The complainant prayed for an account, and that the defendants be restrained by injunction from further infringements.

The defendants put in an answer, to which there was a replication. Afterwards feigned issues were ordered by the court, to try the questions whether or not the patentee was the first and original inventor of the application of the expansive and contracting power of the me-

## Opinion of the court.

tallic rod, by different degrees of heat, to open and close the damper which governs the admission of air into a stove; and, also, whether or not he was the first and original inventor of the combination described in his patent, by which the regulation of the heat of a stove in which it might be used was effected.

The jury, after hearing the proofs upon these issues, returned a verdict in the negative. Afterwards the cause came before the court upon the pleadings and proofs, and the case made upon the trial of the feigned issues; and after hearing the arguments of counsel for the respective parties, held that the patent was valid, notwithstanding the verdict of the jury on the feigned issues, and also that the defendants had been guilty of an infringement, and referred the cause to a master, to ascertain and report the profits which the defendants had derived by reason of said infringement. A most voluminous record of testimony was taken before the master, and on the 17th of June, 1854, he reported profits made by the defendants to the amount of \$2,650. Thirty exceptions were filed to the report by the counsel for the complainant, and eighteen by the defendants, and were argued before the court. The view the court has taken of the case here renders it unimportant to refer particularly or specially to the decision of the court below upon each of these exceptions. After disposing of them, the court, agreeably to an earnest request of the counsel that the cause should not be again sent down to the master, but that the court, upon the evidence before it, should ascertain the amount of profits to which the complainant was entitled, entered upon the inquiry, and, after a laborious and minute examination of a record of some six hundred closely-printed octavo pages of proofs, found an aggregate of profits to the amount of \$17,980.40, and an aggregate of interest (averaged) of \$5,663.82, making a total of \$23,644.22. And on the 28th of August, 1856, a final decree was entered for the complainant against the defendants for this amount, with the costs, to be taxed.

The cause is now before this court on appeal.

The difference of opinion among the judges of this court in respect to the amount of profits that should be allowed to the complainant, precludes the delivery of any written opinion on this branch of the case. The decree of the court below as to the amount, with the exception of the interest, is affirmed by a divided court. A majority of the court are of opinion that there was error in the allowance of interest on the profits found for the complainant. That amount, therefore, which is \$5,663.82, must be deducted.

## Dissenting opinion.

This court is also of opinion that the court below erred in awarding costs of the complainant against the defendants.

The first claim of the patentee in his patent was disproved by the prior construction and use of what is called in the case the Saxton stove, and no disclaimer was entered according to the requirements of the act of Congress 3d March, 1837. By the ninth section of that act it is provided, that when a patentee, by mistake, shall have claimed to be the inventor of more than he is entitled to, the patent shall still be good for what shall be truly and *bonâ fide* his own, and he shall be entitled to maintain a suit in law or equity for an infringement of this part of the invention, notwithstanding the specification claims too much. But in such case, if judgment or decree be rendered for the plaintiff, he shall not recover costs against the defendant, unless he shall have entered a disclaimer in the Patent Office of the thing patented, to which he has no right, prior to the commencement of the suit. There is also another condition, namely, that the plaintiff shall not be entitled to the benefits of the section, if he has unreasonably neglected or delayed to enter the disclaimer.

The Saxton stove was produced on the trial of the feigned issues, after this suit had been commenced, and the question has been in controversy from thence to the present time, whether or not the arrangement, construction, and use of that stove had the effect to disprove the first claim in the complainant's patent. It would be going too far, therefore, under these circumstances, to hold that the delay in entering the disclaimer was unreasonable within the meaning of the statute. A majority of the court is of opinion the delay has not been unreasonable within the meaning of the act, so as to defeat the recovery.

According to our conclusions, the decree of the court below is reversed as to the \$5,663.82 interest, and also as to the costs allowed the complainant, and affirmed as to the residue, without costs to either party in this court; and that the case be remitted to the court below, to enter a decree for the complainant against the defendants, in conformity to this opinion, and proceed to the execution of the same.

Mr. Justice DANIEL and Mr. Justice GRIER dissented.

Mr. Justice DANIEL.

I concur entirely in the views expressed by my brother Grier in this cause. I have always regarded the patent of the complainant void upon its face. I moreover consider the decree of the Circuit

## Dissenting opinion.

Court inconsistent with the claim of the complainant, unwarranted by any evidence in the cause, and most unjust and oppressive in its operation.

Mr. Justice GRIER, dissenting.

Although I may occasionally differ in opinion with the majority of my brethren, my usual custom has been to submit to their better judgment without remark. But in this case I feel constrained to protest against a decree which, in my opinion, does great and manifest injustice to the appellants. In doing so, it is proper that I thus state my reasons as briefly as possible, without an attempt at their full vindication by a tedious argument.

I. I believe the patent of complainant to be void on its face.

The first claim is for the application of the "expansive and contracting power of a metallic rod, by different degrees of heat, to open and close a damper which governs the admission of air into a stove."

Now, this claim is false in fact. The patentee was not the first to make this application of the different degrees of expansion of metals to open and close a damper to a stove. The evidence is clear, explicit, and uncontradicted. Moreover, a jury has so found in an issue ordered in this case, and which verdict does not appear to have been set aside, although it was disregarded in the decision of the case.

This claim, even if it were true in fact, is clearly void in law, unless we agree to reverse the doctrine laid down by this court in the case of *O'Reilly v. Morse*, with regard to the eighth claim of Morse's patent. Besides, at the trial at law, the Circuit Court decided, in 1848, that this first claim could not be sustained. Yet, with ten years' judicial notice of this defect in his patent, the patentee has never amended it, entered a disclaimer, or attempted to avail himself of the privilege offered to him by the statute to rescue it from this charge, so destructive to its validity.

At common law, a patent having this infirmity was absolutely void. The Patent Act of 1836, sec. 13, provides a remedy, "where a patent is inoperative and void, by reason of a patentee's claiming in his specification as his invention more than he had a right to claim, and when the error has arisen through inadvertence or mistake."

In such a case, the patentee is permitted to surrender his patent, and, on payment of a further sum, have his patent reissued as corrected. But he was not permitted to recover any damage for infringement which occurred before the date of the reissued patent.

The Patent Act of 1837, section 7, gives a further privilege to the patentee of escaping the consequences of such a defect, "where his

## Dissenting opinion.

patent is too broad," by permitting him to enter a disclaimer, to be taken and considered as part of the original specification. It does not subject him to the costs of a new patent, nor to the forfeiture of antecedent damages, where the disclaimer is made during the pendency of a suit, but gives the defendant a right to object to its validity on account of unreasonable neglect and delay in filing it.

The ninth section of the same act provides for the case where "the patentee, in his specification, has claimed to be the inventor of any material or substantial part of the thing patented, of which he was not the first inventor, and provided it be distinguishable from other parts claimed in his patent. He is permitted to sustain his action for such part as is *bonâ fide* his own invention, forfeiting his right to costs where he has not filed a disclaimer before suit brought. But no person, bringing any such suit, shall be entitled to the benefits of this section, who shall have unreasonably neglected or delayed to enter at the Patent Office a disclaimer as aforesaid."

Now, the first claim of this patent does not come within the category of the ninth section. It is not for "a material and substantial part of the thing, distinguishable from other parts," but it is the case embraced in the seventh section, where the claim is void because it is too broad.

Here the claim is for a monopoly of the expansive power of metals when applied to a stove, and this expansive power is a necessary agent in every claim for a combination in the patent.

The seventh section gives the patentee no right to recover at all, unless a disclaimer has been filed before trial or judgment. But, assuming that the privilege given by the ninth section be available to the patentee in this case, has he brought himself within the proviso? He has refused to avail himself of the privilege tendered to him by the law, and stands upon his patent. Notwithstanding the decision of the Circuit Court against this claim in 1848; notwithstanding the decision of this court in *O'Reilly v. Morse*; notwithstanding the verdict in 1853 declaring this claim false, no disclaimer has ever been entered. The pendency of the suit could be no reason, for the acts contemplate a pending suit. I cannot consent to say that this is not a case not only of unreasonable delay, but of stubborn rejection of the privilege offered by the law.

The case of *O'Reilly v. Morse* cannot be quoted as a precedent for this. There, Morse was admitted to be the original inventor of the application of an element of nature in his eighth claim; but the court decided that it was void, because it was too broad. Until that decision was read in court, the patentee had not the least reason to

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suspect his claim to be invalid. The decision was a surprise not only to him, but many others more learned in the law, who had carefully examined this claim and advised the patentee that it was valid. In the present case, the patentee disregarded the judgment of a Circuit Court, a verdict of a jury, and judgment of this court, all of which warned him of the necessity of a disclaimer many years before final judgment.

I cannot consent to annul the statute altogether, and allow its benefits to a patentee who has stubbornly refused to submit to the conditions on which they are tendered.

II. The interlocutory decree of the court below does not condemn the defendants for infringing the third claim of the complainant's patent, on which alone it was decided on the trial at law the defendant was liable, and on which it is now attempted to justify this decree. What that decree is must be judged by the record, and not by any parol explanations or contradictions of it.

The decree affirms—

1st. That the plaintiff was the first inventor of the *application* of the expansion and contraction of the inflexible metallic rod to the regulation of the heat of stoves.

2d. That any regulator in which the expansive and contracting power of an inflexible metallic rod, which expansion and contraction is produced by changes in the heat of the stove regulated, is *applied* to the dumper to regulate the heat of the stove, is embraced within the principle of the invention claimed in the patent.

3d. That the defendants have made and sold regulators embracing that principle.

4th. That they must account for all regulators made and sold by them which embrace that principle.

This decree charges the defendant with the infringement of the first claim of the patent, and is in conformity with the doctrines advanced in the charge of the court, on the issue tried before them, where the court thus define the claim of the patent:

“Now, in this case, as I understand the claim of the patentee, he claims the application of the principle of expansion and contraction in a metallic rod for the purpose of regulating the heat of a stove. That is the new conception which he claims to have struck out; and, although the mere abstract conception would not have constituted the subject-matter of a patent, yet, when it is reduced to practice by any means, old or new, resulting usefully, it is the subject of a patent, independently of the machinery by which the application is made.”

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Again, speaking of the first claim, he says:

"That claim is not for any mode or method of applying the expansion and contraction of the metallic rod to regulate the heat of the stove, but it is for the conception of the idea itself."

The interlocutory decree says, therefore, in effect, that the brass-rod regulators, which the defendants admit in their answers that they made and sold, are infringements of the plaintiff's patent, *because* they embrace the principle of the application of the expansive and contracting power of an inflexible metallic rod to the damper of a stove. And the master is directed to take an account of all regulators that fall within the principle specified, no matter what their mechanical structure is, or how they may differ from the regulators of which the plaintiff gives a description in his specification, and no matter whether they embrace or not anything that the plaintiff claims in either his second, his third, or his fourth claim. The plaintiff and the court below say, in effect, that they do not care for any proof as to whether any claim of the patent but the first is infringed; and that, as the defendants have been guilty of applying the expansive and contracting power of an inflexible metallic rod to open and close the damper of a stove, in which changes in the heat of the stove produce the expansion and contraction, they must respond for all instances of such application.

The defendants are found guilty of infringing the first claim of the patent alone. No testimony was produced in the case to show that the Race patent infringed the third claim, and this fact was emphatically denied in the answer. Nor was the verdict and judgment at law put in evidence. And if it had been, it is no estoppel in equity to the defendants' putting the truth of that charge of the bill in issue in his answer. That verdict and judgment is put into the bill, as laying a proper ground for the granting of the preliminary injunction. Nor is it true, as now asserted, that this court has decided the question in the case of *Silsby v. Foote*, 14 Howard, 225.

On that trial, the court below had instructed the jury, "that the defendants had not infringed the plaintiff's patent unless they had used all the parts embraced in the plaintiff's combination," and submitted the question to the jury whether there had been such infringement.

This instruction was adjudged by this court to be correct. The question whether the verdict was correct was not before this court, and could not have been decided.

The third claim which it is *now* alleged to be infringed is as follows:



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"I also claim the combination *above described*, by which the regulation of the heat of a stove, or other structure in which it may be used, is effected."

The law requires that a patent should "particularly specify and point out the part, improvement, or combination which the patentee claims as his own invention."

This claim does not specify the combination claimed, otherwise than by reference to the body of the specification, where two distinct and complex combinations of numerous parts and devices are set forth.

After a full and fair trial, the jury have found, on an issue directed for that purpose, that the complainant was not the first and original inventor of the combinations set forth in this claim. But assuming that the court may disregard this verdict, and, without setting it aside or ordering a new trial of the issue, treat it as a nullity; and assuming, that without any testimony whatever being offered in the case, the court may, on view of the models, declare that the defendants' patent infringes that of complainant; and assuming the doctrine affirmed by this court in *Silby v. Foote* and *McCormick v. Manny* to be correct, "that defendant has not infringed plaintiff's patent unless he has used all the parts embraced in plaintiff's combination," I think it is clear to ocular demonstration that the defendants have not infringed either of the combinations claimed, unless we assert that all other combinations which produce the same result are equivalents for the first—a sophism which has just been rejected by this court in the case of *McCormick v. Manny*. A vindication or demonstration of the correctness of this conclusion could not be made intelligible unless by a long recital from the specification and an exhibition of models or diagrams. The decree of the court below very properly does not assert or adjudge that defendants have used the complex combination of complainant's specification in any of its numerous parts save one—the expanding rod. On this point, therefore, my objection to the affirmance of any portion of this decree, is because it is founded on a claim admitted to be void in law, and is sustained by presuming, contrary to the record, that it was founded on a claim found by verdict in the case to be void in fact, and without any proof of infringement save ocular demonstration of the contrary.

III. But assuming the verdict of 1848 between the present complainant and some of the defendants to be conclusive as an estoppel on all of them, notwithstanding the denial of the answer and the evidence of our senses, yet that verdict was between the complainant's patent and the Race patent, which is called the "brass-rod

## Syllabus.

regulator," then used by the defendants. It had no reference whatever to the "expander patent," afterwards used by defendants. There is no charge in the bill that the combination of this last patent infringes the complainant's patent. There was no evidence offered to prove such to be the fact. The master's report declares it not to be an infringement of the combination of the third claim,—it is patent to the eyes of any one who will examine the models that it does not,—yet, because it used the expansive power of metals, the defendants are mulcted in the sum of \$7,033 damages, not for invading the complainant's rights, but for evading his patent by a patented invention for a different combination. I forbear to make any further remarks on this enormity, because it is affirmed by the division of the court, and their opinion has, happily, not been compelled to defend it by argument. As it is without precedent, so neither can it be cited as such hereafter.

IV. Lastly, after a very long and laborious investigation, the master has found that the profit of making and vending the machine charged as an infringement is ten cents on each regulator. This finding of the report was excepted to by the complainant. The court overruled the exception and confirmed the report on this point; and, nevertheless, assess the damage at *tenfold the amount*. By what process of reasoning or arithmetic, on what facts or what principle of law, this astonishing and ruinous decree is founded, it does not undertake to explain. I can conceive of no other ground than that the court have calculated the whole profit of the stove, as was done in the case of *Seymour v. McCormick*, and overruled by this court.

Believing, therefore, that the decree of this court, so far as it affirms any portion of the decree of the Circuit Court, is not only unsustained by evidence, but contrary to the law as heretofore established by this court, I cannot give my assent to it.

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CYRUS H. McCORMICK, APPELLANT, v. WAITE TALCOTT, RALPH EMERSON, JESSE BLINN, AND SYLVESTER TALCOTT, SURVIVORS OF JOHN H. MANNY.

(20 Howard, 402.)

1. The reaping-machines made by Manny do not infringe McCormick's patent, either as to the divider, the manner in which the reel is supported, or the combination of the reel with a seat for the raker.
2. McCormick not being the original inventor of the machine called a divider, but the patentee of only an improvement for a combination of mechanical devices, could not hold as an infringer one who used only a part of the combination.

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3. The manner of supporting the reel in Manny's machine is not like that in McCormick's, and was used before McCormick's first patent.
4. With respect to the raker's seat, McCormick's patent was for a combination of the reel with a seat arranged and located according to his description. But Manny's arrangement differs from McCormick's, in principle as well as in form and combination, and is, therefore, no infringement of McCormick's patent.

THIS was an appeal from the Circuit Court of the United States for the Northern District of Illinois, sitting as a court of equity.

The bill which was filed by McCormick alleged that the defendants in error had infringed his patent for a reaping-machine, called upon them for an account, and prayed for an injunction. The defendants denied the infringement, and claimed a right to construct their machines under letters patent granted to John H. Manny. The Circuit Court dismissed the bill, and McCormick appealed to this court.

McCormick's patent had been twice before this court, as will be seen by referring to 16 Howard, 480, and 19 Howard, 96. The same claims, viz., the fourth and fifth of the patent of 1845, were involved in the case in 19 Howard, and the remaining claim, viz., that relating to the seat of the raker, under the patent of 1847, was before the court in 16 Howard, only that it now comes up under a reissued patent in 1853.

The reporter despairs of giving any intelligible account of the argument in this case. The record was upwards of one thousand pages of printed matter, of which seven hundred and fifty pages were the depositions of witnesses; and the court-room was filled with models and drawings, introduced upon either side, to which constant reference was made by the counsel.

The case was argued by *Mr. Reverdy Johnson* and *Mr. Dickerson*, for the plaintiff in error, and by *Mr. Stanton* and *Mr. Harding*, for the defendants.

Mr. Justice GRIER delivered the opinion of the court.

The bill charges the defendants with infringing two several patents granted to complainant for improvements in the machine known as McCormick's reaper. One of these patents bears date the 31st of January, 1845; the other on the 24th of May, 1853, being the reissue of a previous one, dated 23d of October, 1847. The defendants are charged with infringing the fourth and fifth claims of the patent of 1845, and the second claim of the reissued patent of 1853.

I. The first infringement charged is that of the divider, or that part of the reaping-machine which is defined "as an arrangement or

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apparatus for separating the grain to be cut from that which is to be left standing."

The claim is as follows: "4th. I claim the combination of the bow, L, and the dividing-iron, M, for separating the wheat in the way described."

The description referred to is as follows:

"The *divider*, K, is an extension of the frame on the left side of the platform, say three feet before the blade, for the purpose and so constructed as to effect a separation of the wheat to be cut from that to be left standing, and that whether tangled or not. E is a piece of scantling, say three feet long and three inches square, made fast to a projection of the platform by two screw bolts. To the point of this piece, at K, is made fast by a screw or bolt a bow, L, of tough wood, the other end of which is made fast in the hinder part of the platform at R, and it is so bent as to be about two and a half feet high at the (left) reel-post, and about nine inches out from it, with a regular curve. The *dividing-iron*, M, is an iron rod, of a peculiar shape, made fast to the point of the same piece, E, and by the same screw bolt that holds the bow, L. From this bolt this iron rises towards the reel, S, at an angle of say 30°, until it reaches it; then it is bent so as to pass under the reel as far back as the blade, and to fit the curve of it (the reel). From the bolt in the point aforesaid, the other end of this iron extends, say nine inches, along the inside of the piece E, where it is held by another screw bolt, M, and where it has a groove or slot in it to admit the other ends being raised or lowered (turning on the point screw, K, as a pivot) to suit the height of the reel. By means of the bow to bear off the standing wheat, and the iron to throw the wheat to be cut within the powers of the reel, the required separation is made complete."

The answer denies that the arrangement of the divider used by defendants for separating the grain to be cut from that to be left standing is the same in construction or mode of operation as that claimed by complainant, or a colorable evasion of said claim, and avers that it is a different and distinct arrangement, invented by J. H. Manny, after several years' experiments.

It would be a difficult task to make intelligible to the uninitiated the construction of a very complex machine, without the aid of models or diagrams. But, for the purposes of the case, the divider, although a component part of the great complex machine called the reaper, may be considered by itself as a machine or combination of devices attached to the reaper to perform certain functions necessary to complete the whole operation. In order to ascertain whether the divider

used by defendants infringes that of the complainant, we must first inquire whether McCormick was the first to invent the machine called a divider, performing the functions required, or has merely improved a known machine by some peculiar combination of mechanical devices which perform the same functions in a better manner.

If he be the original inventor of the device or machine called the divider, he will have a right to treat as infringers all who make dividers operating on the same principle, and performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement of the original, and patentable as such. But if the invention claimed be itself but an improvement on a known machine by a mere change of form or combination of parts, the patentee cannot treat another as an infringer who has improved the original machine by use of a different form or combination performing the same functions. The inventor of the first improvement cannot invoke the doctrine of equivalents to suppress all other improvements which are not mere colorable invasions of the first.

That portion of a reaping-machine called the divider or separator may be described as a pointed, wedge-formed instrument, which is attached by its butt at that extremity of the cutting apparatus which runs in the grain, in such manner that its point projects in advance of the cutting apparatus, and enters the standing grain. Its functions, where the grain stands erect, are to divide it into two portions, one of which is borne inwards by the inner side of the wedge-formed implement within the range of the cutting apparatus and of the reel, in case the machine is fitted with a reel; the other portion of the grain is borne outwards by the outer side of the divider, so as to be passed by that portion of the machine which lies behind the cutting apparatus. When grain is inclined outwards, the function of the divider is not only merely to divide the grain into portions; but also to raise up the inclined stalks of the grain, below which the divider passes. When the grain inclines inwards, the function of the divider is not only to divide the mass, but also to raise up the inclined stalks of grain beneath which the divider passes, and to bear them outwards without the range of the reel, if the machine has a reel, and of the cutting apparatus. When grain, in addition to being inclined, is also entangled, the divider not only separates and raises the stalks, but also tends to disentangle them. The lower face of a divider also performs the function of a shoe or runner, to prevent the cutting apparatus from digging into the earth when, by any accidental movement of the machine, it would otherwise do so. The divider also performs the func-

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tion of limiting or regulating the width of the swath, by raising up and turning inwards those stalks of grain which, from their inclination outwards, would otherwise escape the action of the cutter; and by raising up and turning outwards those stalks of grain which, from their inclination inwards, would otherwise be within the range of the cutter. All dividers perform these functions in a greater or less degree. The English patent of Dobbs, in 1814, had dividers of wood or metal. The outer diverging rod rose as it extended back, and diverged laterally from the point, to raise the stalks of grain inclining inwards, and to turn them off from the other parts of the machine. The patent of Charles Phillips, of 1841, had a divider, shaped like a wedge, performing the same function, turning the grain aside on both sides of the machine, and raising it up. Ambler's machine had a triangular divider performing the same functions, as also the machines of Hussey, Schnebly, and that of McCormick, patented in 1834, which is now public property. The present claim is for the combination of this bow with a dividing-iron of a certain form, and for nothing more. This dividing-iron is but a new form or substitute for that side of the triangle or wedge which in other machines performed the function of separating the inside grain and raising it to the cutters.

It is described in the patent as having these peculiarities to distinguish it from those that preceded it:

1. It rises at an angle of about thirty degrees till it reaches the reel.
2. It is curved under the reel.
3. It is made adjustable by means of a slot, so as to suit the different heights of the reel.

Its function is to raise and support the grain along the inner edge of the divider, at the maximum elevation consistent with the employment of the reel. As a form or combination of devices it is new, and no doubt an improvement, and therefore the proper subject of a patent. But as a claim for a combination of mechanical devices or parts, it is not infringed by one who uses a part of the combination. Nor can it challenge other improvements of the same machine, different in form or combination, as infringements, because they perform the same functions as well or better, by calling them equivalents. The machine constructed under defendants' patent has a wooden projection, somewhat in the form of a wedge, extended beyond the cutting-sickles some three feet, and which, from the point in front, rises as it approaches the cutting apparatus, with a small curve, (not approaching to an angle of thirty degrees,) so as to raise the leaning

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grain. It has no dividing-iron, nor substitute or equivalent possessing the peculiar qualities of that instrument. It more resembles the wedges in use before McCormick's patent of 1845. As an improvement on former machines, it has some peculiarities of form and construction, but it does not adopt the combination of complainant's patent. It is a distinct improvement, probably inferior to McCormick's, but certainly no infringement of his claim.

II. The fifth claim of complainant's patent of 1845, which the bill charges the defendants with infringing, is as follows:

"5. I claim setting the lower end of the reel-post, R, behind the blade, curving it at R<sup>2</sup>, and leaning it forward at top, thereby favoring the cutting, and enabling me to brace it at top by the front brace, S, as described, which I claim in combination with the post."

In the reaping-machine of McCormick's original patent of 1834, he had placed the reel-post in front of the cutters. This position of the post interfered with the action of the reel in drawing the grain to the cutters, especially in gathering tangled grain. In order to remedy this defect of his own machine, he set the post farther back, and braced it as described.

Defendant does not support his reel by posts, as was done by McCormick. He uses the horizontal reel-bearer, connected by a frame with the hinder part of the machine. This device for supporting the reel was invented and used many years before McCormick's first patent of 1834. It had no reel-post situated as in his patent, and encountered none of the evils remedied by the change in its position. This attempt to treat the earlier and better device used by defendant as an infringement of a later device to obviate a difficulty unknown to the first, is an application of the doctrine of equivalents which needs no further comment.

III. The bill charges defendants with infringing the second claim of the reissued patent of 1853. This claim is as follows:

"2. And I also claim the combination of the reel for gathering the grain to the cutting apparatus and depositing it on the platform, with the seat or position for the raker *arranged and located as described*, or the equivalent thereof, to enable the raker to rake the grain from the platform, and deliver and lay it on the ground at the side of the machine, as described."

If this claim be construed to include all machines which have a reel and a raker's seat, it is void for want of novelty. Hite, Woodward, Randall, and Schnebly had invented and publicly used reaping-machines which had reels and a place for the raker on the machine. But the true construction of this claim, and the only one which will

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support its validity, is to treat it as a claim for a combination of the reel with a seat "arranged and located as described." And such was the construction given to it by the defendant himself, when the Commissioner had refused to grant him a patent claiming the mere combination of a reel and a raker's seat, "because such a combination was not patentable, the functions of each device having no necessary connection with the other."

This arrangement for the location of a raker's seat was made "by placing the gearing and crank forward of the driving-wheel, and thus carrying the driving-wheel further back than heretofore, and sufficiently so to balance the rear part of the frame and the raker thereon."

By this device he obtained a place for the raker over the finger-bar, just back of the driving-wheel, and at the end of the reel, where he could have free access to the grain, and rake it off the machine at right angles to the swath. It was by limiting his claim to this arrangement, location, and combination that the complainant obtained his patent, and without this construction of it the claim is neither patentable nor original.

The arrangement, combination, and location of the raker's seat by defendants has been patented to Mauny as an independent contrivance and distinct invention. The place for the raker is obtained by a change in the shape of the platform different from any before employed. It differs from the complainant's device in principle as well as in form and combination. The raker's seat is on a different part of the machine, where he may stand without destroying the balance of the machine or tilting it up. It requires no modification of the reel. It requires no such combination or modification of parts of the machine in order to find a place for the raker, which is an essential part of complainant's claim.

It is substantially different, both in form and in combination, from that claimed by the complainant, and is consequently no infringement of his patent.

Concurring, as we do, in the opinion and decision of the court below on these several points, the decree is affirmed with costs.

Mr. Justice DANIEL, dissenting.

In the opinion of this court just delivered I do not concur. Protracted as the discussion by counsel in the case has been, the real grounds for controversy between the parties are obvious, and comprised within quite a limited compass. The unusual display of mechanical ingenuity, and the comment upon its progress exhibited in



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the conduct of this cause, whilst they evince great zeal and industry, and may afford entertainment to the curious on such subjects, are in a great degree irrelevant to and beside any legitimate inquiry which an adjustment of the claims of the parties either imposes or warrants. In the decree of the court below, as well as in the arguments in this court, it has been conceded that the patent of the appellant is strictly legal. This *concession* necessarily excludes, and in legal acceptation *concludes*, all inquiry as to the right of the appellant to the full benefit of his invention, either as an original or a combination, and renders unnecessary, and irregular and improper, any and every comparison between that invention and previous claims to discovery and improvement, having in view the same results and the same or merely equivalent modes of producing them. This *concession*, therefore, narrows down and confines the proper investigation before this court, as it should have restricted that before the Circuit Court, to the single question whether the machine complained of as an infringement, either in theory, in construction, or in operation, was the same with the improvement invented by the appellant, for the benefit or the reward for which the law had given its guarantee? This was the proper inquiry before the court below; is the only regular inquiry here. All others connected with previous inventions were and must be irregular, and are excluded and forbidden by the concession that the patent of the appellant is legal and valid. To guide them in this, the only legitimate inquiry, this court has had before them a species of evidence of all others best calculated to conduct them to the truth—evidence superior to and unaffected by the interests or prejudices of partisans, or by the opinions (the reveries, they may often be called) of a class of men styled experts; men as often skillful and effective in producing obscurity and error as in the elucidation of truth. No witnesses can testify so clearly and so impartially as do the subjects (though mute) concerning which a controversy about identity or dissimilarity is pending. These witnesses have been produced, and their testimony eagerly and keenly scrutinized; and that testimony establishes, in my judgment, with a force and certainty which no ingenuity can either withstand or evade, that the machine put in operation by the appellees is a palpable infringement of the rights of the appellant; that in theory or principle, in structure, in the modes of operation, and in the results proposed, it is essentially and, with some insignificant and merely apparent diversity, *formally identical*, at least in one important particular, with the invention secured by the government to the appellant, and admitted by the appellees and by the court to have been rightfully and legally guaranteed to him.

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That portion of the machines put in operation by each of the parties to this controversy, and which constitutes the most material subject of contention in this cause, consists of what, in the description and specification of the respective patents, is called a divider. The function and the value of this divider are experienced in separating the stalks of wheat designed to be immediately severed by the cutters, from those which do not come within their immediate and regular operation, but which it is desired should be left to the future or succeeding action of the machine. It frequently happens, in fields of luxurious growth, that from high winds, heavy rains, and even from its own weight, wheat is pressed down, and becomes, in rustic phrase, *lodged*. In this condition, the stalks and heads of the wheat, on both sides of a line described by the track of a machine, will become entangled, and inclined in various and opposite directions, accordingly as the momentum which displaces the natural position of the growing crops has been applied. In such a condition of the wheat, any process by which a portion of the crop should be torn apart from portions with which it was intertwined, would prove highly detrimental, inasmuch as it would necessarily increase the irregularity in the position of the wheat not cut and standing outside of the regular track of the machine, and by violently and rapidly rending apart the tangled straw, would shatter and waste the grain in each division, creating thereby a serious diminution in the yield or product. In order to prevent these mischiefs by disentangling the wheat, by separating that designed to be immediately severed from that reserved for the succeeding action of the machine, and by raising up the former and bringing it within the scope and operation of the reel and the cutters, was devised an addition or appendage to the reaper, called the *divider*. The importance of this appendage, both to the success of the reaper and on account of its real utility in practice, cannot be, with reason, called in question. Its essential importance is sufficiently evinced, by the zeal and industry displayed, and the extraordinary expense which must have been incurred in this controversy. The divider of McCormick may be thus substantially described: A pointed instrument or structure, called by the patentee a *bow*, formed of strong, hard wood, confined in front, and projecting so far in advance of the cutters as to enter the wheat in time to effect its preparation for the approach of the cutters. This bow is extended in a curvilinear form on the outer side of the machine, next the grain to be separated from the cutters, and is gradually elevated from the point in front to a degree increasing towards the rear of the machine, sufficient to disentangle the straw, and place it in a position proper for the sweep or

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action of the returning machine. On the interior side of the machine, or that on which the grain is to be severed, the divider of McCormick is constructed of a bar of iron, confined at the same point with the wooden bow above mentioned as operating externally; and this iron bar is capable of being so adjusted as to disentangle and raise the wheat separated from that standing on the exterior of the machine, and by a lateral and angular direction given this adjustable bar, as well as by its vertical extension, it embraces and secures the wheat on the interior side of the machine, and presses it to the action of the reel and the cutters.

Such as has been just described, I hold to be McCormick's divider, and such, too, its operation and effects. Let us now compare them with the structure and operation of the structure complained of as an infringement, in order to ascertain how far the rival claims of the parties are identical or diverse. And this comparison will be most fairly and satisfactorily accomplished, and the results most clearly established, by a recurrence to that silent but irresistible testimony already referred to,—the testimony of the machines themselves.

On Manny's machine, the divider on the exterior side, or the side of the standing grain, is formed of a piece of timber which, according as fancy shall dictate, may be denominated a *bow*, or by any other appellation which may be preferred. This piece of timber, like the divider of McCormick's machine, is confined in front, and penetrates the standing grain in advance of the cutters. Like McCormick's divider, it rises obliquely from the stationary point in front, towards the rear of the machine, to a degree intended to be sufficient to separate and support the straw, and in the same manner diverges in an angle supposed to be great enough to secure that separation, and to prevent the breaking down of any portion of the straw by being pressed to the earth, or by being torn away by the machine in its progress. On the interior side or section of Manny's divider, there is no adjustable iron bar or rod, as a part of the divider; but for this is substituted a piece of timber or a board, connected and confined in the front of the machine, with the wooden fixture extended on the outside next the standing grain; and from that point of connection this substituted board is protracted in a diverging angle, and to a length corresponding exactly with those of McCormick's adjustable iron bar, and, like the latter, it is gradually curved to a vertical elevation intended to be great enough to separate and raise up the wheat designed to be immediately severed by the cutters from that reserved for further action of the machine. The only differences between this fixture and the adjustable bar of McCormick (and they are merely

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pretended and deceptive) are these: that the former, instead of being of *iron*, is made of wood; that instead of being movable or adjustable, it is stationary; that it is broader on its lateral surface than is that of the iron portion of McCormick's divider, and on that lateral surface is somewhat curved. But these differences, correctly apprehended, are mere disguises, and were indispensable to shelter the possession of property evidently pirated from the rightful owner. Had the appellees openly taken McCormick's iron instrument, adjusted it so that it could be graduated in practice to the quality or height of the grain in which the machine was to operate, and placed it at an angle suited to the conducting of the grain within the action of the reel and cutters, there would in so bold a piracy have been left no ground, no pretext even, for contest or cavil. Hence the effort at distinctions or differences attempted in the case. To my mind, it seems impossible not to perceive that they are entirely unfounded, and cannot for one instant conceal these truths, viz., that the instrument or structure called a divider, introduced and practiced by the appellees, is, in *theory* or principle, in *manner* of its operation, in its *effects* or *results*, and it may almost be said in its *minute constituent portions and formation*, identical with the instrument invented by and patented to the appellant, and therefore an infringement of the rights guaranteed to him by the government.

Entertaining this opinion, I must dissent from the decision of the court in this cause, and declare it as my opinion that the decree of the Circuit Court should be reversed and this cause remanded, with instructions to reinstate the injunction formerly awarded by the Circuit Court, and to direct an account between the parties. The only legitimate inquiry for the court is this: whether the improvement of McCormick called a divider, and the instrument claimed and put in operation by Manny, are essentially the same, or are essentially or substantially different. All that has been said (and a great deal has been said) about the comparative superiority or inferiority of inventions or improvements previous to those patented to McCormick, is wholly irrelevant and out of this cause; and is calculated only to confound and to divert the attention from the only proper subject of investigation here, which is the rightfulness of the claims advanced by the appellant and appellees in this cause, relatively to themselves, and to no others.

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Statement of the case.

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## ROSS WINANS, PLAINTIFF IN ERROR, v. THE NEW YORK AND ERIE RAILROAD COMPANY.

(21 Howard, 88.)

1. Where objection was made, during the trial of a cause, to the reception of the deposition of a witness, which had been taken under a commission, it was properly overruled, because the rules of practice in the Circuit Court of New-York give time and opportunity to move for a suppression of the deposition, or a reëxamination of the witness.
2. The paper which the witness referred to, but did not annex to his deposition, was not in his power.
3. In the trial of a suit for the violation of a patent-right, the court cannot be compelled to receive the evidence of experts as to how a patent ought to be construed. The judge may obtain information from them, if he desire it.
4. Winans' patent for "a new and useful improvement in the construction of cars or carriages intended to travel upon railroads," was for the manner of arranging and connecting the eight wheels of a railroad carriage, for the purpose of enabling burden and passenger cars to pursue a more smooth, even, and safe course over the curves and irregularities of a railroad. And it was proper to instruct the jury, that if they found, from the evidence, that before the time when Winans claimed to have made the discovery, carriages with eight wheels, arranged and connected substantially in the same manner, and upon the same mechanical principles with those described in the patent, were known and publicly used; Winans was not entitled to recover.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Northern District of New York.

It was an action brought by Winans against the railroad company for a violation of his patent for a new and useful improvement in the construction of cars or carriages intended to travel upon railroads.

In order that the reader may understand the nature of the improvement, the description of it, as given by Winans himself, is here inserted, because it is remarkably clear and well drawn up.

The following is the schedule referred to in the letters patent:

"To all whom it may concern : Be it known, that I, Ross Winans, civil engineer, of the city of Baltimore, in the State of Maryland, have invented a new and useful improvement in the construction of cars or carriages intended to travel upon railroads; which improvement is particularly adapted to passenger cars, as will more fully appear by an exposition of the difficulties heretofore experienced in the running of such cars at high velocities, which exposition I think it best to give in this specification, for the purpose of exemplifying the more clearly the object of my said improvement.

"In the construction of all railroads in this country which extend to any considerable distance, it has been found necessary to admit of

## Statement of the case.

lateral curvatures, the radius of which is sometimes but a few hundred feet; and it becomes important, therefore, so to construct the cars as to enable them to overcome the difficulties presented by such curvatures, and to adapt them for running with the least friction practicable upon all parts of the road. The friction to which I now allude is that which arises from the contact between the flanches of the wheels and the rails, which, when it occurs, causes a great loss of power, and a rapid destruction of, or injury to, both the wheel and the rail, and is otherwise injurious. The high velocities attained by the improvements made in locomotive engines, and which are not only sanctioned, but demanded, by public opinion, render it necessary that certain points of construction and arrangement, both in the roads and wheels, which were not viewed as important at former rates of traveling, should now receive special attention. The greater momentum of the load, and the intensity of the shocks and concussions, which are unavoidable even under the best constructions, are among those circumstances which must not be neglected, as the liability to accident is thereby not only greatly increased, but the consequences to be apprehended much more serious. The passenger and other cars in general use upon railroads have four wheels, the axles of which are placed from three and a half to five feet apart; this distance being governed by the nature of the road upon which they run, and other considerations. When the cars are so constructed that the axles retain their parallelism, and are at a considerable distance apart, there is a necessary tendency in the flanches of the wheels to come into contact with the rails, especially on the curvatures of least radius, as the axles then vary more from the direction of the radii. From this consideration, when taken alone, it would appear to be best to place the axles as near to each other as possible, thus causing them to approach more nearly to the direction of the radii of the curves, and the planes of the wheels to conform to the line of the rails. There are, however, other circumstances, which must not be overlooked in their constructions. I have already alluded to the increased force of the shocks from obstructions at high velocities; and, whatever care may be taken, there will be inequalities in the rails and wheels, which, though small, are numerous, and the perpetual operation of which produces effects which cannot be disregarded. The greater the distance between the axles, while the length of the body remains the same, the less is the influence of these shocks or concussions; and this has led, in many instances, to the placing them in passenger cars, at or near their extreme ends. Now, however, a compromise is most commonly made between the evils

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resulting from a considerable separation and a near approach, as, by the modes of construction now in use, one of the advantages must be sacrificed to the other. But it is not to the lateral curvatures and inequalities of the road alone that the foregoing remarks apply. The incessant vibration felt in traveling over a railroad is mainly dependent upon the vertical motion of the cars in surmounting those numerous though minute obstructions which unavoidably exist. The nearer the axles are placed to each other, the greater is the effect of this motion upon the passengers, and the greater its power to derange the machinery and the road. It becomes very important, therefore, both as regards comfort, safety, and economy, to devise a mode of combining the advantages derived from placing the axles at a considerable distance apart, with those of allowing them to be situated near to each other. It has been attempted, and with some success, to correct the tendency of the flanches to come into contact with the rails, on curved and other parts of the road, by making the tread of the wheel conical; and if the traveling upon railroads was not required to be very rapid, this would so far prove an effectual corrective, as the two rails would find diameters upon the wheels which would correspond with the difference in length, the constant tendency to deviation being as constantly counteracted by this construction; but at high velocities, the momentum of the body in motion tends so powerfully to carry it in a right line, as to cause the wheel on the longer rail to ascend considerably above that part of the cone which corresponds therewith. The consequence of this is a continued serpentine motion, principally, but not entirely, in a lateral direction; nor is this confined to the curved parts of the road, but it exists to an equal or greater extent upon those which are straight, especially when the axles are near to each other, the irregularities before spoken of constantly changing the direct course of the wheels, whilst there is no general curvature of the rails to counteract it. To avoid this effect, and the unpleasant motion and tendency to derangement consequent upon it, an additional motive is furnished for placing the axles at a considerable distance apart.

“The object of my invention is, among other things, to make such an adjustment or arrangement of the wheels and axles as shall cause the body of the car or carriage to pursue a more smooth, even, direct, and safe course, than it does as cars are ordinarily constructed, both over the curved and straight parts of the road, by the before-mentioned desideratum of combining the advantages of the near and distant coupling of the axles, and other means to be hereinafter described. For this purpose, I construct two bearing carriages, each

## Statement of the case.

with four wheels, which are to sustain the body of the passenger or other car by placing one of them at or near each end of it, in a way to be presently described. The two wheels on either side of these carriages are to be placed very near to each other; the spaces between their flanches need to be greater than is necessary to prevent their contact with each other. These wheels I connect together by means of a very strong spring,—say double the usual strength employed for ordinary cars,—the ends of which spring are bolted, or otherwise secured, to the upper sides of the boxes, which rest on the journals of the axles, the longer leaves of the springs being placed downwards, and surmounted by the shorter leaves. Having thus connected two pairs of wheels together, I unite them into a four-wheel bearing carriage, by means of their axles, and a bolster of the proper length extending across, between the two pairs of wheels, from the center of one spring to that of the other, and securely fastened to the tops of them. This bolster must be of sufficient strength to bear a load upon its center of four or five tons. Upon this first bolster I place another of equal strength, and connect the two together by a center pin or bolt passing down through them, and thus allowing them to swivel or turn upon each other in the manner of the front bolster of a common road wagon. I prefer making these bolsters of wrought or cast iron; wood, however, may be used. I prepare each of the bearing carriages in precisely the same way. The body of the passenger or other car I make of double the ordinary length of those which run on four wheels, and capable of carrying double their load. This body I place so as to rest its whole weight upon the two upper bolsters of the two before-mentioned bearing carriages or running gear. I sometimes place these bolsters so far within the ends of the body of the car as to bring all the wheels under it, and in this case less strength is necessary in the car body than when the bolster is situated at its extreme ends. In some cases, however, I place the bolster so far without the body of the car, at either end, as to allow the latter to hang down between the two sets of wheels or bearing carriages, and to run, if desired, within a foot of the rails.

“When this is done, a strong frame-work projects out from either end of the car or carriage body, and rests upon the upper bolsters of the two bearing carriages. This last arrangement, by which the body of the car is hung so low-down, manifestly affords a great security to the passengers, exempting them in a great degree from those accidents to which they are liable when the load is raised. Several bodies may be connected, or rest on a common frame, and be supported on the bearing carriage, in a manner similar to that of a single



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body. When the bolsters of the bearing carriages are placed under the extreme ends of the body, the relief from shocks and concussions, and from lateral vibrations, is greater than it is when the bolsters are placed between the middle and the ends of the body, and this relief is not materially varied by increasing or diminishing the length of the body, while the extreme ends of it continue to rest on the bolsters of the bearing cars, the load supposed to be equally distributed over the entire length of the body.

“Although I prefer the use of a single spring to a pair of wheels as above described; instead of the ordinary spring to each wheel, and consider it as more simple, cheap, and convenient than any other arrangement, the end which I have in view may nevertheless be obtained by constructing the bearing carriages in any of the modes usually practiced, provided that the fore and hind wheels of each of them be placed very near together; because the closeness of the fore and hind wheels of each bearing carriage, taken in connection with the use of two bearing carriages coupled remotely from each other as can conveniently be done, for the support of one body, with a view to the objects and on the principles herein set forth, is considered by me as a most important feature of my invention; for, by the contiguity of the fore and hind wheels of each bearing carriage, while the two bearing carriages may be at any desirable distance apart, the lateral friction from the rubbing of the flanches against the rails is most effectually avoided, whilst at the same time all the advantages attendant upon placing the axles of a four-wheeled car far apart are thus obtained. The bearing of the load on the center of the bolster, which also is the center of each bearing carriage, likewise affords great relief from the shocks occasioned by the percussions of the wheels on protuberant parts of the rails or other objects, and from the vibrations consequent to the use of coned wheels; as the lateral and vertical movements of the body of the car resulting from the above causes are much diminished. The two wheels on either side of one of the bearing carriages may, from their proximity, be considered as acting like a single wheel, and as these two bearing carriages may be placed at any distance from each other, consistent with the required strength of the body of the car, it is evident that all the advantage is obtained which results from having the two axles of a four-wheeled car at a distance from each other, whilst its inconveniences are avoided. Another advantage of this car, compared with those in common use, and which is viewed by me as very important, is the increased safety afforded by it to passengers, not only from the diminished liability to breakage, or derangement in the frame-work, but

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also from the less disastrous consequences to be apprehended from the breaking of a wheel, axle, or other part of the running gear, as the car body depends for its support and safety upon a greater number of wheels and bearing points on the road. I do not claim as my invention the running of cars or carriages upon eight wheels, this having been previously done; not, however, in the manner or for the purposes herein described, but merely with a view of distributing the weight, carried more evenly upon a rail or other road, and for objects distinct in character from those which I have had in view, as hereinbefore set forth. Nor have the wheels, when thus increased in number, been so arranged and connected with each other, either by design or accident, as to accomplish this purpose. What I claim, therefore, as my invention, and for which I ask a patent, is the before-described manner of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad car, so as to accomplish the end proposed by the means set forth, or by any others which are analogous and dependent upon the same principles.

“ROSS WINANS.”

The patent was originally issued in 1834, and continued regularly until 1848, when it was extended by the Commissioner of Patents for seven years from the 1st of October, 1848.

The defendants pleaded the general issue, and gave notice under the statute that Winans was not the original inventor, but that, substantially, the same contrivance was described in many books, known to many persons, and used in many places. Other grounds of defense were also mentioned. The case came on for trial in June, 1856, when the jury found a verdict for the defendants.

The first exception was to the admission of the testimony of Conduce Gatch, a witness for the defendant, who had been examined under a commission. The questions and answers were as follows:

“One hundredth cross-interrogatory. Did you, before answering the said direct interrogatories, or the said cross-interrogatories, or any of them, see or read, or hear read, or hear stated, any part of, or the substance of any part of, any testimony given or affidavit made by you, or by any other person or persons, in the case of Ross Winans against the Eastern Railroad Company, or in the case of Ross Winans against Orsamus Eaton and others, or in the case of Ross Winans against the New York and Harlem Railroad Company? And if yea, in what case was such testimony or affidavit given, and by whom was the same read, or shown, or stated to you, or to any other person or persons in your presence or hearing?”

To this, Gatch answered:

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“X 100th. To the one hundredth cross-interrogatory he saith: At the time of the Commissioner’s reading to me the direct interrogatories, when I was before him for the purpose of giving my deposition in this case, it struck me forcibly that the questions, if not identically the same, were the same in substance of those I had answered in the case of Winans against the New York and Harlem Railroad Company; and upon ascertaining that the Commissioner had a copy of the answers I then gave, and for the purpose of facilitating the execution of this commission, I adopted the answers before referred to, altering them in some particulars, so as to be more explicit; and I now declare that, independent of seeing the copy of my answers, the facts I have herein testified to are true.”

The one hundred and second cross-interrogatory was too long to be inserted. It inquired whether he had heard, read, or stated, any paper, &c.; and if any suggestion had been made in writing, &c., to annex a copy of such writing.

To which Gatch answered:

“To the one hundred and second cross-interrogatory he saith: I refer to my answer to the one hundredth cross-interrogatory.”

Upon the trial, the counsel for the plaintiff moved to exclude the whole testimony of Gatch, because he did not annex the writing to his answer. But the court overruled the objection and admitted the evidence, which constituted the first exception.

After this, there were thirty-one exceptions taken, viz., nine to the refusal of the court to allow the plaintiff to prove certain matters which he offered to prove, fourteen to various parts of the charge of the court, and eight to refusals by the court to charge the jury in accordance with the prayers of the plaintiff.

As the first class of exceptions is particularly noticed in the opinion of this court, it is proper to mention the circumstances under which they were taken.

After the defendants had rested their case, and after the plaintiff had thereafter put in a part of his evidence in reply, the plaintiff made to the court the following offer to prove the facts and matters stated in said offer, namely:

“1. The plaintiff, by his counsel, offers to prove that the action of coned wheels, specified in the patent, requires the wheels to be fast on, and turned with their axles. That at the time the plaintiff’s patent was granted, it was the general practice, in constructing cars for running at high velocities, to construct them with coned wheels, fast on and turning with their axles, and that non-coned wheels, or coned wheels turning on their axles, are not equivalent for, and cannot pro-

## Opinion of the court.

duce, the effects described in the patent as peculiar to the use of coned wheels."

The defendants objected to the proving of any of the facts and matters stated in said offer, on the ground that all of said facts and matters were immaterial and irrelevant, and the court sustained said objection, and refused to allow the plaintiff to prove any of the facts and matters stated in said offer, to which sustaining and refusal the plaintiff then and there duly and in due time excepted.

The plaintiff then made to the court the following offer to prove the facts and matters stated in said offer, namely:

"2. The plaintiff, by his counsel, offers to prove, that the end proposed in the specification of the plaintiff's patent cannot be effected by a car having two swivelling four-wheeled tracks connected with a body or platform, unless the wheels of the bearing carriages are coned on their treads, and are fast on, and turn with their axles."

The defendants objected to the proving of any of the facts and matters stated in said last-mentioned offer, on the ground that all of said facts and matters were immaterial and irrelevant; and the court sustained said last-mentioned objection, and refused to allow the plaintiff to prove any of the facts and matters stated in said last-mentioned offer, to which last-mentioned sustaining and refusal the plaintiff then and there duly and in due time excepted.

These two offers of proof by the plaintiff sufficiently show the character of the proof offered, and which the court ruled out. The remaining seven were similar in their character.

The exceptions to the charge of the court when construing the patent are too voluminous to be inserted, as are also the prayers to the court on behalf of the plaintiff.

Upon all these exceptions the case came up to this court.

It was argued by *Mr. Blatchford* and *Mr. Keller*, for the plaintiff in error, and by *Mr. Davis* and *Mr. Whiting*, for the defendants.

In the argument of a patent case, it is impossible to give to the reader a clear idea of the arguments, because drawings and models were produced, without which all attempts at explanation would be superfluous.

Mr. Justice GRIER delivered the opinion of the court.

The patent which the defendants are charged to have infringed purports to be "for a new and useful improvement in the construction of cars or carriages intended to travel upon railroads."

The specification commences with an enumeration of the difficulties

## Opinion of the court.

attending short curves in railroads from friction, and the consequent necessity of placing the wheels, where four only are used, near together. But in high velocities the shocks from obstructions or inequalities on the rails are thus greatly increased; so that a compromise is usually made between the evils consequent on too great a separation and too near approach, wherein the advantage of one is necessarily sacrificed for the sake of the other. The incessant vibration felt in traveling on railroad cars is mainly imputed to the minute obstructions which unavoidably exist, and the approximation of the wheels necessary to avoid friction tends to increase the effect of this motion, and its power to derange the machinery of the road.

The important object which the plaintiff's invention seeks to obtain, as regards comfort, safety, and economy, "is to devise a mode of combining the advantages derived from placing the axles at a considerable distance, with those of allowing them to be situated near each other."

The specification then states the methods heretofore used to remedy these difficulties; such as making the track wheels conical, which, in case of slow traveling, has been found an effectual correction; but in high velocities it caused a serpentine motion, not only on curves, but where the track was straight. To avoid this effect, an additional motive is furnished for placing the axles at a considerable distance apart.

For this purpose the patentee proposes to construct two bearing carriages, each with four wheels, to sustain the body of the cars, one at or near each end thereof; the two wheels on either side of these carriages to be placed very near each other. These wheels may be connected by a strong spring, double the usual strength employed for ordinary cars. The use of this spring, though preferable, is not absolutely required, as the end in view may be obtained by constructing the bearing carriages in any of the modes usually practiced, provided the fore and hind wheels of each of the carriages be placed near together; because the closeness of the fore and hind wheels of each bearing carriage, coupled remotely from each other, is considered as the most important feature of the invention.

On each of these carriages a bolster is placed, on which the car body rests, connected with each by a center pin or bolt passing down through them, thus allowing them to swivel or turn upon each other.

After this description of the improvement contemplated, and the objects to be gained by it, (of which we have given a brief summary,) the specification concludes with the following disclaimer and statement of what the patentee claims to have invented:

## Opinion of the court.

"I do not claim as my invention the running of cars or carriages upon eight wheels, this having been previously done; not, however, in the manner or for the purposes herein described, but merely with a view of distributing the weight carried more evenly upon a rail or other road, and for objects distinct in character from those which I have had in view, as hereinbefore set forth. Nor have the wheels, when thus increased in number, been so arranged and connected with each other, either by design or accident, as to accomplish this purpose. What I claim, therefore, as my invention, and for which I ask a patent, is the before-described manner of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad car, so as to accomplish the end proposed by the means set forth, or by any others which are analogous and dependent upon the same principles."

The defense set up in the pleadings does not deny that defendants use cars constructed as described in the patent, but takes issue on the originality of the invention, averring, among numerous other matters, that the same, or substantially the same, improvement had been previously made and used on the Quincy Railroad, near Boston.

The first bill of exceptions taken on the trial is to the refusal of the court to reject a deposition taken on interrogatories, because the witness had not annexed to it a copy of a former deposition, which, in answer to a previous interrogatory, he admitted he had seen and had used to refresh his memory.

There are two sufficient reasons why this exception cannot be sustained. 1. By the rules of practice in force in the Circuit Court, such an objection cannot be made on the trial of a cause, when the party, as in this case, had full time and opportunity to move for a suppression of the deposition or a reëxamination of the witness.

And, secondly, the paper was not in the power of the witness, but in that of the Commissioner, or the plaintiff himself, who might have used it if he thought proper.

After the parties had each given evidence tending to prove the issues between them, and the defendants had closed their testimony, the plaintiff's counsel made nine distinct offers of proof, which were severally overruled as irrelevant, and exception taken.

They then proposed eight several instructions, which they requested the court to give to the jury, and took exceptions to the court's refusal. Besides all this, the charge was parcelled out into fourteen paragraphs, and an exception taken to each.

To state each one of these thirty-one propositions at length, and discuss them severally, would be a tedious as well as an unprofitable labor.

## Opinion of the court.

There was in fact but one question to be decided by the court, viz., the construction of the patent; the question of novelty being the fact to be passed on by the jury.

The testimony of experts, which was rejected, had no relevancy to the facts on which the jury were to pass, but seemed rather to be intended to instruct the court on some mechanical facts or principles on which the court needed no instruction, or to teach them what was the true construction of the patent.

Experts may be examined to explain terms of art, and the state of the art at any given time. They may explain to the court and jury the machines, models, or drawings exhibited. They may point out the difference or identity of the mechanical devices involved in their construction. The maxim of "*cuique in sua arte credendum*" permits them to be examined to questions of art or science peculiar to their trade or profession; but professors or mechanics cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing. A judge may obtain information from them, if he desire it, on matters which he does not clearly comprehend, . . . but cannot be compelled to receive their opinions as matter of evidence. Experience has shown that opposite opinions of persons professing to be experts may be obtained to any amount; and it often occurs that not only many days, but even weeks, are consumed in cross-examinations, to test the skill or knowledge of such witnesses, and the correctness of their opinions, wasting the time and wearying the patience of both court and jury, and perplexing, instead of elucidating, the questions involved in the issue. . . .

If the construction given by the court to the specification be correct, and in fact the only construction of which it is capable, as we think it is, it would be wholly superfluous to examine experts to teach the court, what they could clearly perceive without such information, that the necessity for coned wheels to avoid friction on curves was a consequence of the fact that the wheels were fixed to the axle.

The improvement claimed by the patent being a device to remedy, among other things, the serpentine or wobbling motion of such wheels in high velocities, the testimony offered concerning them, if it would have any effect at all, would tend only to mislead both court and jury from the only issue in the case.

The following extracts from the charge will show that the judge has given the only construction which the language of this specification will admit, and one which had been previously given by Mr. Chief Justice Taney in 1839, and again by Mr. Justice Nelson:

"According to the import and true construction of the plaintiff's

## Opinion of the court.

patent and specification, he claims to be the first inventor of 'a new and useful improvement in the construction of cars and carriages intended to travel upon railroads,' which improvement consists in *the manner of arranging and connecting* the eight wheels, which constitute the two bearing carriages, with a railroad car, the object of which is to make such an adjustment of the wheels, axles, and bearings of the car as shall enable a car with a comparatively long body to pass curves with greater facility and safety, and less friction, and as shall, at the same time, cause the body of the car to pursue a more smooth, even, direct, and safe course over the curvatures and irregularities, and over the straight parts of the road.

"*The manner* of such arrangement and connection is to place upon the upper bolsters of two bearing carriages, each having four wheels, with the flanches of each pair of wheels very near together; the body of a car, so as to rest its weight and have the bearing of the load upon the center or central portion of the bolsters, being also the center or central portion of the bearing carriages; the bolsters of the bearing carriages and car body, respectively, being connected by center pins or bolts, so as to allow them to swivel and turn upon each other; in the manner of the front bolster of a common road wagon, and the bolsters being placed at, near, or beyond the ends of the body.

"And the closeness of the fore and hind wheels of each of the two bearing carriages, coupled as remotely from each other as may be desired, or can conveniently be done, for the support of one body, is a most important feature of the invention, with a view to the objects and on the principles set forth in the specification.

"The patentee does not claim to be the inventor of a car body (either for freight or for passengers) of a new or peculiar construction in size or form, nor of any single and wholly separate part of the entire car; but he claims as his invention *the manner* of arranging and connecting the eight wheels, which constitute the two bearing carriages, with a railroad car, in the mode and by the means described in his specification, for the ends before described, whether such railroad car is adapted to the transportation of freight or of passengers.

"The leading principle set forth in the specification, upon which the arrangement and connection act to effect the objects aimed at, is that by the contiguity of the fore and hind wheels of each bearing carriage, and the swivelling motion of the trucks or bearing carriages, the planes of the flanches of the wheels conform more nearly to the line of the rails, and the lateral friction of the flanches on the rails, while entering, passing through, and leaving curves, is thereby



## Syllabus.

diminished; while at the same time, in consequence of the two bearing carriages being arranged and connected with the body of a passenger or burden car, by means of the king bolts or center pins and bolsters, placed as remotely from each other as may be desired or can be conveniently done, and with the weight bearing upon the *central* portion of the bolsters and bearing carriages, the injurious effects of the shocks and concussions received from slight irregularities and imperfections of the track, and other minute disturbing causes, are greatly lessened."

The remarks of the court about the want of a disclaimer, where the patent claimed too much, though correct as a general statement of the law, could have little bearing on the present case, where the disclaimer, to be effectual, would include the whole invention claimed.

It is abundantly evident, therefore, that the court having given a correct construction to the patent, there could be no error in refusing to give a different one, or in refusing to admit testimony which, under this construction, was wholly irrelevant to the issue on which the jury were about to pass.

The judgment of the Circuit Court is therefore affirmed with costs.

Mr. Justice DANIEL dissents, on the ground of a want of jurisdiction.

**AFFIRMED WITH COSTS.**

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GEORGE KENDALL, LEANDER M. WARE, AND GEORGE L. JENCKS,  
PLAINTIFFS IN ERROR, v. JOSEPH S. WINSOR.

(21 Howard, 322.)

1. The ultimate object of the Patent Laws being to benefit the public by the use of the invention after the temporary monopoly shall have expired, one who conceals his invention, and uses it for his own profit, is not entitled to favor if another person should find out and use the invention.
2. But this does not include the case of an inventor who forbears to apply for a patent until he has perfected his invention or tested its value by experiments.
3. Whether or not an inventor intended to do this, or negligently to postpone his claims to a patent, as, for instance, by acquiescing with full knowledge in the use of his invention by others, are questions which ought properly to be left to the jury.
4. If a person should surreptitiously obtain knowledge of the invention, and use it, he would have no right to continue to use it after the inventor should have obtained a patent.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Rhode Island.

The facts in the case, the instructions asked for and refused upon the trial in the Circuit Court, and also those given to the jury by the court, are all set forth in the opinion of the court. Under these instructions, the jury found a verdict for the plaintiff, and assessed his damages in the sum of two thousand dollars.

It was argued by *Mr. Jenckes*, for the plaintiffs in error, and by *Mr. Keller*, for the defendant.

The points made by the counsel on each side can be readily inferred from a perusal of the instructions asked for on behalf of the defendants in the Circuit Court, and of those given, which latter were sustained in the argument in this court. All of these instructions are set forth in the following opinion :

Mr. Justice DANIEL delivered the opinion of the court.

This was an action on the case in the Circuit Court of the United States, instituted by the defendant in error against the plaintiffs, for the recovery of damages for an alleged infringement by the latter of the rights of the former as a patentee. No question was raised upon the pleadings or the evidence in this case as to the originality or novelty of the invention patented, nor with respect to the identity of that invention with the machine complained of as an infringement of the rights of the patentee, nor as to the use of that machine. These several facts were conceded, or at any rate were not controverted, between the parties to this suit.

Under the plea of *not guilty*, the defendant in the Circuit Court gave notice of the following defenses to be made by him :

1. A license from the plaintiff to use his invention.
2. A right to use that invention in virtue of the seventh section of the act of Congress of the 3d of March, 1839, which section provides, "That every person or corporation who has or shall have purchased or constructed any newly-invented machine, manufacture, or composition of matter prior to the application of the inventor or discoverer for a patent, shall be held to possess the right to use, and vend to others to be used, the specific machine, manufacture, or composition of matter so made or purchased, without liability therefor to the inventor or any other person interested in such invention."

To the relevancy and effect of the evidence adduced with reference to the two defenses thus notified, and to the questions of law arising

upon the issues made by those defenses, this controversy is properly limited.

Upon the trial in the Circuit Court, in support of this defense, evidence was introduced tending to show that the plaintiff constructed a machine in substantial conformity with his specification as early as 1846, and that in 1849 he had several such machines in operation, on which he made harness to supply all such orders as he could obtain; that he continued to run these machines until he obtained his letters patent; that he repeatedly declared to different persons that the machine was so complicated that he preferred not to take a patent, but to rely on the difficulty of imitating the machine, and the secrecy in which he kept it. And the defendants also gave evidence tending to prove that the first of their machines was completed in the autumn of 1853, and the residue in the autumn of 1854; and that, in the course of that fall, the plaintiff had knowledge that the defendants had built, or were building, one or more machines like his invention, and did not interpose to prevent them.

The plaintiff gave evidence tending to prove that the first machine built by him was never completed so as to operate; that his second machine was only partially successful, and improvements were made upon it; that in 1849 he began four others, and completed them in that year, and made harness on them, which he sold when he could get orders; that they were subject to some practical difficulties, particularly as it respected the method of making the harness, and the liability of the bobbing to get out of the clutch; that he was employed in devising means to remedy these defects, and did remedy them; that he also endeavored to simplify the machine by using only one ram-shaft; that he constantly intended to take letters patent when he should have perfected the machine; that he applied to Mr. Keller for this purpose in February, 1853, but the mode and specifications were not sent to Washington till November, 1854; that he kept the machines from the view of the public, allowed none of the hands employed in the mill to introduce persons to view them, and that the hands pledged themselves not to divulge the invention; that among the hands employed by the plaintiff was one Kendall Aldridge, who left the plaintiff's employment in the autumn of 1852, and entered into an arrangement with the defendants to copy the plaintiff's machine for them, and did so; and that it was by Aldridge, and under his superintendence, and by means of the knowledge which he had gained while in the plaintiff's employment, under a pledge of secrecy, that the defendant's machines were built and put in operation; and

that one of the defendants had procured drawings of the plaintiff's machine, and has taken out letters patent for it in England.

Each party controverted the facts thus sought to be proved by the other.

The defendant's counsel prayed the court to instruct the jury as follows :

1. That it is the duty of an inventor, if he would secure the protection of the Patent Laws, to apply for a patent as soon as his machine (if he has invented a machine) is in practical working order, so as to work regularly every day in the business for which it was designed; and if he does not so apply, he has no remedy against any persons who possess themselves of the invention, with his knowledge and without his notification to desist, or of his claims as an inventor before he applies for his patent.

2. That a machine can no longer be considered as an experiment, or the subject of experiment, when it is worked regularly in the course of business, and produces a satisfactory fabric, in quantities sufficient to supply the entire demand for the article.

3. That in order to justify the delay of the plaintiff in applying for a patent after his machine was in practical working order, on the ground of the desire to improve and perfect it, the plaintiff must show some defect in construction, or difficulty in the operation or mode of operation, which he desired and expected to remove by further thought and study; and if no such thing is shown, then the machine must be held to have been completed and finished, in the sense of the Patent Law, at the time it was put in regular working use and operation.

4. That under the seventh section of the act of 1839, entitled, &c., if the jury are satisfied that the machines, for the use of which the defendants are sued, were constructed and put in operation before the plaintiff applied for his patent, then the defendants possessed the right to use, and vend to others to be used, the specific machines made or purchased by them, without liability therefor to the plaintiff; and the jury are to inquire and find only the fact of such construction before the date of the plaintiff's application, in order to render a verdict for the defendants.

5. That under said section of said act, if the machines used by the defendants were purchased or constructed by them before the application of the plaintiff for his patent, with the knowledge of the plaintiff, then they must be held to possess the right to use, and vend to others to be used, the machines so purchased or constructed; and the jury are to inquire into and find only the fact of such purchase or

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construction, and that the plaintiff had knowledge of the same, in order to render a verdict for the defendants.

6. That under said section of said act, if the machines used by the defendants were purchased or constructed by them before the application of the plaintiff for his patent, without the knowledge of the plaintiff, and without his notifying the defendants of his claim as the inventor, and requiring them to desist from such construction, then they must be held to possess the right to use, and vend to others to use, and machines so purchased or constructed; and the jury are to inquire only into and find the fact of such purchase or construction, and that the plaintiff had knowledge of the same, and did not notify the defendant to desist from such purchase or construction of his claims as inventor, in order to render a verdict for the defendants.

The court set aside all those prayers for instructions, and did instruct the jury as follows:

1. That if Aldridge, under a pledge of secrecy, obtained knowledge of the plaintiff's machine, (and he had not abandoned it to the public,) and thereupon, at the instigation of the defendants, and with the knowledge, on their part, of the surreptitiousness of his acts, constructed machines for the defendants, they would not have the right to continue to use the same after the date of the plaintiff's letters patent; *but if the defendants had these machines constructed before the plaintiff's application for his letters patent, under the belief authorized by him that he consented and allowed them so to do, then they might lawfully continue to use the same after the date of the plaintiff's letters patent, and the plaintiff could not recover in this action.* And that if the jury should find that the plaintiff's declaration and conduct were such as to justify the defendants in believing he did not intend to take letters patent, but to rely on the difficulty of imitating his machine, and the means he took to keep it secret, this would be a defense to the action. And they were further instructed, that to constitute such an abandonment to the public as would destroy the plaintiff's right to take a patent, in a case where it did not appear any sale of the thing patented had been made, and there was no open public exhibition of the machine, the jury must find that he intended to give up and relinquish his right to take letters patent; but if the plaintiff did intend not to take a patent, and manifested that intent by his declarations or conduct, and thereupon it was copied by the defendant, and so went into use, the plaintiff could not afterwards take a valid patent.

To which refusal to give the instructions prayed for, as well as to the instructions given, the defendants, by their counsel, excepted

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before the jury retired from the bar; and, as the matter thereof did not appear of record, prayed the court to allow and seal this bill of exceptions; which, being found correct, has been allowed and sealed accordingly by the presiding judge.

B. R. CURTIS,

*Justice Sup. Ct. U. S.*

[L. S.]

The first ground of defense assumed under the notice from the defendant in the court below, viz., a license from the patentee, may at once be disposed of by the remark that no evidence was offered on the trial, bearing directly or remotely upon the fact of an actual license from the patentee, either to the defendant or to any person whomsoever. The defense, then, must depend exclusively upon the proper construction of the section of the law above cited, and the application of that section to the conduct of the parties, as shown by the bill of exceptions.

It is undeniably true, that the limited and temporary monopoly granted to inventors was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another, and doubtless the primary, object in granting and securing that monopoly. This was at once the equivalent given by the public for benefits bestowed by the genius and meditations and skill of individuals, and the incentive to further efforts for the same important objects. The true policy and ends of the Patent Laws enacted under this government are disclosed in that article of the Constitution, the source of all these laws, viz., "to promote the progress of science and the useful arts," contemplating and necessarily implying their extension and increasing adaptation to the uses of society. *Vide* Constitution of the United States, art. 1, sec. 8, clause 9. By correct induction from these truths, it follows that the inventor who designedly, and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the Constitution or acts of Congress. He does not promote, and if aided in his design would impede, the progress of science and the useful arts. And with a very bad grace could he appeal for favor or protection to that society which, if he had not injured, he certainly had neither benefitted nor intended to benefit. Hence, if, during such a concealment, an invention similar to or identical with his own should be made and patented, or brought into use without a patent, the latter could not be inhibited nor restricted, upon proof of its identity with a machine previously invented and withheld and concealed by the inventor from the public. The rights and interests, whether of the public or of individuals,

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can never be made to yield to schemes of selfishness or cupidity. Moreover, that which is once given to or is invested in the public, cannot be recalled nor taken from them.

But the relation borne to the public by inventors, and the obligations they are bound to fulfill, in order to secure from the former protection and the right to remuneration, by no means forbid a delay requisite for completing an invention, or for a test of its value or success by a series of sufficient and practical experiments; nor do they forbid a discreet and reasonable forbearance to proclaim the theory or operation of a discovery during its progress to completion, and preceding an application for protection in that discovery. The former may be highly advantageous, as tending to the perfecting the invention; the latter may be indispensable, in order to prevent a piracy of the rights of the true inventor.

It is the unquestionable right of every inventor to confer gratuitously the benefits of his ingenuity upon the public, and this he may do either by express declaration, or by conduct equally significant with language—such, for instance, as an acquiescence with full knowledge in the use of his invention by others; or he may forfeit his rights as an inventor by a willful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced by others. Whilst the remuneration of genius and useful ingenuity is a duty incumbent upon the public, the rights and welfare of the community must be fairly dealt with and effectually guarded. Considerations of individual emolument can never be permitted to operate to the injury of these. But whilst inventors are bound to diligence and fairness in their dealings with the public, with reference to their discoveries, on the other hand, they are, by obligations equally strong, entitled to protection against frauds or wrongs practiced to pirate from them the results of thought and labor, in which nearly a lifetime may have been exhausted: the fruits of more than the *viginti annorum lucubrationes*, which fruits the public are ultimately to gather. The shield of this protection has been constantly interposed between the inventor and fraudulent spoliator by the courts in England, and most signally and effectually has this been done by this court, as is seen in the cases of *Pennock & Sellers v. Dialogue*, 2 Peters, 1, and of *Shaw v. Cooper*, 7 Peters, 292. These may be regarded as leading cases upon the question of the abrogation or relinquishment of patent privileges, as resulting from avowed intention, from abandonment or neglect, or from use known and assented to.

Thus, in the former case, the court, on page 18, interpreting the

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phrase, "*not known or used before the application for a patent*," make the inquiry, 'what is the true meaning of the words *not known or used*,' &c. They cannot mean that the thing invented was not known or used before the application by the inventor himself, for that would be to prevent the only means of his obtaining a patent. The *USE* as well as the *KNOWLEDGE* of his invention must be indispensable to enable him to ascertain its competency to the end proposed, as well as to perfect its component parts. The words, then, to have any rational interpretation, must mean, *not known or used by others* before the application. But how known or used? If it were necessary, as it well might be, to employ others to assist in the original structure or use by the inventor himself, or if, before his application, his invention *should be pirated by another, or used without his consent*, it can scarcely be supposed that the legislature had within its contemplation such knowledge or use." Further on in the same case, page 19, the court say: "If an inventor should be permitted to hold back from the knowledge of the public the secrets of his invention; if he should, for a long period of years, retain the monopoly and make and sell his invention publicly, and thus gather the whole profits of it, relying on his superior skill and knowledge of the structure, and then, and then only, when the danger of competition should force him to secure the exclusive right, he should be allowed to take out a patent, and thus exclude the public from any further use than what would be derived under it during his fourteen years—it would materially retard the progress of science and the useful arts, and give a premium to those who should be least prompt to communicate their discoveries." In *Shaw v. Cooper*, 7 Peters, this court, on page 319, in strict coincidence with the decision in 2 Peters, say: "The knowledge or use spoken of in the statute could have referred to the public only, and cannot be applied to the inventor himself. He must necessarily have a perfect knowledge of the thing invented, and its use, before he can describe it, as by law he is required to do preparatory to the emanation of a patent. But there may be cases in which the knowledge of the invention *may be surreptitiously obtained* and communicated to the public, that do not affect the right of the inventor. Under such circumstances, no presumption can arise in favor of an abandonment of the right by the inventor to the public, though an acquiescence on his part will lay the foundation for such a presumption."

The real interest of an inventor, with respect to an assertion or surrender of his rights under the Constitution and laws of the United States, whether it be sought in his declarations or acts, or in forbearance or neglect to speak or act, is an inquiry or conclusion of *fact*,



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Statement of the case.

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and peculiarly within the province of the jury, guided by legal evidence submitted to them at the trial.

Recurring now to the instruction from the judge at circuit in this case, we consider that instruction to be in strict conformity with the principles hereinbefore propounded, and with the doctrines of this court, as declared in the case of *Pennock v. Dialogue* and *Shaw v. Cooper*. That instruction diminishes or excludes no proper ground upon which the conduct and intent of the plaintiff below, as evinced either by declarations or acts, or by omission to speak or act, and on which also the justice and integrity of the conduct of the defendants were to be examined and determined. It submitted the conduct and intentions of both plaintiff and defendants to the jury, as questions of *fact* to be decided by them, guided simply by such rules of law as had been settled with reference to issues like the one before them; and upon those questions of fact the jury have responded in favor of the plaintiff below, the defendant in error. We think that the rejection by the court of the prayers offered by the defendants at the trial was warranted by the character of those prayers, as having a tendency to narrow the inquiry by the jury to an imperfect and partial view of the case, and to divert their minds from a full comprehension of the merits of the controversy. The decision of the Circuit Court is affirmed, therefore, with costs.

AFFIRMED WITH COSTS.

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THOMAS OTIS LE ROY AND DAVID SMITH, APPELLANTS, v. BENJAMIN TATHAM, JR., HENRY B. TATHAM, AND GEORGE N. TATHAM.

(22 Howard, 132.)

The patent of the Tathams, for an improvement upon the machinery used for making pipes and tubes from lead or tin, when in a set or solid state, explained and sustained.

THIS was an appeal from the Circuit Court of the United States for the Southern District of New York, sitting in equity.

It was a bill filed by the Tathams against the appellants, for an infringement of the patent for making lead pipe, which is particularly described in a former case, reported in 14 Howard, 156.

The Circuit Court decreed that John Hanson and Charles Hanson, of England, were the first and original inventors and discoverers of the improvement in making pipes and tubes from metallic substances, set forth and described in the bill of complaint.

That the subject-matter of the said invention and discovery is patentable.

That the complainants are the legal patentees and owners, within the United States, of the said invention and discovery, set forth in the bill of complaint, which sufficiently describes the same.

That the defendants have infringed and violated the said patent-right of the complainants in the manner charged in the bill of complaint.

The court thereupon ordered a reference to a master to take an account of the damages sustained by the complainants. Upon the coming in of his report, sundry exceptions were filed by the defendants, which were overruled, and the court decreed the amount which the defendants should pay. An appeal from this decree brought the case up to this court.

The facts of the case are stated in the opinion of the court.

It was argued by *Mr. Stoughton* and *Mr. Noyes*, for the appellants, and by *Mr. Keller* and *Mr. Goddard*, for the appellees.

The principal ground upon which the counsel for the appellants sought to reverse the decree, was that the patent to the complainants was void, because the Hansons were not the original and first inventors of the improvements therein described and claimed.

The discussion of this proposition filled the court-room with models and machines upon both sides, the description of which would be of little interest to the readers of this volume. They will be, therefore, entirely passed over.

Mr. Justice McLEAN delivered the opinion of the court.

This is an appeal from the final decree of the Circuit Court of the United States for the Southern District of New York, on a bill filed by the appellees to restrain the infringement by the appellants of a patent for making lead pipe, and for general relief.

A suit at law was commenced, after the filing of the bill, on or about the 10th of May, 1847, to recover damages for the same infringement.

The action was twice tried—once on the 3d of May, 1848, and resulted in a verdict for the appellants, which was set aside by the court, and a new trial awarded. It was tried in May, 1849, when the jury gave a verdict for the respondents for \$11,394 in damages. Exceptions were taken to the charge, and the judgment was reversed, and a new trial ordered in December Term, 1852. 14 How., 156.

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Before this decision was made, and in January, 1852, it was stipulated, between the counsel for the respective parties, that the testimony taken on the last trial in the action at law should be read; and it forms the principal part of the evidence on both sides in this suit.

The action at law was not to be tried again; but the suit in equity was prosecuted in its stead.

The patent under which the plaintiffs claim bears date the 14th of March, 1846; and in their schedule they say: "Our invention consists in certain improvements upon and additions to the machinery used for manufacturing pipes and tubes from lead or tin, or any alloy of soft metals, capable of being forced, by great pressure, from out of a receiver, through or between apertures, dies, and cores, when in a set or solid state, set forth in the specification of a patent granted to Thomas Burr, of Shrewsbury, in Shropshire, England, dated the 11th of April, 1820, recited in the Repertory of Arts, &c., London, &c."

The bill alleges that John and Charles Hanson, of England, were the inventors of the improvements specified; on or prior to the 31st of August, 1837; that on the 10th of January, 1840, the Hansons assigned to H. B. & B. Tatham, two of the defendants in error, the full and exclusive right to said improvements; that on the 29th of March, 1841, letters patent were granted for the improvements to the Tathams, as the assignees of the Hansons; that afterwards, H. B. & B. Tatham assigned to G. N. Tatham, the remaining defendant, an undivided third part of the patent.

On the 14th of March, 1846, the said letters patent were surrendered, on the ground that the specifications of the improvements claimed were defective; and a new patent was issued, which granted to the patentees, their heirs, &c., for the term of fourteen years from the 31st of August, 1837, the exclusive right to make and vend the improvements secured.

The defendants denied the infringement charged.

A great number of facts were proved, showing the successful manufacture of lead in the mode stated in the specifications, and particularly that "pipes thus made are found to possess great solidity and unusual strength, and a fine uniformity of thickness and accuracy is arrived at, such as, it is believed, has never been attained by any other machinery." And they say the essential difference in the character of this pipe, which distinguishes it, as well as that contemplated by Thomas Burr, from all others heretofore known or attempted, is that it is wrought under heat, by pressure and constriction, from set metal, and that it is not a casting formed in a mould.

“And it was proved; that, in all the modes of making lead pipe previously known and in use, it could be made only in short pieces; but that, by this improved mode, it could be made of any required length, and also of any size; and that the introduction of lead pipe made in the mode described had superseded the use of that made by any of the modes before in use, and that it was also furnished at a less price.” And it was proved that lead, when recently become set, and while under heat and extreme pressure, in a close vessel, would reunite perfectly after a separation of its parts.

In the case of *The Househill Company v. Neilson*, Webster's Patent Cases, 683, it is said: “A patent will be good, though the subject of the patent consists in the discovery of a great, general, and most comprehensive principle in science or law of nature, if that principle is, by the specification, applied to any special purpose, so as thereby to effectuate a practical result and benefit not previously attained.”

Mr. Justice Clerk Hope, in his charge to the jury, said: “The specification does not claim anything as to the form, nature, shape, materials, numbers, or mathematical character of the vessel or vessels in which the air is to be heated, or as to the mode of heating such vessels.”

Now, in this case it must not be forgotten that the machinery was not claimed as a part of the invention; but the jury were instructed to inquire “whether the specification was not such as to enable workmen of ordinary skill to make machinery or apparatus capable of producing the effect set forth in said letters patent and specification”; and that, in order to ascertain whether the defendants had infringed the patent, the jury should inquire whether they “did, by themselves or others, and in contravention of the privileges conferred by the letters patent, use machinery or apparatus substantially the same with the machinery or apparatus described in the plaintiffs' specification, and to the effect set forth in said letters and specification.”

Now, as no specification was claimed in regard to the machinery, it is not perceived how the patent could be infringed, unless upon the principle that, having claimed no specific mode of applying the heat, he could use any mode he might prefer, in defiance of the rights of other patentees.

Now, this cannot be law; certainly it is not law under the Patent Act of this country. That act requires the making and constructing “the thing, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains to make, construct, and use the same.”

Alderson, B., (Webster's Patent Cases, 342,) says: “The distinction

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between a patent for a principle and a patent which can be supported, is that you must have an embodiment of the principle in some practical mode described in the specification of carrying into actual effect; and then you take out your patent, not for the principle, but for the mode of carrying the principle into effect."

"It is quite true, that a patent cannot be taken out solely for an abstract philosophical principle—for instance, for any law of nature or any property of matter, apart from any mode of turning it to account. A mere discovery of such a principle is not an invention, in the Patent-Law sense of the term." Webster's P. C., 683.

However brilliant the discovery of the new principle may be, to make it useful it must be applied to some practical purpose. Short of this, no patent can be granted. And it would not seem to be a work of much labor for a man of ingenuity to describe what he has invented.

The "newly-discovered property in the metal, and the practical adaptation of it by these means to the production of a new result, namely, the manufacture of wrought pipe out of solid lead," was the discovery. "There can be no patent for a principle; but for a principle so far embodied and connected with corporeal substances as to be in a condition to act and to produce effects in any trade, mystery, or manual occupation, there may be a patent."

"It is not that the patentee conceived an abstract notion that the consumption in fire-engines may be lessened; but he discovered a practical manner of doing it, and for that he has taken his patent. This is a very different thing from taking a patent for a principle."

The principle may be the new and valuable discovery, but the practical application of it to some useful purpose is the test of its value.

In the case of *Le Roy v. Tatham*, 14 Howard, 136, it was said: "That in the view taken by the court in the construction of the patent, it was not material whether the mere combination of machinery referred to were similar to the combination used by the Hansons, because the originality did not consist in the novelty in the machinery, but in bringing a newly-discovered principle into practical application, by which a useful article is produced, and wrought pipe made, as distinguished from cast pipe."

Now, it must be observed that the machinery used was admitted to be old, and any difference in form and strength must arise from the mode of manufacturing the pipes. The new property in the metal, claimed to have been discovered by the patentees, belongs to the process of manufacture. The result is before us. We see the

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manufactured article, and are told that its substance is greatly modified and improved, but we derive little or no knowledge from inspecting it. Except by the known process of its formation, we cannot appreciate its value, or comprehend the various purposes for which it was made. We want to see and understand the processes by which it was formed, the machinery in action, and a full explanation of its parts.

The claimants say: "We wish it to be understood that we do not, confine ourselves to the mode of operation herein described, by making the cylinder rise with the hydraulic ram and other parts, and keeping the piston stationary, as the same effects will take place when the cylinder is stationary, and the power of the ram is applied to the top of the piston to cause it to descend into the cylinder, and our improvements might be applied to a cylinder and press, fitted up in other respects upon Burr's plans, whereby the pipe is received over the top of the machinery, &c., all which and other variations will readily suggest themselves to any practical engineer, without departing from the substantial originality of our invention.

"The combination of the following parts above described is claimed, to wit, the core and bridge, or guide-piece, with the cylinder, the piston, the chamber, and the die, when used to form pipes of metal, under heat and pressure, in the manner set forth, or in any other mode substantially the same."

To the above is added: "We do not claim as our invention and improvement any of the parts of the above-described machinery, independently of their arrangement and combination above set forth."

The machinery described in both the above sentences is only claimed when used to form pipes of metal under heat and pressure; and it must be admitted that the machinery described and illustrated by the drawings is sufficiently explicit to show the nature of the invention. If it be admitted that the machinery, or a part of it, was not new when used to produce the new product, still it was so combined and modified as to produce new results, within the Patent Law. One new and operative agency in the production of the desired result would give novelty to the entire combination.

The specifications are drawn with care and no ordinary skill, and they cannot be misunderstood. No one can be supposed to mistake the new product for the machinery through which it is developed. And in regard to a practical application of the new conception, it is as necessary as the conception itself; and they must unite in the patent. "The apparatus described is properly regarded by the pat-

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entees as subordinate, and as important only as enabling them to give practical effect to the newly-discovered property, by which they produce the new manufacture." Certainly no comparison was instituted between the mechanical contrivance used, and the new discovery.

In the case of *Le Roy v. Tatham*, 14 Howard, 176, the court instructed the jury: "That the originality of the invention did not consist in the novelty of the machinery, but in bringing a newly-discovered principle into practical use."

Principle is often applied to a machine to describe its movements and effect; and we are told that the originality of this invention did not "consist in the novelty of the machinery, but in bringing a newly-discovered principle into practical effect." Whether the new manufacture was the result of frequent experiments or of accident, it will be admitted that the process has been demonstrated to the satisfaction of all observers; and this has been done in the mode described.

In the complicated and powerful machinery used to produce this result, it is not perceived why it should not be adverted to, as showing the most natural and satisfactory explanation of the discovery. It is only necessary to examine the machinery combined, to see that its parts are dissimilar to others in use; and there would seem to be no other reason for the use of the new principle, to the exclusion of the mechanical structures employed, except a higher reach of knowledge. However this may be, it would seem that, when dealing with a patentable subject, its appropriate name should be given to the machinery by which it was developed. The admitted want of novelty in the machinery, referred to so frequently, might invite criticism, if it were necessary, to the case in 14 Howard; but the case now before us is in chancery, and has been deliberately considered.

Up to the year 1837, the date of Hanson's invention, two methods only were known of making wrought pipe from lead, in the set or solid state, and these were the Burr method and the draw-bench method. As soon as the plan of the Hansons was introduced, they superseded all other methods.

Both of the above methods were defective—the draw-bench on account of the great labor, limited length of pipe produced, and unequal thickness; and the Burr, because of the difficulty of holding the core central in the die, in forming pipes of small calibre.

The superiority of the Burr method, for the general purposes of manufacturing leaden pipes which require different sizes to be made, was so slight, as it seems, that for seventeen years after the date of

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Order.

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the Burr patent, not one of such machines was put in use in the United States or in Europe.

In this combination of machinery there are six essential parts:

First. A metal cylinder, capable of receiving the lead in a fluid state, and permitting it to become set or solid therein, and of great strength.

Second. A piston, which is a solid metallic body, fitted to the bore of the cylinder, to work therein accurately, to prevent the charge of lead from escaping around it, and so connected with a hydraulic press, or other motor of great power, as to traverse the length of the cylinder with a force applied of several tons, to force out the charge of lead not in the liquid state.

Third. A die, which is simply a block of steel, with a central hole of a cylindrical form, and of a diameter of the pipe to be made.

Fourth. A core, which is simply a short cylindrical rod of steel, of the diameter of the calibre of the pipe to be made.

Fifth. A bridge or core-holder, which is a plate of metal with apertures, having four or more arms radiating from the central part, which has a central hole of the size of the core.

Sixth. A chamber of construction, located between the bridge and the die, and extending from the one to the other, and either conical or cylindrical, provided the end next the bridge be made of greater diameter than the die.

It is rare that so clear and satisfactory an explanation is given to the machinery which performs the important functions above specified. We are satisfied that the patent is sustainable, and that the complainants are entitled to the relief claimed by them.

ORDER. This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the Southern District of New York, and was argued by counsel; on consideration whereof, it is the opinion of this court that the complainants in the court below are entitled to recover from the defendants the sum of \$16,815.57. Whereupon, it is now here ordered, adjudged, and decreed by this court, that the same is hereby affirmed to the extent of the aforesaid sum of \$16,815.57, and that it be reversed as to the residue; and that this cause be, and the same is hereby, remanded to the said Circuit Court, with directions to enter a decree for that amount in favor of the complainants. And it is further ordered and decreed by this court, that the costs in the court below be paid by respondents in that court, (the appellants here,) and that each party pay his own costs in this court.



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Argument for the plaintiff in error.

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EDWIN M. CHAFFEE, PLAINTIFF IN ERROR, v. THE BOSTON BELTING COMPANY.

(22 Howard, 217.)

1. Where a patentee, whose patent had been extended according to law, conveyed all his interest to another person, and the assignee brought suit against certain parties for an infringement of the patent, and these parties claimed under a license granted by the original patentee before the assignment, it was necessary to show a connected chain of title to themselves, in order to justify their use of the improvement secured by the patent.
2. Having omitted to do this, the judgment of the court below, which was in favor of the defendants, must be reversed, and the case remanded for another trial.
3. Whether the patent was for a process or a machine, is not decided in the present case.

THIS case was brought up by writ of error from the Circuit Court of the United States for the District of Massachusetts.

It was an action of trespass on the case brought by Chaffee against the Boston Belting Company, for an infringement upon a patent granted for the manufacture of India-rubber, granted to Chaffee in 1836, and extended for seven years from the 31st day of August, 1850.

The respective claims of the plaintiff and defendants are fully stated in the opinion of the court.

The presiding judge in the court below ruled that the defendants had a right to continue the same machinery for the same purposes, and in conformity with the directions contained in the specification, after the expiration and renewal of the letters patent, and, consequently, that the plaintiff could not recover.

To this ruling the plaintiff excepted, and brought the case up to this court.

It was argued by *Mr. Jenckes* and *Mr. Clarence A. Seward*, for the plaintiff in error; no counsel appearing for the defendants.

The case having gone off upon a single point, the argument of the counsel for the plaintiff in error upon that point is alone reported.

The court below erred in charging the jury, that, under their title, the defendants had a right to continue to use the same machinery for the same purposes. This charge was predicated upon an assumption of title in the defendants, which they had not proved. They had proved that Goodyear, while the owner of the original term of the

patent, had granted to Edwards a license for a specific purpose. They did not prove any privity between themselves and that license. They did not prove an assignment of that license to themselves. They did not prove the assent of Edwards to their use of the plaintiff's patent in the manufacture of the articles specified in the license. The only purpose for which the license seems to have been introduced was to identify the uses to which the defendants applied the plaintiff's patent, to wit, "for the preparation and application of India-rubber to the manufacture of the articles mentioned and described in the indenture between Goodyear and Edwards." This identification was not a justification of the use by the defendants of the plaintiff's patent. It proved satisfactorily the nature and extent of that use; but it proved nothing more. It did not prove that the defendants were rightfully in the enjoyment of the thing patented during the original term of the patent.

The defendants, therefore, having failed to establish any privity between themselves and Goodyear, the owner of the original term of the patent, failed also to establish any right, as against the plaintiff, to use his patent during its extended term. The defendants, upon the record, appear as naked infringers of the plaintiff's patent.

The charge of the court below, therefore, was erroneous in assuming the existence of a license from Goodyear to the defendants, and entitles the plaintiff to a reversal of the judgment and to a *venire facias de novo*.

Mr. Justice CLIFFORD delivered the opinion of the court.

This case comes before the court on a writ of error to the Circuit Court of the United States for the District of Massachusetts. It was an action of trespass on the case, for the alleged infringement of certain rights secured by letters patent.

As the foundation of the suit, the declaration alleges, in effect, that the assignor of the plaintiff was the original and first inventor of certain improvements in the manufacture of India-rubber, and that in the year 1836 letters patent for such improvements were duly issued to him by the Commissioner of Patents, as is therein fully and correctly set forth and described.

Those improvements, as is alleged in the declaration, consist in a mode of preparing the rubber for manufacturing purposes, and of reducing it to a pasty state, without the use of the spirits of turpentine or other solvents, and of applying the same to cloths, and for other purposes, by the use of heated rollers and other means, as set forth in the letters patent, saving thereby, as is alleged, a large por-

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tion of the expense of reducing the original material to a proper degree of softness, and of fitting and preparing it for the various uses to which it may be applied.

On application subsequently made to the Commissioner of Patents, in due form of law, by the original inventor, the patent was extended for the further term of seven years from the 31st day of August, 1850; and the plaintiff alleges that the patentee, on the 1st day of July, 1853, transferred, assigned, and conveyed to him all his title to the invention and to the patent for the extended term.

By virtue of that deed of transfer, it is claimed in the declaration that the plaintiff acquired the right to demand and recover the damages for all infringements of the letters patent prior to the date of the transfer, as well as for those that have been committed since that time; and, accordingly, the plaintiff alleges that the defendants, on the 31st day of August, 1850, fraudulently commenced the use of those improvements, without law or right, and so continued to use them to the day of the commencement of this suit; averring, at the same time, that the defendants have prepared large quantities of the native rubber for manufacturing purposes, without the use of spirits of turpentine or other solvents, thereby making large gains, and greatly to the damage of the plaintiff.

As appears by the transcript, the action was entered in the Circuit Court at the May Term, 1854, but was continued from term to term until the May Term, 1857, when the parties went to trial upon the general issue.

From what is stated in the bill of exceptions, it appears that one Charles Goodyear was the owner of the original letters patent on the 26th day of January, 1846, and that he continued to own them for the residue of the term for which they were originally granted. On that day he entered into an indenture with one Henry Edwards, of the city of Boston, whereby, for certain considerations therein expressed, he sold and conveyed to the said Henry Edwards, his executors, administrators, and assigns, the exclusive right and license to make, use, and vend any and all articles appertaining to machines, or in the manufacture, construction, and use of machines or machinery, of whatever description, subject to certain limitations and qualifications therein expressed.

By the terms of the instrument, it was understood that the right and license so conveyed was to apply to any and all articles substituted for leather, metal, and other substances, in the use or manufacture of machines or machinery, in so far as the grantor had any rights or privileges in the same, by virtue of any invention or im-

provement made, or which should thereafter be made, by him in the manufacture of India-rubber or gum-elastic goods, and in virtue of any and all letters patent or patent-rights of the United States granted or belonging to him, or which should thereafter be granted or belong to him, for any or all inventions or improvements in the manufacture of such goods in this country, but excluding the right to make any contract with the government of the United States. In consideration of the premises, the grantee paid the sum of one thousand dollars, as appears by the recital of the instrument, and agreed to pay a certain tariff, at the rate of five cents per superficial yard, or five cents per pound for the pure gum, according to the nature of the article manufactured.

Reference is made in the declaration to the letters patent, and to the deed of assignment from the patentee to the plaintiff; but neither of those instruments appears in the bill of exceptions, or in any other part of the record.

At the trial of the cause, it was conceded and agreed that the defendants, before the date of the plaintiff's writ, used certain machinery, constructed in conformity with the specification annexed to the letters patent declared on, and that the defendants, in using the machinery, conformed to the directions contained in the specification, and that the same was so used for the preparation and application of India-rubber to the manufacture of the articles mentioned and described in the indenture from Charles Goodyear to Henry Edwards, and that all the machinery so used was constructed and in use as aforesaid before and at the time the original letters patent expired.

Upon this state of the case, according to the bill of exceptions, the presiding justice ruled and instructed the jury, that, under their title, the defendants had the right to continue to use the same machinery for the same purposes, and in conformity with the directions contained in the specification, after the expiration and renewal of the letters patent, and, consequently, that the plaintiff could not recover.

Under the ruling and instruction of the court, the jury returned their verdict for the defendants; and the plaintiff excepted to the ruling, and his exceptions were duly allowed.

It is insisted, by the counsel of the plaintiff, that the instruction given to the jury was erroneous; and that is the only question presented for decision at the present time. In considering that question, our attention must necessarily be confined to the evidence reported in the bill of exceptions, as the only means of ascertaining the precise state of facts on which the instruction to the jury was given. Whether the report of the evidence, as set forth in the bill of excep-

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tions, may or may not be incomplete, or imperfectly stated, cannot be known in an appellate court. Bills of exception, when properly taken and duly allowed, become a part of the record, and, as such, cannot be contradicted.

By the admission of the parties in this case, it appears that the defendants, before the date of the plaintiff's writ, had used certain machinery, constructed in conformity with the specification of the plaintiff's patent. In the absence of any explanation or suggestion to the contrary, it must be inferred that the use of the machinery so admitted was without the license or consent of the plaintiff, and subsequent to the period when he became the owner of the patent for the extended term; and if so, the admission was sufficient, under the pleadings, to make out a *prima facie* case for the plaintiff. To maintain the issue on their part, the defendants proved in effect, or it was admitted, that all the machinery so used by them had been constructed, and was in use, as aforesaid, before and at the time the original letters patent expired, and that in using the machinery they had conformed to the directions contained in the specification, and that the same was so used for the purposes and in the manufacture of the articles specified and described in the before-mentioned indenture. As before stated, they had previously proved, or it had been admitted, that the owner of the original term of the patent had granted the exclusive right and license to a third party to use the invention, for the same purposes for which the defendants, both under the original and extended term of the patent, had used their machinery; but they did not prove, and there is no evidence in the case to show, any privity between themselves and that license, either by assignment or in any other manner. They offered no proof tending to show that their use of the machinery in question, under either term of the patent, was with the license, consent, or knowledge of the patentee, or of any other person who ever had or claimed to have any power or authority under him to convey the right. Provision is made by the eighteenth section of the act of Congress passed on the 4th day of July, 1836, for the extension of patents beyond the time of their limitation, on application therefor, in writing, by the patentee, to the Commissioner of the Patent Office, setting forth the grounds for such extension. By the latter clause of that section, the benefit of such renewal is expressly extended to assignees and grantees of the right to use the thing patented, to the extent of their respective interests therein. 5 Stat. at Large, 125. Under that provision, it has been repeatedly held, by this court, that a party who had purchased a patented machine, and was using it during the original term for which

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the patent was granted, might continue to use the machine during the extended term. *Bloomer v. McQuewan*, 14 How., 549; *Wilson v. Rousseau*, 4 How., 646. That rule rests upon the doctrine that the purchaser, in using the machine under such circumstances, exercises no rights created by the act of Congress, nor does he derive title to it by virtue of the franchise or the exclusive privilege granted to the patentee.

When the patented machine rightfully passes to the hands of the purchaser from the patentee, or from any other person by him authorized to convey it, the machine is no longer within the limits of the monopoly. According to the decision of this court in the cases before mentioned, it then passes outside of the monopoly, and is no longer under the peculiar protection granted to patented rights. By a valid sale and purchase, the patented machine becomes the private individual property of the purchaser, and is no longer protected by the laws of the United States, but by the laws of the State in which it is situated. Hence it is obvious, that if a person legally acquires a title to that which is the subject of letters patent, he may continue to use it until it is worn-out, or he may repair it or improve upon it as he pleases, in the same manner as if dealing with property of any other kind. Applying these principles to the present case, as it is exhibited in the bill of exceptions, there would be no difficulty in sustaining the instructions given to the jury, provided it appeared that the machinery used by the defendants had been legally purchased by them of the patentee or his assigns during the original term of the patent. But nothing appears in the evidence reported to warrant the inference that they were either assignees or grantees of the thing patented, within the meaning of the act of Congress or the decisions of this court. All that the indenture offered in evidence showed was the nature and extent that the defendants had used the invention, but, as is well contended by the counsel for the plaintiff, it proved nothing more. It did not prove, or tend to prove, that the defendants were rightfully in the enjoyment of the thing patented during the original term of the patent; and having failed to establish any right or license to use their machinery during the extended term by any other proof, they appear in the record as naked infringers.

Their right to continue to use the machinery as against the plaintiff is predicated in the instruction upon the assumption that they had a title to it, and were rightfully in the use of it under that title, before and at the time the original letters patent expired. That assumed fact finds no support in the evidence reported. It is clearly error for the court, in its instruction to the jury, to assume a material

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Syllabus.

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fact as proved, of which there is no evidence in the case. *United States v. Breitling*, 20 How., 255. And when the finding of the jury accords with the theory of the instruction, thus assumed without evidence, the error is of a character to deserve correction.

Another position is assumed by the counsel of the plaintiff, which ought not to be passed over without a brief notice. They contend that the invention of the plaintiff, as described in the letters patent, is for a process, and not for a machine or machinery; and that the act of Congress extending the benefit of renewals to assignees and grantees of the right to use the thing patented, when properly construed, does not include patents for a process, but should be confined to patents for machines. That question, if properly presented, would involve the construction of the letters patent in this case, as well as the act of Congress; but as the patent is not in the record, it is not possible to determine it at the present time, and we only advert to it that it may not appear to have escaped attention.

The decree of the Circuit Court is reversed with costs, and with directions to issue a new *venire*.

REVERSED WITH COSTS.

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LEWIS TEESE AND LEWIS TEESE, JR., PLAINTIFFS IN ERROR, *v.* C. P. HUNTINGDON AND MARK HOPKINS.

(23 Howard, 2.)

1. Counsel fees are not a proper element for the consideration of the jury in the estimation of damages in actions for the infringement of a patent-right. This point has been directly ruled by this court, and is no longer an open question.
2. By the fifteenth section of the Patent Act of the 4th of July, 1836, the defendant is permitted to plead the general issue and give any special matter in evidence, provided notice in writing may have been given to the plaintiff or his attorney thirty days before the trial.
3. It is not necessary that this should be served and filed by an order of the court; and it is sufficient if it was served and filed subsequently to the time when the depositions were taken and filed in court.
4. For the purpose of impeaching a witness, a question was asked of another witness, "What is the reputation of the [first] witness for moral character?" This question was objected to, and properly not allowed to be put by the court below.
5. The elementary writers and cases upon this point examined.
6. Another witness was asked, what was the reputation of the first witness for truth and veracity, who replied that he had no means of knowing, not having had any transactions with him for five years. This question was excluded by the court, which must judge according to its discretion whether or not it applies to a time too remote.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Northern District of California.

The history of the trial in the court below is fully set forth in the opinion of this court.

It was argued by *Mr. Phillips*, for the plaintiffs in error, and by *Mr. Gifford*, for the defendants. The arguments of the counsel upon many of the points which occurred are omitted, and only the two following will be noticed.

With respect to impeaching the character of a witness, *Mr. Phillips* said:

Evidence was offered to impeach the character of one of defendants' witnesses, by showing his "general reputation for moral character." It was objected, that "the inquiry should be limited to his general reputation for truth and veracity"; and the objection was sustained.

The authorities on this point are to be found carefully collated in 21 American Law Journal, N. S., page 145, where it is said, that so far as the decisions in England are concerned, "they are unanimous to the point that the true criterion of the credit of a witness is his general character and conduct, and not his general character for truth and veracity. The English books will be examined in vain for a single authoritative case which in any respect limits the examination upon this point to the character for truth and veracity."

Upon examination, it will be found that this rule obtains in most of our States.

Other evidence was then offered to prove the reputation of the witness from 1850 to 1853 for truth and veracity. To which it was objected, that "the dates named were too remote, and that the reputation of the witness at a period less remote from the time of trial could be alone put in issue." This objection was also sustained.

The judgment was rendered on the 26th October, 1857, and the time covered by the inquiry was from 1850 to 1853, so that the intermediate period was less than four years.

This is certainly a short statute of limitations in favor of reputation. Whatever influence the question of time was entitled to, was for the jury to consider. The judge could not exclude the evidence as incompetent, for there is neither common-law rule nor statute to justify it.

The view which *Mr. Gifford* took of these points was the following:

The objection to the inquiry as to Jesse Morrill's reputation for "moral character" was properly sustained.



## Argument for the defendants.

1. It is not in any case proper to seek to impeach a witness, by proving what was his reputation for moral character. The inquiry should be as to his reputation for truth and veracity. *United States v. Van Sickle*, 2 McLean, 219; *Goss v. Stimpson*, 2 Sumner, 610; *Gilbert v. Sheldon*, 13 Barb., 623; *The People v. Rector*, 19 Wend., 569; *Jackson v. Lewis*, 13 Johns., 504; *The State v. Bruce*, 24 Maine, 71, 72; *Phillips v. Ringfield*, 1 Appl., 375; *Commonwealth v. Morse*, 3 Pick., 194, 196; *Morse v. Pine*, 4 Vt., 281; *State v. Smith*, 7 Id., 141; *State v. Forrest*, 15 Id., 435; *State v. Randolph*, 24 Conn., 363; *State v. Howard*, 9 N. H., 485; *Gilchrist v. McKee*, 4 Watts, 380; *Chess v. Chess*, 1 Penn., 32; *Uhl v. Commonwealth*, 6 Gratt., 706; *Ward v. The State*, 28 Ala., 53—(court divided;) *Ford v. Ford*, 7 Humph., 92; *Jones v. The State*, 13 Tex., 168; *Perkins v. Nobley*, 4 Warden's Ohio State R., 668; Taylor on Evidence, sec. 1083.

The testimony was properly excluded as to what was the reputation of Jesse Morrill in 1852 or 1853,—about five years before the trial.

1. Because it does not appear that said Morrill was a witness called by the defendants. He is not named in the notices of special matter of defense as one of the defendants' witnesses, and he is not named in the lists of witnesses examined by the defendants.

It must appear by the record that he was called by the defendants, or this objection for that reason must fall.

The law requires that an authenticated transcript of the record and an assignment of errors shall be returned with the writ; and there can be no error cognizable by this court, unless it appears from the record.

The mere assertion of facts in the assignment of errors to show error cannot be substituted for the record. Judiciary Act of 1789, sec. 22; Conkling's Treatise, 3d ed., 689; *Stevens v. Gladding & Proud*, 19 How., 64; *Parsons v. Bedford et al.*, 3 Peters, 433, 445.

All the information the record gives, is that this Morrill "had, as a witness in said case, given material evidence for the defense on said trial."

There is nothing more common than for a witness called by one party to give "material evidence" for the other party. This is constantly done on cross-examinations, and often by the party opposed to the one calling the witness, making him his own witness as to certain facts.

A party cannot impeach a witness called by himself, by proving him unworthy of belief. Graham & Waterman on New Trials, 953.

The court below ruled out the evidence offered to impeach Morrill,

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and, except in so far as the record shows, this court has no means of knowing why. All presumptions are in favor of the correctness of the ruling. This court is bound to consider the determination of the court below to have been correct, on the common presumption that the judge exercised his jurisdiction soundly, until the facts are presented showing the contrary. 2 Graham & Waterman on New Trials, 596 to 599, and cases.

2. Said testimony was properly excluded, because if it had appeared that this Morrill was a witness in behalf of the defendants, an attempt to impeach him, by proving what his reputation was four or five years before the trial, was not admissible.

There must be a limit of time, back of which a party cannot go to prove the reputation of a witness to impeach him; else to impeach a man on a trial to-day, it might be proved what his reputation was for truth and veracity fifty years ago.

There is no specific time fixed by law, and it must be left to the discretion of the judge at the trial.

There was no offer or suggestion in the present case, on the part of the plaintiffs, to add anything to the proof proposed.

They called one witness who, as appears from the record, did then know Morrill, and proposed to prove by him what Morrill's reputation was for moral character. This being ruled out as an improper form of question, they dropped that witness, and called another, who did not know Morrill, and had not known him for four or five years, and then varied the question, and put it as to his reputation for truth and veracity.

Why did they not put the question in that form to the first witness, who had the information? Obviously, for the reason that they dared not properly interrogate a witness having the requisite knowledge, but preferred rather to weave snares to suspend the case and bill of exceptions.

Mr. Justice CLIFFORD delivered the opinion of the court.

This is a writ of error to the Circuit Court of the United States for the Northern District of California. According to the transcript, the declaration in this case was filed on the 18th day of March, 1856. It was an action of trespass on the case for an alleged infringement of certain letters patent purporting to have been duly issued to the plaintiffs for a new and useful improvement in a certain machine or implement called a sluice-fork, used for the purpose of removing stones from sluices and sluice-boxes in washing gold. As the foundation of the suit, the plaintiffs, in their declaration, set up the letters

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patent, alleging that they were the original and first inventors of the improvement therein described, and charged that the defendants, on the 2d day of July, 1855, and on divers other days and times between that day and the day of the commencement of the suit, unlawfully and without license vended and sold a large number of the improved forks, made in imitation of their invention. To this charge the defendants pleaded the general issue, and, in addition thereto, set up in their answer to the declaration two other grounds of defense. In the first place, they denied that the plaintiffs were the original and first inventors of the improvement described in the letters patent, averring that the supposed improvement was known and used by divers other persons in the United States long before the pretended invention of the plaintiffs. They also alleged that the improvement claimed by the plaintiffs as their invention was not the proper subject of a patent, within the true intent and meaning of the Patent Law of the United States.

By the fifteenth section of the Patent Act of the 4th of July, 1836, the defendant, in actions claiming damages for making, using, or selling the thing patented, is permitted to plead the general issue, and for certain defenses, therein specified, to give that act and any special matter in evidence which is pertinent to the issue, and of which notice in writing may have been given to the plaintiff or his attorney thirty days before the trial. Within that provision, and subject to that condition, he may, under the general issue, give any special matter in evidence tending to prove that the patentee was not the original and first inventor or discoverer of the thing patented, or a substantial and material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery by the patentee, or had been in public use, or on sale, with the consent and allowance of the patentee, before his application for a patent. But whenever the defendant relies in his defense on the fact of a previous invention or knowledge or use of the thing patented, he is required to "state in his notice of special matter the names and places of residence of those whom he intends to prove to have possessed a prior knowledge of the thing, and where the same had been used."

Two written notices were accordingly given by the defendants of special matter to be offered in evidence by them at the trial, in support of the first ground of defense set up in the answer to the declaration. One was dated on the 28th day of August, 1856, and the other on the 19th day of September of the succeeding year, but they were both duly served and filed in court more than thirty days

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before the trial. Upon this state of the pleadings, the parties, on the 20th day of October, 1857, went to trial, and the jury, under the rulings and instructions of the presiding justice, returned their verdict for the defendants. After the plaintiffs had introduced evidence tending to prove the alleged infringement of their patent, they claimed that counsel fees were recoverable as damages in this action, and offered proof accordingly, in order to show what would be a reasonable charge in that behalf.

That evidence was objected to by the defendants, upon the ground that counsel fees were not recoverable as damages in actions of that description, and the court sustained the objection, and excluded the evidence,—to which ruling the plaintiffs excepted. Little or no reliance was placed upon this exception by the counsel of the plaintiffs, and in view of the circumstances one or two remarks upon the subject will be sufficient. Suppose it could be admitted that counsel fees constituted a proper element for the consideration of the jury, in the estimation of damages in cases of this description, still the error of the court in excluding the evidence would furnish no ground to reverse the judgment, for the reason that the verdict was for the defendants. For all purposes connected with this investigation, it must be assumed, under the finding of the jury, that the plaintiffs were not entitled to any damages whatever; and if not, then the evidence excluded by the ruling of the court was entirely immaterial. But the evidence was properly rejected on the ground assumed by the presiding justice.

Counsel fees are not a proper element for the consideration of the jury in the estimation of damages in actions for the infringement of a patent-right. That point has been directly ruled by this court, and is no longer an open question. Jurors are required to find the actual damages incurred by the plaintiff at the time his suit was brought; and if, in the opinion of the court, the defendant has not acted in good faith, or has caused unnecessary expense and injury to the plaintiff, the court may render judgment for a larger sum, not exceeding three times the amount of the verdict. 5 Stat. at Large, page 123; *Day v. Woodworth*, 13 How., 372. To maintain the issue on their part, the defendants offered three depositions, each tending to prove that the plaintiffs were not the original and first inventors of the improvement described in their letters patent.

Objection was seasonably made by the plaintiffs to the introduction of each of these depositions, on two grounds: 1. Because the first notice of special matter to be introduced at the trial did not accord with the proof offered, as contained in these depositions.

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2. Because the second notice of special matter to be thus introduced was served and filed without any order from the court, and therefore should be disregarded.

Exceptions were duly taken to the respective rulings of the court, in admitting each of these depositions; but as they all depend upon the same general considerations, they will be considered together.

It is conceded by the defendants that the first notice was, to some extent, insufficient. On the other hand, it is admitted by the plaintiffs that the terms of the second notice were sufficiently comprehensive and specific to justify the rulings of the court, in allowing the depositions to be read to the jury. They, however, insist upon the objection, taken at the trial, that it was served and filed without any order of the court, and that it was insufficient, because it was served and filed subsequently to the time when the depositions were taken and filed in court.

But neither of these objections can be sustained. All that the act of Congress requires, is that notice of the special matter to be offered in evidence at the trial shall be in writing, and be given to the plaintiff or his attorney more than thirty days before the trial. By the plain terms of the law, it is a right conferred upon the defendant; and of course he may exercise it in the manner and upon the conditions therein pointed out, without any leave or order from the court. When the notice is properly drawn, and duly and seasonably served and filed in court as a part of the pleadings, nothing further is required to give the defendant the full and unrestricted benefit of the provision.

Such notice is required, in order to guard patentees from being surprised at the trial by evidence of a nature which they could not be presumed to know or be prepared to meet, and thereby subject them either to delay or a loss of their cause. To prevent such consequences, the defendant is required to specify the names and places of residence of the persons on whose prior knowledge of the alleged improvement he relies to disprove the novelty of the invention, and the place or places where the same had been used. *Wilton v. Railroads*, 1 Wall. Jr., 195.

Compliance with this provision, on the part of the defendant, being a condition precedent to his right to introduce such special matter under the general issue, it necessarily follows that he may give the requisite notice without any leave or order from the court; and for the same reason, if he afterwards discovers that the first notice served is defective, or not sufficiently comprehensive to admit his defense, he may give another, to remedy the defect or supply the deficiency.

subject to the same condition, that it must be in writing, and be served more than thirty days before the trial.

Having given the notice as required by the act of Congress, the defendant at the trial may proceed to prove the facts therein set forth by any legal and competent testimony. For that purpose, he may call and examine witnesses upon the stand, or he may introduce any deposition which has been legally taken in the cause. Under those circumstances, depositions taken before the notice was served, as well as those taken afterward, are equally admissible, provided the statements of the deponents are applicable to the matters thus put in issue between the parties.

After the defense was closed, the plaintiffs offered evidence to impeach one of the witnesses, who had given material testimony for the defendants. When called, the impeaching witness stated that he knew the witness sought to be impeached, and knew other persons who were acquainted with the witness, and that they both resided in the city of Sacramento; whereupon the counsel of the plaintiffs put the question, "What is the reputation of the witness for moral character?" To that question, the counsel of the defendants objected, on the ground that the inquiry should be limited to the general reputation of the witness for truth and veracity, with the right to put the further inquiry, whether the witness testifying would believe the other on his oath; and the court sustained the objection, and rejected the testimony.

No reasons were assigned by the court for the ruling; and of course the only point presented is whether the particular question propounded was properly excluded.

Courts of justice differ very widely, whether the general reputation of the witness for truth and veracity is the true and sole criterion of his credit, or whether the inquiry may not properly be extended to his entire moral character and estimation in society. They also differ as to the right to inquire of the impeaching witness whether he would believe the other on his oath. All agree, however, that the first inquiry must be restricted either to the general reputation of the witness for truth and veracity, or to his general character; and that it cannot be extended to particular facts or transactions, for the reason that, while every man is supposed to be fully prepared to meet those general inquiries, it is not likely he would be equally so without notice to answer as to particular acts.

According to the views of Mr. Greenleaf, the inquiry in all cases should be restricted to the general reputation of the witness for truth and veracity; and he also expresses the opinion that the weight of

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authority in the American courts is against allowing the question to be put to the impeaching witness whether he would believe the other on his oath. In the last edition of his work on *The Law of Evidence*, he refers to several decided cases, which appear to support these positions; and it must be admitted that some of these decisions, as well as others that have since been made to the same effect, are enforced by reasons drawn from the analogies of the law, to which it would be difficult to give any satisfactory answer. 1 *Greenl. Ev.*, sec. 461; *Phillips v. Kingfield*, 19 Me., 375, per Shepley, J.; *Goss v. Stimpson*, 2 Sumn., 610; *Wood v. Mann*, 2 Sumn., 321; *Craig v. The State*, 5 Ohio N. S., 605; *Gilbert v. Sheldon*, 13 Barb., 623; *Jackson v. Lewis*, 13 Johns., 504; *United States v. Van Sickle*, 2 McLean, 219; *The State v. Bruce*, 24 Mo., 72; *Com. v. Morse*, 3 Pick., 196; *Gilchrist v. McKee*, 4 Watts, 380; *The State v. Smith*, 7 Vt., 141; *Frye v. Bank of Illinois*, 11 Ill., 367; *Jones v. The State*, 13 Tex., 168; *The State v. Randolph*, 24 Conn., 363; *Uhl v. Com.*, 6 Gratt., 706; *Wike v. Lightner*, 11 S. & R., 338; *Kemmel v. Kemmel*, 3 S. & R., 338; *The State v. Howard*, 9 N. H., 485; *Buckner v. The State*, 20 Ohio, 18; *Ford v. Ford*, 7 Humph., 92; *Thurman v. Virgin*, 18 B. Munroe, 792; *Perkins v. Noble*, 4 Ohio N. S., 668; *Bates v. Barber*, 4 Cush., 107.

On the other hand, a recent English writer on the law of evidence, of great repute, maintains that the inquiry in such cases properly involves the entire moral character of the witness whose credit is thus impeached, and his estimation in society; and that the opinion of the impeaching witness, as to whether he is entitled to be believed on his oath, is also admissible to the jury. 2 *Taylor Ev.*, secs. 1082, 1083.

That learned writer insists that the regular mode of examining into the character of the witness sought to be impeached, is to ask the witness testifying whether he knows his general reputation; and if so, what that reputation is, and whether, from such knowledge, he would believe him upon his oath. In support of this mode of conducting the examination, he refers to several decided cases, both English and American, which appear to sustain the views of the writer. *Rees v. Watson*, 32 How. St. Tr., 496; *Mawson v. Hartsink*, 4 Esp. R., 104; *Rex v. Rockwood*, 13 How. St. Tr., 211; *Carpenter v. Wall*, 11 Ad. & El., 803; Anonymous, 1 Hill, (S. C.), 259; *Hume v. Scott*, 3 A. K. Marshall, 262; *Day v. The State*, 13 Miss., 422; 3 *Am. Law Jour.*, N. S., 145.

Both Mr. Greenleaf and Mr. Taylor agree, however, that the impeaching witness must be able to state what is generally said of the other witness by those among whom he resides, and with whom he

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is chiefly conversant, and in effect admit, that unless he can so speak, he is not qualified to testify upon the subject, for the reason that it is only what is generally said of the witness by his neighbors that constitutes his general reputation. To that extent they concur, and so, as a general remark, do the authorities which on the one side and the other support these respective theories; but beyond that, the views of these commentators, as well as the authorities, appear to be irreconcilable.

In referring to this conflict of opinion among text writers, and judicial decisions, we have not done so because there is anything presented in this record that makes it necessary to choose between them, or even renders it proper that we should attempt at the present time to lay down any general rule upon the subject. On the contrary, our main purpose in doing so is to bring the particular question exhibited in the bill of exceptions to the test of both theories, in order to ascertain whether, under either rule of practice, it ought to have been allowed. Under the first mode of conducting the examination, it is admitted that it was properly rejected, and we think it was equally improper, supposing the other rule of practice to be correct. Whenever a witness is called to impeach the credit of another, he must know what is generally said of the witness whose credit is impeached by those among whom the last-named witness resides, in order that he may be able to answer the inquiry, either as to his general character in the broader sense, or as to his general reputation for truth and veracity. He is not required to speak from his own knowledge of the acts and transactions from which the character or reputation of the witness has been derived, nor indeed is he allowed to do so, but he must speak from his own knowledge of what is generally said of him by those among whom he resides, and with whom he is chiefly conversant; and any question that does not call for such knowledge is an improper one, and ought to be rejected. No case has been cited authorizing such a question, or even furnishing an example where it was put, and our researches in that direction have not been attended with any better success. For these reasons, we think the question was properly excluded. Some further attempts were made by the plaintiffs to impeach this witness, and with that view they called another witness, who testified that he knew the one sought to be impeached, and had had business transactions with him during the years 1852-'53, in the city where they resided. On being asked by the counsel of the plaintiffs what was the reputation of the witness for truth and veracity, he replied that he had no means of knowing what it was, not having had any dealings with him since



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those transactions; thereupon the same counsel repeated the question, limiting it to that period.

Objection was made to that question by the counsel of the defendants, on the ground that the period named in the question was too remote, and the court sustained the objection and excluded the question. To this ruling the plaintiffs excepted. Such testimony, undoubtedly, may properly be excluded by the court, when it applies to a period of time so remote from the transaction involved in the controversy as thereby to become entirely unsatisfactory and immaterial; and as the law cannot fix that period of limitation, it must necessarily be left to the discretion of the court. Considering that the witness had already stated that he was not able to answer the question, we do not think that the discretion of the court in this case was unreasonably exercised. None of the exceptions can be sustained, and the judgment of the Circuit Court is therefore

AFFIRMED WITH COSTS.

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THE MAYOR, ALDERMEN, AND COMMONALTY OF THE CITY OF NEW YORK, PLAINTIFFS IN ERROR, *v.* FRANKLIN RANSOM AND UZZIAH WENMAN.

(23 Howard, 487.)

In an action for damages for the infringement of a patent-right, the plaintiff must furnish some data by which the jury may estimate the actual damage. If he rests his case after merely proving an infringement of his patent, he may be entitled to nominal damages, but no more.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Southern District of New York.

The case is stated in the opinion of the court.

It was submitted on a printed argument by *Mr. Keller*, for the defendants in error; no counsel appearing for the plaintiffs in error.

Mr. Justice GRIER delivered the opinion of the court.

The plaintiffs in error were defendants in an action for infringement of a patent "for a new and useful improvement in the mode of applying water to fire-engines, so as to render their operation more efficient."

On the trial, they took some twenty-four exceptions to the rulings of the court in their charge to the jury; but they have not seen fit to appear in this court, and point out to us on which of these numerous

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exceptions they principally rely for the reversal of the judgment. The defendants in error have not elected to have the writ of error dismissed for want of prosecution, but have filed a printed argument, praying for an affirmance of the judgment.

On examination of the record, we find that the bill of exceptions contains no copy of the specification of the letters patent. Without this, we are unable to test the correctness of the construction of the patent by the court below.

But there is one exception which the record enables us to examine, and in which we think there is error.

The defendants' fourteenth prayer for instruction is as follows :

"The plaintiffs have furnished no data to estimate actual damage, and, therefore, in no aspect of the case can they recover more than nominal damages."

If the predicate of this proposition be true, the conclusion was correct, and the instruction should have been given by the court.

Where a plaintiff is allowed to recover only "actual damages," he is bound to furnish evidence by which the jury may assess them. If he rest his case, after merely proving an infringement of his patent, he may be entitled to nominal damages, but no more. He cannot call on a jury to guess out his case without evidence. Actual damages must be calculated, not imagined, and an arithmetical calculation cannot be made without *certain* data on which to make it.

The invention in this case was not one which enabled the patentee to make a profit by a monopoly of its use. Nor was it a separate and distinct machine, by the sale of which he could make a profit. The patent is for an improvement in the apparatus of the common fire-engine, by which the hydrostatic pressure of the water from the hydrant may be combined with the hydraulic pressure of the engine, and thus add to its power and efficiency. There was evidence tending to show the invention to be valuable, and that it could be applied to the engines in use at an expense of twenty-five dollars, thereby greatly increasing the power of the machine. It was proved that the city had applied this invention to fifty engines, but no information whatever of the price or value of a single license is given in the bill; fifty is the coefficient by which an unknown number is to be multiplied, and without further data the result is still an unknown quantity. If there had been any proof that the selling price of a single license for a single engine was four hundred dollars, the jury would have had something to support their verdict for \$20,000.

In the case of *Seymour v. McCormick*, 16 Howard, 485, it was decided, by this court, that where the profit of the patentee is derived

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neither from an exclusive use of the thing patented, nor from a monopoly of making it for others to use, the actual damage which he suffers by the use of his improvement without his license, is the price of it, with interest, and no more. It is to his advantage that every one should use his invention, provided he pays for a license. The only damage to the patentee is the non-payment of that sum when the infringer commences the use of the invention.

As the plaintiffs in this case did not furnish any evidence upon which to found a calculation of actual damages, the court should have instructed the jury as requested by the counsel. Instead of it, the court instructed the jury as follows:

“If the invention is valuable; if by its use the power and efficiency of the fire-engines belonging to the defendant are so increased that fifty engines used with this improvement are equal in practical effect to seventy-five, or any other number of engines, used without this improvement, the jury are at liberty to infer, if they think the inference a just one, that the defendant, in its corporate capacity, has saved the cost of the purchase and operation of the additional number of engines which would have been required to produce the same results if this invention had not been used; and that the corporate authorities, if they had admitted the plaintiffs’ rights, would have paid the amount of this additional cost, or a large portion of it, as the consideration for a license to use this invention, rather than to abandon its use; and that the plaintiffs have therefore lost by the infringement what the defendant would have so paid to secure such license. It is for this reason that the benefits received by the defendant in its corporate capacity, from the use of the invention, in the consequent reduction of its expenditures for fire-engines, and their management and operation, are proper subjects for consideration in determining the plaintiffs’ damages; and the jury must determine for themselves, upon the consideration of this and the other facts of the case, (if they find that the plaintiffs are entitled to recover,) what damages have been actually sustained by the plaintiffs in consequence of the unauthorized and wrongful acts of the defendant, being careful only to give the actual damages proved, and not to speculate upon the possibility, or even probability, of damages beyond such as are proved to have been sustained by the plaintiffs.”

It was of little use to caution the jury from giving speculative or any other than “actual damages,” after the large margin of inference and presumption which they were permitted to take in order to find data by which to calculate them.

It was said, in the case to which we have referred, “actual dam-

## Syllabus.

ages should be actually proved, and cannot be assumed as a legal inference from facts" which afford no data by which they can be calculated.

In order to find out the plaintiffs' loss or damage, the jury were allowed by the court to *infer* that the defendants have saved all the money indicated by the comparative powers of the engines with and without the improvement; and after having made this inference, they may *presume* that the defendants would have paid this amount to the plaintiff for the use of his improvement.

Thus the possible advantage or gain made by the use of plaintiffs' improvement on their machines, is made the measure of his loss. If the plaintiffs, unable to furnish any other data for a calculation, had proved that the defendants had made a certain amount of money by putting out the fires in New York, which the plaintiffs would otherwise have made by use of their invention, he might with some reason contend that this was a proper measure.

But if he fails to furnish any evidence of the proper data for a calculation of his damage, he should not expect that a jury should work out a result for him by inferences or presumptions founded on such subtle theories.

We therefore direct the case to be remanded for a *venire facias de novo*.

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WILLIAM H. PHILLIPS, PLAINTIFF IN ERROR, v. GEORGE PAGE.

(24 Howard, 164.)

1. In a patent taken out by Page for certain improvements in the construction of the portable circular saw-mill, he claimed the manner of affixing and guiding the circular saw, by allowing end-play to its shaft, in combination with the means of guiding it (the saw) by friction-rollers, embracing it near its periphery, so as to leave its center entirely unchecked laterally.
2. An instruction by the court below, that the claim was as stated above, but adding "in a saw-mill capable of being applied to the sawing of ordinary logs," was erroneous.
3. Although the improvements of the patentee may have enabled the machine to be applied to the purpose of sawing logs, when before it was applied only to the purpose of sawing light materials, such as shingles, and blinds for windows, yet there is nothing in the patent to distinguish the new parts of the machine from the old, or to state those parts which he had invented, so as to enable the machine to saw logs.
4. The Patent Law does not require the defendant to give notice of the time when any person may have possessed the knowledge or use of the invention in question, but only of the name of the person and of his place of residence, and the place where it has been used.

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5. An instruction of the court below, making the time material, was therefore erroneous.

THIS case was brought up by writ of error from the Circuit Court of the United States for the Northern District of New York.

The principal question related to the construction of Page's patent for improvements in the construction of a portable circular saw-mill, the circumstances of which are stated in the opinion of the court. Under the instructions of the court below, the jury found a verdict for Page, with \$50 damages, and \$466.14 costs. The bills of exception are stated in the opinion of the court.

It was submitted on printed arguments by *Mr. Keller*, for the plaintiff in error, and by *Mr. Reverdy Johnson* and *Mr. Latrobe*, for the defendant.

The arguments upon the points in the case are omitted, as not being likely to interest the profession generally.

Mr. Justice NELSON delivered the opinion of the court.

This is a writ of error to the Circuit Court for the Northern District of New York.

The suit was brought in the court below by Page, the defendant in error, to recover damages for the infringement of a patent for certain improvements in the construction of the portable circular saw-mill. After describing minutely the different parts, and manner of constructing the machine, with drawings annexed, and also the use and operation of the respective parts, the patentee sets forth the particular portion of the construction which he claims as his own, as follows:

"I claim the manner of *affixing and guiding the circular saw, by allowing end-play to its shaft, in combination with the means of guiding it (the saw) by friction-rollers, embracing it near its periphery, so as to leave its center entirely unchecked laterally.* I do not claim the use of friction-rollers, embracing and guiding the edge of a circular saw, as these have been previously used for that purpose; *but I limit my claim to their use, in combination with a saw having free lateral play at its center.*"

Evidence was given on the part of the defendant, in the course of the trial, tending to prove that, long before the time of granting the plaintiff's patent, and before the date of his invention, machines for sawing shingles from short blocks of timber, and sawing lath and blinds for windows, with circular saws, varying in size from ten to thirty inches in diameter, had been in public use; in which machines

the circular saw was guided by means of guide pins, embracing it (the saw) near the periphery, and its shaft having end-play, and being entirely unchecked laterally; but it did not appear that such machines had been used in a saw-mill for sawing timber, or in a mill, or a machine of a size or character adapted to the sawing of ordinary logs, or other large unsawed timbers.

When the evidence closed, the defendant's counsel prayed the court to charge the jury, that according to the true construction of the patent, the claim is for the manner of affixing and guiding the circular saw, by allowing end-play to its shaft, in combination with the means of guiding it by friction-rollers, embracing it near its periphery, so as to leave its center entirely unchecked laterally.

But the court refused so to charge, and instructed the jury that the claim was limited to the manner of affixing and guiding the circular saw, by allowing end-play to its shaft, in combination with the means of guiding it by friction-rollers, embracing it near its periphery, so as to leave its center unchecked laterally, *in a saw-mill capable of being applied to the sawing of ordinary logs.*

And in refusing another prayer, the court charged, that in order to defeat the plaintiff's patent by the use of prior machines of this construction, they must have been machines for the purposes of sawing in mills of a size and character adapted to the sawing of ordinary logs.

There can be no doubt but that the improvements of the patentee in the manner of constructing the portable circular saw-mill described in his specification were designed to adapt it to the sawing of logs in a saw-mill, and which could be carried from place to place, and put into operation by the use of horse-power; and it may very well be, if he had set up in his claim the improvements or particular changes in the construction of the old machine, so as to enable him to adapt it to the new use, and one to which the old had not and could not have been applied without these changes, the patent might have been sustained. The utility is not questioned, and, for aught there appears in the case, such improvements were before unknown, and the circular saw-mill for sawing logs the first put in successful operation.

But no such claim is set up by the patentee; nor does he distinguish in the description of the parts of the machine, nor in any other way, the old from the new, or those parts which he has invented or added in its adaption to the use of sawing logs, not before found in the old machine for sawing shingles, blinds for windows, and other light materials. On the contrary, his claim is for the precise organ-

## Opinion of the court.

ization of the old machine, namely, the manner of affixing and guiding the circular saw, by allowing end-play to its shaft, in combination with the means of guiding it by friction-rollers, embracing it near to its periphery, so as to leave its center entirely unchecked laterally. There is nothing new in this combination. It had long been known and used in the circular saw for sawing timbers of smaller dimensions than an ordinary saw-log. Nor does the enlargement of the organization of the machine compared with the old one, (the same being five feet in diameter, and the other parts corresponding,) afford any ground, in the sense of the Patent Law, for a patent. This is done every day by the ordinary mechanic in making a working machine from the patent model.

The patentee in the present case must carry his improvements farther, in order to reach invention; he must contrive the means of adapting the enlarged old organization to the new use, namely, the sawing of saw-logs, and claim, not the old parts, but the new device, by which he has produced the new results.

The learned judge, by interpolating the new purpose of the improvement, namely, the sawing of logs, not only inserted what was not specified in the claim, but, if it had been, it would not have helped out the difficulty, as it was in effect, upon the construction given, simply applying an old organization to a new use, which is not a patentable subject.

The defect here is both in the specification and in the claim. The former does not distinguish the new parts from the old, nor is there anything in the specification by which they can be distinguished; and the latter, instead of claiming the old parts, should have excluded them, and claimed the new, by which the old were adapted to the new use, producing the new result.

We are also of opinion the court below erred in rejecting the evidence of the witness as to the prior knowledge and use of the improvement of the patentee.

The fifteenth section of the Patent Law provides, that when the defendant relies in his defense on the fact of a previous invention, knowledge, or use of the thing patented, he shall give notice of the names and places of residence of those whom he intends to prove possessed the prior knowledge, and where the same was used.

In this case, the notice stated that Hiram Davis, who resided at Fitchburg, Massachusetts, had knowledge of the said improvement, and of the use thereof at that place, during the years 1836, 1837, 1838, &c., and that he resided there.

The court, on objection, refused to allow a witness to prove the

use of the improvement by Davis prior to the year 1836 at Fitchburg, holding that the notice limited it within that time.

Notice of the time when the person possessed the knowledge or use of the invention is not required by the act; the name of the person, and of his place of residence, and the place where it has been used, are sufficient.

The time, therefore, was not material; nor could it have misled the plaintiff, as he had the name and place of residence of the person, and also the place where the improvement had been used.

With this information of the nature and ground of the defense, the plaintiff was in possession of all the knowledge enabling him to make the necessary preparation to rebut, that the defendant possessed to sustain it.

Judgment reversed and *venire*.





## DIGESTED ABSTRACT.

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### ABANDONMENT.

1. An inventor may abandon his invention, or dedicate it to the public; and this inchoate right, thus once gone, cannot afterward be resumed. *Pennock v. Dialogue*, 127.
2. Under the act of 1793, the acquiescence of an inventor in the public sale or use of his invention before his application for a patent, creates a disability to comply with the terms and conditions on which alone he could receive a patent. *Ibid.*
3. Any acquiescence in the public use by the inventor will be an abandonment of his right; but if the right were asserted by one who fraudulently obtained it, perhaps no lapse of time could give it validity. *Shaw v. Cooper*, 173.
4. If an individual witness a sale and transfer of real estate, in which he has an equitable lien or interest, and does not make known his interest, he shall not afterward be permitted to assert it. On this principle it is that a discoverer abandons his right, if before the obtainment of his patent his discovery goes into public use. But his right would be secured by giving public notice that he was the inventor of the thing used, and that he should apply for a patent. *Ibid.*
5. A strict construction of the act, as it regards the public use of an invention before it is patented, is required also by sound policy. The doctrine of presumed acquiescence, where the public use is known, or might be known, to the inventor, is the only safe rule which can be adopted on this subject. *Ibid.*
6. Whatever may be the intention of the inventor, if he suffers his invention to go into public use, through any means whatever, without an immediate assertion of his right, he is not entitled to a patent; nor will a patent obtained under such circumstances protect his right. *Ibid.*
7. After the right is perfected by a patent, no presumption arises against it by a subsequent use by the public. *Ibid.*
8. The decision of the court below as to a dedication of an invention by a description of it in the specification of a former patent, is erroneous. By the defects mentioned in the statute, and to remedy which a surrender and reissue is permitted, nothing passes to the public from the specifications and claims within the scope of the patentee's invention. *Battin v. Taggart*, 969.
9. An inventor may abandon his invention to the public, either by express declaration or conduct equally significant—such, for instance, as an acquiescence, with full knowledge, in the use of his invention by others. *Kendall v. Winsor*, 1108.
10. The cases of *Pennock v. Dialogue*, 2 Pet., 1, and *Shaw v. Cooper*, 7 Pet., 292, may be regarded as leading cases upon the questions of the relinquishment of patent privileges as resulting from abandonment, neglect, or use known and assented to. *Ibid.*

See APPLICATION; JURY; PRIOR USE; SECRET USE.

## ACCOUNT OF PROFITS.

1. In a bill filed for an injunction and for an account of profits, the defendant is accountable for such profits as he has actually made, and not for such as "with due diligence and prudence" might have been made. *Livingston v. Woodworth*, 922.
2. An account of profits may be ordered under the prayer for general relief. *Stevens v. Gladding*, 981.
3. The right to an account for profits is incidental to the right to an injunction in copyright and patent cases. *Ibid.*
4. An agreement made with a patentee to manufacture his patented machines, and the making and selling of such machines under the patentee's title, estops such party, in an action for account brought by the patentee, from alleging the invalidity of the patent. *Kinsman v. Parkhurst*, 997.
5. Even if the patent was invalid, it would not have rendered the sales of the machines illegal, so as to release such party from the obligation to account. *Ibid.*
6. And if such an agreement was void, as against public policy, it would furnish no answer to a claim for an account of profits realized. *Ibid.*

See DAMAGES.

## ACTIONS.

1. Under section 5 of the act of 1793, an assignee of a part of a patent-right cannot maintain an action for a violation of it. *Tyler v. Tuel*, 1.
2. In construing a patent, the intention of the government and the patentee is entitled to great consideration; the authorizing the issue of the patent, the petition for the issue of the patent, and the specification may all be resorted to for such intention. *Evans v. Eaton*, 8.
3. The purchase of an article, made in violation of a patent of a third person, but without any connection on the part of such purchaser with the manufacture, except as a purchaser, will not make the party buying guilty of an infringement of the rights of the patentee, as having used the patented invention. *Keplinger v. De Young*, 122.
4. At common law, the author has a property in his manuscript, and may obtain redress against any one who deprives him of it, or endeavors to realize a profit from its publication. *Wheaton v. Peters*, 200.
5. The grantee of an exclusive right, limited to the use of a certain number of machines within a certain territory, has such an exclusive right as will enable him to maintain an action for an infringement within that district, under section 14 of the act of 1836. *Wilson v. Rousseau*, 357.
6. A contract to use a patented machine during the continuance of the patent, and to pay therefor a fixed proportion of the value of the fuel saved thereby, will not support an action until the expiration of the patent. *Washington and Alexandria Steam Packet Co. v. Sickles*, 554.
7. But if the defendants had agreed to pay by installment at the end of certain times, an action would lie for every breach as occurring. *Ibid.*
8. An action for an infringement cannot be maintained by an inventor against any one for using his invention before a patent is obtained. *Gayler v. Wilder*, 576.
9. The purchaser of a machine or implement for use in the ordinary pursuits of life, does not become possessed of a portion of the franchise or monopoly conferred by the patent; but when the machine passes into his hands it is no longer within the limits of the monopoly, or under the protection of the acts of Congress, and if his right is infringed he must seek redress in the

**ACTIONS—continued.**

courts of the State, and not in the courts of the United States, or under the acts of Congress. *Bloomer v. McQuewan*, 730.

10. Under section 11 of the judiciary act of 1789, jurisdiction of the person of a defendant can only be obtained, in a civil action, by service of process on his person within the district where the suit is instituted. *Chaffee v. Hayward*, 1054.
11. And this provision is not changed by any of the process acts, or by the act of Congress conferring jurisdiction on the Circuit Courts in patent cases, without regard to citizenship. Section 11 of the judiciary act is not affected by the subsequent process acts, and it applies to *all* civil suits. *Ibid.*

See **APPEALS; ASSIGNMENT; COMMISSIONER OF PATENTS; COURTS; DAMAGES; DEFENSES; INFRINGEMENT; PATENT; PLEADING.**

**ADMINISTRATORS.**

1. Section 18 of the act of 1836 authorizes the extension of a patent on the application of the executor or administrator, although the patentee had, during his lifetime, disposed of all his interest. *Wilson v. Rousseau*, 357.
2. Such extension inures to the benefit of the administrator only in such capacity, and not to assignees or grantees, so as to vest in them any exclusive right whatever. But those who are in the use of the patented article at the time of the renewal may continue to use such machines or articles. *Ibid.* (McLean, J., and Woodbury, J., dissenting.)
3. An administrator may, under section 18 of the act of 1836, take an extension of a patent. *Woodworth v. Wilson*, 428.

**AFFIRMED CASES.**

See **EXAMINED CASES.**

**AGREEMENTS.**

1. Where a contract provided for a certain mode of ascertaining the amount of fuel saved by the use of the patent in steam machinery, evidence having been given of that test, it is competent to confirm it by other tests made by others in other boats. *Washington and Alexandria Packet Co. v. Sickles*, 554.
2. An agreement between B and C and others, as follows, "that the said parties may each hereafter manufacture and vend spikes of such kind and character as they see fit, notwithstanding their conflicting claims to this time," must be construed with reference to the situations of the parties to it; and B having claimed that he had the exclusive right, under his patent, to make such spikes, which right the defendant, C, was infringing, but the defendant claiming that he did not infringe such patent, but made spikes by an entirely different method: *Held*, That such agreement did not give C a license to make such spikes after B's patent, but only a right to make them by the same process or machinery he had been using before. *Troy Iron and Nail Factory v. Corning*, 691.
3. A stipulation in a patent suit provided a decree should be entered for the plaintiffs, unless the machine used by the defendant was constructed before the date of the application of plaintiffs for their patent: *Held*, That the time when such machine was so "constructed" meant when it was substantially complete in its parts, and that it was not necessary that it should be doing work. *Troy Iron and Nail Factory v. Odiorne*, 967.
4. An agreement made between a patentee with another, that in case of

**AGREEMENTS—continued.**

renewal he will convey to him such renewed patent in consideration of a certain sum, is valid; and if the patent is renewed, such agreement conveys to the assignee an equitable interest or title to the entire interest of the assignor, which can be converted into a legal title by paying, or offering to pay, the agreed consideration. *Hartshorn v. Day*, 1031.

5. An agreement made between a patentee and a trustee, that the latter should hold the patent and have control thereof, for the benefit of those who had a right to use the same, without the written consent of such trustee, transfers the entire interest, legal and equitable, of the patentee to such trustee, for the benefit of those interested. *Ibid.*
6. A neglect to pay to such patentee an annuity provided for in such agreement to be paid by the trustee to the patentee, will not rescind the contract or remit to the patentee the interest conveyed. The right to such annuity rests in covenant, for a breach of which an action at law will lie. *Ibid.*

See ACCOUNT OF PROFITS; ACTIONS; ASSIGNMENT; INFRINGEMENT;  
LICENSE; RESTRAINT OF TRADE.

**ALIENS.**

1. As to the rights of a patentee to surrender a defective patent, there is no difference between a citizen and an alien. *Shaw v. Cooper*, 173.
2. By the provisions of the Patent Acts, (1793 and 1800,) citizens and aliens, as to patent-rights, are placed substantially on the same ground. *Ibid.*

**AMBIGUITY IN PATENTS.**

1. The invention cannot be established by comparing the invention specified in the patent with former ones in use. *Evans v. Eaton*, 48.
2. The degree of clearness required in the specification, under the act of 1793, is to "distinguish the invention from things before known, and to enable any person skilled in the art or science to make and use the same." *Hogg v. Emerson*, 438.
3. But the patentee need not describe particularly, and disclaim all the old parts. *Ibid.*

See COMPOSITION OF MATTER; DEFENSES; PATENT; SPECIFICATION.

**AMOUNT IN CONTROVERSY.**

1. Where a bill is filed to enforce a specific performance of a contract in relation to a patent, the Supreme Court has no appellate jurisdiction, unless the matter in controversy exceeds the value of two thousand dollars. *Brown v. Shannon*, 1044.
2. The amount of the penalty in a bond taken in the court below, cannot be referred to, to give jurisdiction. *Ibid.*

See APPEALS.

**ANSWER.**

See APPEALS.

**ANNULMENT OF PATENT.**

See COURTS.

**APPEALS.**

1. Under section 17 of the act of 1836, if a writ of error is allowed in cases where the amount in dispute does not reach two thousand dollars, and in

APPEALS—*continued.*

- such as are deemed "reasonable," it must bring up the whole case for consideration. *Hogg v. Emerson*, 438.
2. The word "reasonable" applies to the cases, rather than to any discrimination between the different points in the cases. *Ibid.*
  3. A decree for a perpetual injunction, and a reference to a master to report the damage sustained by the plaintiff, is not a final decree so that an appeal will lie. *Barnard v. Gibson*, 487.
  4. Section 17 of the act of 1836, providing for appeals and writs of error, does not apply to a suit in equity to set aside an assignment of a patent. *Wilson v. Sandford*, 532.
  5. The right of appeal is confined to the cases mentioned in the first part of the section, and was intended to secure uniformity of decision in the construction of the acts of Congress in relation to patents. *Ibid.*
  6. The law does not give a party who is not aggrieved an appeal from a decree in his favor, because the judge has given no reasons, or insufficient ones, for the judgment admitted to be correct. *Corning v. Troy Iron and Nail Factory*, 906.
  7. Where a complainant in a patent suit had a decree in his favor, and the respondent appealed: *Held*, If the complainant desired a more favorable decree, he must enter a cross-appeal. *Ibid.*
  8. A second appeal lies when the court below, in carrying out the mandate of the Supreme Court, is alleged to have committed an error. On an appeal from a mandate, nothing is before the court but the proceedings subsequent to the mandate. *Ibid.*
  9. The defendant took two grounds of defense; the Circuit Court decided against him on one and dismissed the bill on the other; on appeal to the Supreme Court, the decree was reversed and the cause remanded: *Held*, That the defendant could not then appeal from the decision of the Circuit Court on the ground originally decided against him. *Ibid.*
  10. An objection to the joinder of an assignor with an assignee as complainant, comes too late on appeal. *Livingston v. Woodworth*, 922.
  11. The power as to granting appeals and writs of error, in patent cases, vested in the Circuit Courts by section 17 of the act of 1836, is confined to cases which involve the construction of the Patent Laws, and does not justify the allowance of a writ of error to review a question of costs. *Sizer v. Many*, 937.
  12. As a motion to allow an answer to be filed, made after the bill has been taken *pro confesso*, is addressed to the discretion of the court, an appeal does not lie to the Supreme Court for a refusal to grant such leave. *Dean v. Mason*, 1048.

See AMOUNT IN CONTROVERSY; BILL OF EXCEPTIONS; SUPERSEDEAS;  
WRIT OF ERROR.

## APPLICATION.

1. The authority to issue patents is a limited one, and the party must bring himself within the terms of the statute before he can derive any title to demand a patent. *Pennock v. Dialogue*, 127.
2. Under the act of 1793, the Secretary of State in issuing patents may be considered as a ministerial officer. If the prerequisites of the law are complied with, he can exercise no judgment on the question whether the patent shall issue. *Grant v. Raymond*, 146.
3. To entitle an individual to the privileges secured under the Patent Law, vigilance is necessary. And if the invention, by fraudulent means, shall

APPLICATION—*continued*.

be made known to the public, the inventor should assert his right immediately. *Shaw v. Cooper*, 173.

4. In 1853 there was nothing in the acts of Congress which required that a patent should be issued within any given time after the application was filed. *O'Reilly v. Morse*, 763.
5. It has always been the practice, when a foreign patent is desired, to delay the issuing of a patent here, for fear of injuring such foreign application. *Ibid*.
6. The law allows for a delay requisite for completing an invention, or testing its value or success. *Kendall v. Winsor*, 1108.

See ABANDONMENT; ASSIGNEE; DRAWINGS; PATENT; STATUTES, CONSTRUCTION OF.

## APPROVED CASES.

See EXAMINED CASES.

## ART.

1. An invention of a new improvement in an art, as of casting iron, by giving an angular direction to the tube which conducts the metal to the mould, so that the slag or dross will be thrown into the center instead of the surface, is patentable. *McClurg v. Kingsland*, 322.
2. A process, *eo nomine*, is not the subject of a patent under our laws. It is included under the general term "useful art," and an art may require one or more processes or machines. *Corning v. Burden*, 867.

See ARTS, LOST; MANUFACTURE; MODE; PRINCIPLE.

## ARTS, LOST.

1. If any one discovers an art which had been lost, and it is a useful improvement, he will be entitled to a patent. *Gayler v. Wilder*, 576.
2. He would be the first to confer on the public the benefit of the invention. He would discover what is unknown, and communicate knowledge which the public had not the means of obtaining without his invention. *Ibid*.
3. Where an iron and fire-proof safe had been invented and used by the inventor, but no test had been applied to it, and its capacity for resisting heat was not known, and there was nothing to show that any particular value had been placed upon it, and the inventor never made a second one, and the safe itself had disappeared, it was held that it had passed away from the memory of the inventor himself, and of those who had seen it, and that the knowledge of the improvement was as completely lost as if it had never been discovered, and that a subsequent inventor of the same thing, without any knowledge of the former one, was entitled to a patent. *Ibid*.
4. The term lost art is applicable peculiarly to certain monuments of antiquity still remaining, the process of whose accomplishment has been lost for centuries, with all vestige of the archives or records of the nations with whom those arts existed, and the origin, or even the identity, of which process none can certainly establish. *Ibid*. (Dissenting opinion.)
5. If a means of producing the effect we see and have among us be discovered, and none can, either by history or tradition, refer to a similar or to the identical process, the inventor of that means may claim the merit of originality, though the work itself may have been produced possibly by the same means. *Ibid*. (Dissenting opinion.)

## ARTICLE OF MANUFACTURE.

See MANUFACTURE.

## ASSIGNEE.

1. The rights of an assignee of a manuscript would be protected by a court of equity. *Wheaton v. Peters*, 200.
2. If after the assignment of a patent the patent issue to the inventor, a new assignment is not necessary. *Gayler v. Wilder*, 576.
3. An assignee by an assignment executed before patent issued, even though the patent is issued to the inventor, has the legal title necessary to enable him to maintain an action for an infringement. *Ibid.*
4. To enable an assignee of a sectional interest in a patent to sue in his own name, he must have the exclusive right which the patentee held in the territory specified. *Ibid.*
5. The purchaser of an exclusive privilege of *making* and *vending* a thing patented, buys a portion of the franchise conferred by the patent. *Bloomer v. McQuewan*, 730.
6. But the purchaser of the thing for the purpose of *using* it in the ordinary pursuits of life, stands on different ground. He exercises no right created by the acts of Congress, nor does he derive title by virtue of the franchise or exclusive privilege granted to the patentee. *Ibid.*
7. An assignee of a contract, taking *pendente lite*, or with a knowledge of the state of things existing between the original parties to the contract, is bound by the same equities that existed between such parties. *Kinsman v. Parkhurst*, 997.

See ACTIONS; APPEAL; ASSIGNMENT; EXTENSION; PARTNERSHIP.

## ASSIGNMENT.

1. An assignment of an exclusive right to make, use, and vend to others a patented machine within a specified territory only, does not prohibit the assignee from selling outside of the said territory the product of such machine. *Simpson v. Wilson*, 424.
2. The restriction in the assignment applies solely to the using of the machine, and not to the place of the sale of the product. *Ibid.*
3. An assignment of a patent may be made as well before the issuing of the patent as afterwards. When a party has acquired an inchoate right, an assignment of it is legal. *Gayler v. Wilder*, 576.
4. Delay in making an assignment of a patent for some years after an agreement to sell, is not of itself evidence of fraud. *Troy Iron and Nail Factory v. Corning*, 691.
5. The property acquired by the sale of an engraved plate, or stereotype plates, and the copyright of a book or map secured to the author under the acts of Congress, have no necessary connection with each other. *Stephens v. Cady*, 726.
6. The incorporeal right secured by the statute to the author, is not the subject of seizure or sale by execution—at least at common law. But it may be reached by a creditor's bill, and applied to the payment of the debts of the author. *Ibid.*
7. It may, however, be doubted whether a transfer by sale under a decree of court would protect the purchaser, unless in conformity with the requirements of the statute. *Ibid.*
8. The sale of a copper-plate on an execution does not pass to the purchaser the right to publish the map engraved upon it. *Ibid.*
9. It may well be doubted whether patents and copyrights are subject to seizure on execution; such rights do not exist in any particular State, but are co-extensive with the United States. *Stevens v. Gladding*, 981.
10. The incorporeal right subsists wholly independent of the plate, and does not pass with it by a sale or execution. *Ibid.*

See ASSIGNEE; CONGRESS; EXTENSION; LICENSE.



## ATTACHMENT.

1. The attachment of the property of a non-resident defendant does not confer jurisdiction upon the Circuit Courts. *Chaffee v. Hayward*, 1054.

## AUTHOR.

See COPYRIGHT; MANUSCRIPT.

## BILL IN EQUITY.

See EQUITY.

## BILLS OF EXCEPTIONS.

1. The spreading *in extenso* of the judge's charge upon the record, is unnecessary and inconvenient. The substance only of the charge is to be examined; and if it appears, upon the whole, that the law was justly expounded to the jury, general expressions, which might need qualification if they were the direct point in judgment, are to be understood in such restricted sense. *Evans v. Eaton*, 48.
2. Where no exception is taken to the competency or sufficiency of the evidence, the putting of it on the record is an expensive and unnecessary burden. *Pennock v. Dialogue*, 127.
3. Where the charge of the court presented only a general principle of law, it is not necessary to put any part of the evidence upon the record. *Ibid.*
4. Exceptions taken to a judge's charge to a jury, should be to the points ruled by the court. *Stimpson v. West Chester R. R. Co.*, 330.
5. A judgment will not be opened to enable the plaintiff in error to amend the bill of exceptions. *Gayler v. Wilder*, 608.
6. It must appear by the record that an exception to instructions was taken while the jury were at the bar. *Phelps v. Mayer*, 844.
7. An objection not taken in the court below, cannot be taken on appeal. *Kinsman v. Parkhurst*, 997.
8. The Supreme Court is confined to the evidence in the bill of exceptions. *Chaffee v. Boston Belting Co.*, 1124.
9. Bills of exceptions duly allowed become a part of the record, and as such cannot be contradicted. *Ibid.*

See WRIT OF ERROR.

## BURDEN OF PROOF.

See EVIDENCE.

## CHARGE OF JUDGE.

1. If either party deems any point presented by the evidence to be omitted in the charge, it is competent for such party to require an opinion of the court upon that point. If he does not, it is a waiver of it. The court cannot be presumed to do more, in ordinary cases, than to express its opinion upon the questions which the parties themselves have raised at the trial. *Pennock v. Dialogue*, 127.
2. Instructions should always be limited to the facts or evidence in the cause; and instructions which are general, abstract, or not springing from and pertinent to the facts of the case, are calculated to mislead the jury, and are therefore improper. *Gayler v. Wilder*, 576, Diss. Opin.

See BILL OF EXCEPTIONS; EVIDENCE.

## CLAIM.

See COMBINATION; FORM; PATENT; SPECIFICATION.

## COMBINATION.

1. If a patented combination consists of three parts, the use of any two of such parts only, or of the two combined with a third which is substantially different in form, or in the manner of its arrangement, or connection with the others, is not the use of the thing patented. *Prouty v. Ruggles*, 311.
2. One combination is not the same with another, if it differs from it in any of its parts. *Ibid.*
3. A patentee of an improvement in the cotton-gin, claimed his invention as consisting in a particular form of the rib for separating the fibre from the seed, and so connecting the lower and upper surfaces of the rib, that *when the rib was inserted in the frame* there should be no break or shoulder, but a smooth, uninterrupted passage between the ribs: *Held*, That his patent was for the combination of the form of the rib, of the manner of connecting its upper and lower surfaces, and the manner of fixing or fastening it to the frame as stated; and that if the defendants did not fix or fasten the ribs of their machine against the frame-work substantially in the manner described in plaintiff's patent, they were not guilty of any violation of plaintiff's patent. *Carver v. Hyde*, 316.
4. The defendant having used but one element of the plaintiff's combination, did not infringe his patent. *Stimpson v. Baltimore and Susquehanna R. R. Co.*, 535.
5. Where a patentee claims a combination as his invention, his claim can only be sustained by establishing its novelty. *Le Roy v. Tatham*, 657.
6. A claim for a combination which does not point out and designate the particular elements which compose it, but only that the combination is made up of so much of the described machinery as effects a particular result, may be sufficient. It is a question of fact which of the described parts are essential to that result; and to this extent, not the construction, but the application of the claim, should be left to the jury. *Silsby v. Foote*, 717.
7. If a combination has three different parts, and the result is accomplished by the union of all these parts, arranged with reference to each other, the use of two of these parts only, combined with a third substantially different from the former, is not the same combination. *Brooks v. Fiske*, 846.
8. If an invention is an improvement on a known machine, by a mere change of form, the patentee cannot treat another, who has improved the original machine by the use of a different form or combination, performing the same functions as an infringer. *McCormick v. Tulcott*, 1085.
9. A claim for a combination is not infringed by one who uses a part of the combination. *Ibid.*
10. Though a combination, or a part of it, may not be new, if it is combined and modified so as to produce new results, there is novelty, within the Patent Law. *Le Roy v. Tatham*, 1116.
11. One new agency in the production of the result, gives novelty to the combination. *Ibid.*

See COMPOSITION OF MATTER; EQUIVALENT; FORM; MANUFACTURE; NEW APPLICATION; INFRINGEMENT.

## COMMISSIONER OF PATENTS.

1. The performance of the prerequisites of the patent is reëxaminable in any action brought upon it, as the Secretary of State acts ministerially. *Grant v. Raymond*, 146.
2. The decision of the officers of the government in granting a reissued patent, is *prima-facie* evidence that the claim for a reissue was within the statute; and conclusive, except as to fraud. *Stimpson v. West Chester R. R.*, 330.

COMMISSIONER OF PATENTS—*continued.*

3. The decision of the Board of Commissioners upon an application for the extension of a patent under section 18 of the act of 1836, is not conclusive upon the question of their jurisdiction to act in a given case. *Wilson v. Rousseau*, 357.
4. A patent is not invalid because it is certified by a person as "Acting" Commissioner. *Ibid.*
5. A patent signed by "an Acting Commissioner of Patents" is valid. *York and Maryland R. R. v. Winans*, 956.
6. The courts will judicially take notice of the persons who preside over the Patent Office. *Ibid.*
7. The proceedings before the Commissioner of Patents, on the reissue of a patent, are not open for consideration, except on the ground of fraud. *Battin v. Taggart*, 969.

See APPLICATION; COPIES; EXTENSION; REISSUE.

## COMPOSITION OF MATTER.

1. In a patent for a composition of matter, the specification must be in such full, clear, and exact terms as to enable one skilled in the art to which it appertains to compound and use the invention without making any experiments of his own. *Wood v. Underhill*, 432.
2. Where the specification of a new composition of matter gives only the names of the substances to be mixed together, without stating any relative proportion, it would be the duty of the court to declare the patent void; as it would not enable any one to compound and use the invention without experiment. *Ibid.*
3. But where the patentee gives a certain proportion as a general rule, which seems generally applicable, the patent will be valid, though some small difference in the proportions may be occasionally required. *Ibid.*
4. In most compositions of matter, some small difference in the proportions must occasionally be required, since the ingredients proposed to be compounded must sometimes be in some degree superior or inferior to those most commonly used. *Ibid.*

See MANUFACTURE.

## CONGRESS.

1. Whether Congress can decide the fact that an individual is an inventor or author, the courts will never presume it to have decided that question in a general act, the words of which do not render such a construction unavoidable. *Evans v. Eaton*, 8.
2. A private act of Congress authorizing the issue of a patent to an inventor, is ingrafted on the general acts for the promotion of the useful arts, and such a patent is issued in pursuance of both. *Ibid.*
3. The power of Congress to legislate upon the subject of patents, is plenary, by the terms of the Constitution; and as there are no restraints upon its exercise, there can be no limitation of their right to modify the laws at their pleasure, so that they do not take away the rights of property in existing patents. *McChurg v. Kingsland*, 322.
4. Laws respecting patents may be retrospective in their operation. *Ibid.*
5. A special act in relation to any particular patent, is ingrafted upon the general acts relating to patents; they are statutes in *pari materia*, and must be construed together. *Bloomer v. McQuewan*, 730.
6. Under the fifth amendment of the Constitution, Congress would have no right to pass an act depriving purchasers of a patented article of the right to use such article. *Ibid.*

CONGRESS—*continued*.

7. Under the authority conferred upon Congress, it does not follow that it may authorize an inventor to recall rights which he has granted to others. *Ibid*.  
See COPYRIGHT; STATUTE, CONSTRUCTION OF.

## CONSTRUCTION OF CONTRACT.

See AGREEMENT; ASSIGNMENT; ASSIGNEE; LICENSE.

## CONSTRUCTION OF PATENT.

See ACTIONS; PATENT.

## CONSTRUCTION OF STATUTE.

See CONGRESS; STATUTES, CONSTRUCTION OF.

## CONTRACTS AS TO PATENTS.

See AGREEMENTS.

## COPIES.

1. It is the duty of the Commissioner of Patents to give authenticated copies to any person demanding the same, on payment of the legal fees; and for his refusal, an action will lie against him. *Boyden v. Burke*, 754.
2. Although a demand accompanied by rudeness and insult is not a legal demand, a subsequent and proper demand cannot be refused on account of prior misconduct, or to enforce an apology. *Ibid*.

## COPYRIGHT.

1. An author can have no exclusive property in his published production, except under the acts of Congress. *Wheaton v. Peters*, 200.
2. Under the act of 1790, considered in connection with the act of 1802, an author can obtain no exclusive right in his work unless he complies with the requirements of sections 3 and 4 of the act of 1790. *Ibid*.
3. A claim under a renewal term of a copyright involves the validity of the right under the first. *Ibid*.
4. Copyright is an exclusive right to the multiplication of copies, disconnected from any physical existence. *Stephens v. Cady*, 726.

See ACTIONS; ASSIGNEE; ASSIGNMENT; COURTS; INJUNCTION; MANUSCRIPT; PENALTY; REPORTS; STATUTES, CONSTRUCTION OF.

## CORPORATIONS.

A railroad corporation created by one State, and owning a road in that State, is liable for the use of a patented improvement on cars run on that road, though another corporation held the stock and worked the road. *York and Maryland R. R. Co. v. Winans*, 956.

## COSTS.

1. It is proper for the court to have the costs taxed and entered *nunc pro tunc* as a part of the original judgment. *Sizer v. Many*, 937.
2. Under the act of 1837, the plaintiff is not entitled to recover costs upon a judgment in his favor, if he has claimed anything of which he was not the original and first inventor, unless, before suit brought, he has disclaimed such part. *Seymour v. McCormick*, 1004.

See DISCLAIMER.

## COUNSEL FEES.

Counsel fees are not a proper element for the jury in the estimation of damages. *Teese v. Huntingdon*, 1130.

## COURTS.

1. Under section 10 of the act of 1793, if the judge of the District Court grant a rule to show cause why a process should not issue to repeal a patent, the making of such rule absolute, does not *de facto* work a repeal of the patent; but the process to be awarded upon making such rule absolute is in the nature of a *scire facias* at common law to the patentee, to show cause why the patent should not be repealed; and upon such process being returned, the judge is to proceed to try the cause upon the pleadings and the issue joined therein. *Wood & Brundage, Ex parte*, 115.
2. The question whether one machine is substantially like another, cannot be certified to the Supreme Court under section 6 of the act of 1802, chapter 31, which applies only to questions of law. *Wilson v. Barnum*, 510.
3. Where the principles governing a patent cause have been settled by the Supreme Court, it will decline to hear an argument upon technical questions of pleading arising in another case under the same patent. *Smith v. Ely*, 838.
4. The act of February 15, 1819, is the only law conferring equitable jurisdiction in cases of copyright. Section 9 of the act of 1831 protects manuscripts only. *Stevens v. Gladding*, 981.
5. The equity jurisdiction of United States courts does not extend to the adjudication of forfeitures; therefore a decree cannot be entered for the penalties incurred for violation of a copyright. *Ibid.*
6. The jurisdiction of the Circuit Court is materially different, whether a party is seeking to enforce the specific performance of a contract in relation to a patent, or to prohibit the infringement of a patent belonging to him. *Brown v. Shannon*, 1044.

See ACTIONS; AMOUNT IN CONTROVERSY; APPEAL; ASSIGNEE; ATTACHMENT; NONSUIT.

## CREDITOR'S BILL.

See ASSIGNMENT.

## CRITICISED CASES.

See EXAMINED CASES.

## DAMAGES.

1. It is the making and selling to be used, and not the selling, or buying, or making alone, for which full damages are usually given. *Hogg v. Emerson*, 634.
2. The price paid for a license to use a thing patented, may be submitted to the jury as a guide in estimating damages for an infringement, and seems once to have been treated by law as the chief guide in all patent cases; but if the maker of the machine was ignorant of the existence of the patent-right, that sum may be mitigated. *Ibid.*
3. It must be a very extreme case where a judgment will be reversed on account of excessive damages, when the instructions of the court suggested to the jury the true general rule, and when, if the damages were excessive, a new trial could have been moved in the Circuit Court. *Ibid.*
4. The Patent Act of 1790, section 4, made an infringer liable to pay such damages as the jury should find, and also forfeit the machine. The act of 1793, section 5, declared that an infringer should pay a sum equal to three times the price for which the patentee had sold licenses. The act of 1800, section 3, provided that an infringer should pay three times the actual damages sustained. *Seymour v. McCormick*, 944.

**DAMAGES—continued.**

5. The Patent Act of 1836, section 14, confines the jury to the actual damages sustained by the patentee. The power to increase them is committed to the discretion of the court. *Ibid.*
6. There cannot be one rule of damages which will apply equally to all cases. The mode of ascertaining actual damages must necessarily depend upon the nature of the monopoly granted. *Ibid.*
7. If a patentee considers it for his interest to retain the entire invention, and competition would destroy its value, the profits of the infringer may be the only criterion of the actual damage. *Ibid.*
8. Where an inventor has found it profitable to exercise his monopoly by selling licenses, he has himself fixed the average of his actual damage, and the price of such licenses may afford a proper measure of damages. *Ibid.*
9. It is only where no other rule can be found, that the defendant's profits become the criterion of the plaintiff's loss. *Ibid.*
10. Actual damages must be proved; what a patentee *would have made* if an infringer had not interfered with his rights, is a question of fact. It is not a legal inference that third persons would have bought of the patentee what they bought of an infringer, if the latter had not made and sold the thing patented. *Ibid.*
11. Nor is it proper to instruct the jury that the same rule is to govern, as to the measure of damages, whether the patent covers an entire machine or an improvement on a machine. *Ibid.*
12. The rule of damages is the amount of profits received by the unlawful use of the thing patented,—not what he might have made by reasonable diligence. *Dean v. Mason*, 1048.
13. But where the wrong has been done under aggravated circumstances, the court has the power to punish it adequately by an increase of the damages. *Ibid.*
14. The plaintiffs must furnish evidence by which the jury may estimate actual damages. Actual damages must be *calculated*. *Mayor, &c., of New York v. Ransom*, 1140.
15. If the plaintiff rests his case after merely proving an infringement, he is only entitled to nominal damages. *Ibid.*

See ACCOUNT OF PROFITS; COUNSEL FEES; INTENT.

**DECLARATIONS.**

See EVIDENCE.

**DEDICATION TO THE PUBLIC.**

See ABANDONMENT.

**DEFENSES.**

1. Section 6 of the act of 1793 does not enumerate all the defenses which a party may make in a suit brought against him for violating a patent. *Pennock v. Dialogue*, 127.
2. It is not inconsistent with section 6 of the act of 1793, that a defense may be made, that although the patentee is the first as well as the true inventor, he has abandoned or dedicated his invention to the public. *Ibid.*
3. The distinction is now well settled between defenses which authorize a judgment in favor of the defendant, leaving the plaintiff free to bring other suits for infringement, and those which would require the court to enter a judgment not only for the defendant in the particular case, but one which declares the patent to be void. *Grant v. Raymond*, 146.

DEFENSES—*continued*.

4. A party may either plead specially or plead the general issue, and give the notice required by section 6 of the act of 1793 of any special matter he intends to use at the trial. If he shows that the patentee has failed in any of these prerequisites on which the authority to issue the patent is made to depend, his defense is complete, and he is entitled to the verdict of the jury. *Ibid.*
  5. But if, not content with defending himself, he seeks to annul the patent, he must proceed in precise conformity to section 6 of the act of 1793. *Ibid.*
  6. The defendant is permitted to proceed according to section 6 of the act of 1793, but is not prohibited from proceeding in the usual manner, except that special matter may not be given in evidence on the general issue, unaccompanied by the notice which section 6 requires. *Ibid.*
  7. It is a good defense, that the specification does not contain a description of the invention in such full, clear, and exact terms as to distinguish it from all things before known, and so as to enable any person skilled in the art to make and use the same. *Ibid.*
  8. The case of *Pennock v. Dialogue* affirms that failure on the part of a patentee in the prerequisites of the act authorizing a patent, is a bar to a recovery; and this defense does not depend on the intention of the inventor, but is a legal inference upon his conduct. *Ibid.*
  9. The use of the thing patented during the interval between the original and reissued patent, will not defeat an action under the reissued patent. *Stimpson v. West Chester R. R.*, 330.
  10. If a patent has been granted to the defendant, he may put such patent in evidence in justification or defense. *Corning v. Burden*, 867.
  11. Proof of use of the thing patented during the interval between the original and reissued patents, will not defeat the action. *Battin v. Taggart*, 969.
- See ACTIONS; GENERAL ISSUE; INFRINGEMENT; PARTNERSHIP; PLEADING.

## DEPOSITION.

See EVIDENCE.

## DISCLAIMER.

1. Where, in a disclaimer, the party stated that he was the patentee, and said nothing in respect to a transfer of any part of it, the fair presumption is that he still retains the whole; and it is a sufficient compliance with the statute to say that such disclaimer is to operate to the extent of his interest therein. *Silsby v. Foote*, 717.
2. The law requiring a patentee to disclaim is remedial. It is intended for the protection of the patentee as well as the public, and should not receive a construction that would restrict its operation. *O'Reilly v. Morse*, 763.
3. Where a patent is illegal in part because of claiming more than the inventor has described, or more than he has invented, the patentee must disclaim in order to save the portion to which he is entitled. *Ibid.*
4. When a claim has been sanctioned by the Patent Office, and has been held valid by a Circuit Court, the patentee has a right not to disclaim it until it has been passed upon by the highest court; and the omission to disclaim will not render the patent void. The delay in entering the disclaimer, under such circumstances, is not unreasonable. *Ibid.*
5. Under the circumstances of this case, the patentee was not guilty of unreasonable delay in making the disclaimer; such delay was a question of law for the court. *Scymour v. McCormick*, 1004.
6. The granting of a patent, and an opinion of a court below maintaining the

**DISCLAIMER**—*continued.*

validity of such patent, will repel any inference of an unreasonable delay in correcting the claim, by entering a disclaimer, until the highest court to which it could be carried had pronounced its judgment. *Ibid.*

7. The question of unreasonable delay in filing a disclaimer, held to be one of law. *Ibid.*
8. Under section 9 of the act of 1837, where a patentee claims more than he has invented, his patent will still be good for what he has invented, provided he enters a disclaimer without unreasonable neglect or delay. *Silsby v. Foote*, 1071.
9. In this case there had not been such unreasonable delay in entering a disclaimer as to bar a recovery; but the plaintiff was not allowed to recover costs. *Ibid.*

See COSTS; REISSUE.

**DISCOVERY.**

1. A new process is usually the result of discovery; a machine, of invention. *Corning v. Burden*, 867.
2. One may discover an improvement in a process, irrespective of any particular form of machinery; and another may invent a machine by which the process may be performed; and each may be entitled to a patent. *Ibid.*

**DOUBLE USE.**

See NEW APPLICATION.

**DRAWINGS.**

1. Models and drawings may be resorted to for clearer information respecting the invention. *Hogg v. Emerson*, 438.
2. The drawings, as well as the specification, may be looked to for explanation of anything obscure in the patent. And the drawings may be restored when burnt. *Ibid.*
3. The drawings required by section 6 of the act of 1837, are not required by law to accompany the application when first made. *O'Reilly v. Morse*, 763.
4. If necessary, experts may be examined to explain drawings. *Winans v. New York and Erie R. R. Co.*, 1096.

**EFFECT.**

1. An end to be accomplished is not the subject of a patent. *Carver v. Hyde*, 316.
2. A patent is not good for an effect, as that would prohibit all other persons from making the same thing by any means whatsoever, and thus discourage arts and manufactures. *Le Roy v. Tatham*, 637.
3. Whoever discovers that a certain useful result will be produced by the use of certain means, is entitled to a patent for it, if he specifies the means used so fully that a skillful person can, by using the means specified, produce the result described. *O'Reilly v. Morse*, 763.
4. A patent cannot be for an effect produced, distinct from the machinery necessary to produce it. *Ibid.*
5. It is for the discovery of some method of producing a result that a patent is granted, and not for the result itself. *Corning v. Burden*, 867.

See MODE; PRINCIPLE.



## EQUITY.

1. An assignor may be joined as a party complainant with an assignee of the exclusive interest in a certain territory, in a bill for an injunction. *Woodworth v. Wilson*, 428.
  2. A motion to dismiss the bill, on the ground that the defendants had parted with their interest, will be denied, if the assignment has been made after the time when a computation of profits ended. *Dean v. Mason*, 1048.
- See AMOUNT IN CONTROVERSY; APPEAL; COURTS; FEIGNED ISSUE.

## EQUIVALENTS.

The patentee has the right to treat as infringers all who make a like invention, even though the infringing machine may be an improvement on the patented one. *McCormick v. Talcott*, 1085.

See COMBINATION; FORM; INVENTION; NEW APPLICATION.

## ESTOPPEL.

See ACCOUNT OF PROFITS.

## EVIDENCE.

1. It is competent for the plaintiff to introduce testimony to show that the persons of whose prior use defendant had given evidence, had paid the patentee for licenses to use his machine. *Evans v. Eaton*, 8.
2. One having an interest in the question, and not in the event of a patent suit, is a competent witness. *Evans v. Eaton*, 48.
3. In general, the liability of a witness to a like action, or his standing in the same predicament with the party sued, if the verdict cannot be given in evidence for or against him, is an interest in the question, and will not exclude him. *Ibid.*
4. No practice can give validity to depositions which are not taken according to law, unless the parties waive the objection, or agree to have them made evidence. *Ibid.*
5. A deposition which has been introduced in a cause with the consent of the opposite party, cannot be afterwards objected to. *Evans v. Hettich*, 104.
6. It is no objection to the competency of a witness, that he is sued in another action for the infringement of the same patent. *Ibid.*
7. Plaintiff's counsel cannot inquire of witnesses as to acts between plaintiff and third persons as to his patent. *Ibid.*
8. Fraudulent intent must be found by the jury, to justify a judgment of *vacatur* by the court. *Grant v. Raymond*, 146.
9. The question of abandonment does not turn upon the intention of the inventor. *Shaw v. Cooper*, 173.
10. The *onus probandi* is on the defendant to show that proper notice has been given under the statute to enable him to show that the invention of the plaintiff had been known or used before his invention. *Philadelphia and Trenton R. R. v. Stimpson*, 292.
11. It is a presumption of law that all public officers perform their proper official duties until the contrary is proved. Where an act is to be done, as a patent to be granted or reissued upon evidence and proofs to be laid before a public officer, upon which he is to decide, the fact that he has done the act, or granted the patent, is *prima-facie* evidence that the proofs have been regularly made, and were satisfactory. *Ibid.*
12. The declarations of a patentee, affirming that at some former period he invented a particular machine, are not admissible; but his declarations stating that he had made an invention, describing its details and explaining

**EVIDENCE—continued.**

- its operations, are evidence of an assertion of his right at the time, to the extent of the facts made known by him. *Ibid.*
13. Such declarations are to be deemed a part of the *res gestæ* and evidence that the invention was then claimed by him. *Ibid.*
  14. Parol evidence bearing upon written contracts ought not to be admitted, without the production of such contracts. *Ibid.*
  15. It is incumbent upon those insisting upon the right to put particular questions to a witness, to establish that right beyond any reasonable doubt, for the very purpose stated by them; and they are not afterward at liberty to desert that purpose, and to show the pertinency or relevancy of the evidence for any other purpose not then suggested to the court. *Ibid.*
  16. A party cannot cross-examine a witness except as to facts and circumstances connected with the matters stated in his direct examination. If he wishes to examine him as to other matters, he must do so by making the witness his own. *Ibid.*
  17. The declaration of a patentee who had parted with his interest, that he had never completed his invention, is only hearsay evidence. *Wilson v. Simpson*, 515.
  18. A defendant using a machine patented to him, will have the benefit of a like presumption in his favor, as to the originality of his invention, as the plaintiff has. *Corning v. Burden*, 867.
  19. Under the act of 1793, a patent was not even *prima-facie* evidence that the invention patented was new or useful; but under the act of 1836, a patent is received as *prima-facie* evidence of the facts asserted in it. *Ibid.*
  20. The jury are to determine from the facts as to the novelty of the invention. *Battin v. Taggart*, 969.
- See AGREEMENT; BILLS OF EXCEPTIONS; CHARGE OF JUDGE; DAMAGES; DEFENSES; EXPERTS; GENERAL ISSUE; INFRINGEMENT; MODELS.

**EXAMINED CASES.**

1. *Allen v. Blount*, 3 Story, 742, approved, as to the conclusiveness of the Commissioner's decision. *Brooks v. Fiske*, 846.
2. *Battin v. Taggart*, 2 Wall. Jr., 101, reversed: that a description of a part of a machine in a specification, without making any claim for it, is a dedication of such part, and that it cannot afterward be restored by a reissue. *Battin v. Taggart*, 969.
3. *Bean v. Smallwood*, 2 Story, 408, approved: that an application of a machine to a new purpose is not sufficient. *Le Roy v. Tatham*, 657.
4. *Blanchard v. Eldridge*, 1 Wall. Jr., 337, approved. That in case of a license, the patentee can alone maintain an action for infringement of the right of the licensee. *Gayler v. Wilder*, 576.
5. *Brown v. Duchesne*, 2' Curt., 371, affirmed: that the right of property vested in a patentee does not extend to the use of the thing patented upon a foreign vessel, if such thing was put upon her in a foreign country, and authorized by the laws of such country. *Brown v. Duchesne*, 1015.
6. *Carver v. Hyde*, 316, approved: that the use of part of a combination is no infringement. *Stimpson v. Baltimore and Susquehanna R. R. Co.*, 535.
7. *Davis v. Palmer*, 2 Brock., 298, referred to, as a case in which the patent is limited to a particular form described and claimed. *Winans v. Denmead*, 887.
8. *Evans v. Eaton*, Pet. C. C., 323, reversed: that Evans' patent was only for the general result produced by the combination of all his machinery, and not for the several machines as well as the general result. And af-

EXAMINED CASES.—*continued.*

- firmed: that under the act of 1790, under a notice served with the general issue, that an invention had been used, evidence could be given of a use in other places than those named in such notice. *Evans v. Eaton*, 8.
9. *Evans v. Eaton*, 8, approved: that a special act is to be regarded as ingrafted on the general acts. *Bloomer v. McQuewan*, 730.
  10. *Evans v. Eaton*, 48, approved: that a patentee must state distinctly what he claims as his invention. *Brooks v. Fiske*, 846.
  11. *Evans v. Hettich*, 3 Wash., 498, affirmed. *Evans v. Hettich*, 104.
  12. *Ewer v. Coxe*, 4 Wash., 487, approved: that the publication of the record of copyright and the deposit of a book with the Secretary of State are not prerequisites to obtaining a copyright. *Wheaton v. Peters*, 200.
  13. *Foote v. Silsby*, 1 Blatchf., 445, affirmed, as to what is a sufficient statement of the interest of the person making the disclaimer; that a reference to a book mentioned in the notice required with the plea of the general issue, must be to a page or section,—a general reference not enough; and that in a patent for a combination, a claim for such machinery as produces a given result is sufficiently definite. *Silsby v. Foote*, 717.
  14. *Foote v. Silsby*, 2 Blatchf., 275, affirmed, as to what is granted by Foote's patent, but reversed as to the allowance of interest and costs; the ruling below sustained, that a judge may disregard the finding of a jury upon a feigned issue, and give a decree in opposition thereto. *Silsby v. Foote*, 1071.
  15. *Goodyear v. Matthews*, 1 Paine, 302, examined, as to what use of an invention will deprive a party of a right to a patent. *Shaw v. Cooper*, 173.
  16. *Grant v. Raymond*, 146, approved, as to the right to obtain a reissue. *Battin v. Taggart*, 969; *Shaw v. Cooper*, 173.
  17. *Hartshorn v. Day*, 1031, approved. *Day v. Union Rubber Co.*, 1062.
  18. *Herbert v. Adams*, 4 Mass., 5, approved: that an action for an infringement must be brought in the name of the assignee. *Gayler v. Wilder*, 576.
  19. *Hogg v. Emerson*, 438, explained and affirmed. *Hogg v. Emerson*, 634.
  20. *Hotchkiss v. Greenwood*, 4 McLean, 456, affirmed: that the alleged invention was but a new application. *Hotchkiss v. Greenwood*, 610.
  21. *Howe v. Abbott*, 2 Story, 194, explained: that a new application or purpose is not patentable. *Hotchkiss v. Greenwood*, 610.
  22. *Le Roy v. Tatham*, 657, considered, as holding that the patentee was not entitled to a patent for the newly-discovered principle. *O'Reilly v. Morse*, 763, examined and commented on. *Le Roy v. Tatham*, 1116.
  23. *Livingston v. Woodworth*, 922, approved: that a party is accountable only for profits *actually made*, and not what he might have made. *Dean v. Mason*, 1048.
  24. *McChurg v. Kingsland*, 322, examined, as to provision respecting assignees under section 18 of the act of 1836. *Wilson v. Rousseau*, 357, considered to be a patent for the application of a known law of nature to a new purpose. *O'Reilly v. Morse*, 763. (Dissenting opinion.)
  25. *McCormick v. Seymour*, 2 Blatchf., 240, reversed, as to rule of damages. *Seymour v. McCormick*, 944.
  26. *McCormick v. Seymour*, 3 Blatchf., 209, affirmed, except as to construction of one of the claims, and the right of the plaintiff to recover costs. *Seymour v. McCormick*, 1004.
  27. *Morris v. Huntington*, 1 Paine, 348, examined, as to the use of an invention which will invalidate a patent. *Shaw v. Cooper*, 173.
  28. *O'Reilly v. Morse*, 763, approved, as to delay in filing a disclaimer at the Patent Office. *Seymour v. McCormick*, 1004.

**EXAMINED CASES—continued.**

29. *Parkhurst v. Kinsman*, 1 Blatchf., 488, affirmed. *Kinsman v. Parkhurst*, 997.
30. *Pennock v. Dialogue*, 4 Wash., 538, affirmed: that an inventor who permits his invention to go into public use before application, cannot receive a valid patent. *Pennock v. Dialogue*, 127.
31. *Pennock v. Dialogue*, 127, approved: that under the act of 1793 an inventor abandons his inchoate right if he makes his discovery public before application for a patent. *Grant v. Raymond*, 146; *Shaw v. Cooper*, 173, approved: that the use of an invention before application for a patent, without objection, is an abandonment. *McClurg v. Kingsland*, 322, referred to as a leading case upon the invalidation of a patent resulting from abandonment. *Kendall v. Winsor*, 1108.
32. *Prouty v. Ruggles*, 1 Story, 568, affirmed: that it is no infringement to use a part only of a combination. *Prouty v. Ruggles*, 311.
33. *Prouty v. Ruggles*, 311, affirmed: that a combination is not infringed by the use of a part thereof. *Stimpson v. Baltimore and Susquehanna R. R. Co.*, 535.
34. *Shaw v. Cooper*, 173, referred to as a leading case upon the question of abandonment. *Kendall v. Winsor*, 1108.
35. *Silsby v. Foote*, 717, explained, as to the extent of the decision below. *Silsby v. Foote*, 1071.
36. *Stimpson v. West Chester R. R. Co.*, 330, approved: that use under a defective patent does not prevent the taking out of an amended one. *Battin v. Taggart*, 969.
37. *Troy Iron and Nail Factory v. Corning*, 1 Blatchf., 467, reversed. *Troy Iron and Nail Factory v. Corning*, 691.
38. *Whittemore v. Cutter*, 1 Gall., 429, 478, examined, as to the question of the use of an invention which will defeat a patent. *Shaw v. Cooper*, 173.
39. *Wilson v. Barnum*, 1 Wall. Jr., 342, remanded, because a question of fact was certified. *Wilson v. Barnum*, 510.
40. *Wilson v. Rousseau*, 357, approved, as to the rights of assignees under a renewed patent. *Bloomer v. McQuewan*, 730, approved, as to repairing a patented machine. *Wilson v. Simpson*, 515.
41. *Wilson v. Sandford*, 532, approved: that the State laws regulate contracts in regard to patented machines. *Bloomer v. McQuewan*, 730, approved: that a patent signed by an "Acting" Commissioner is not invalid. *York and Maryland R. R. Co. v. Winans*, 956.
42. *Wilson v. Turner*, 7 Law Rep., 527, affirmed. *Wilson v. Turner*, 427.
43. *Winans v. Boston and Providence R. R. Co.*, 2 Story, 412, explained. *Hotchkiss v. Greenwood*, 610.
44. *Woodworth v. Stone*, 3 Story, 749, approved: that the action of the Commissioner in reissuing a patent is conclusive, unless fraud is shown. *Brooks v. Fiske*, 846.
45. *Wyeth v. Stone*, 1 Story, 273, examined and explained, as to the position that a patent may cover a combination, and also a right to distinct improvement. *Hogg v. Emerson*, 438. *Hogg v. Emerson*, 634.

SEE TABLE OF CASES WHICH HAVE BEEN CITED, AFFIRMED, APPROVED, EXPLAINED, DOUBTED, DISAPPROVED, OVERRULED, OR REVERSED. Vol. 2, page 679.

**EXECUTION.**

See ASSIGNMENT.

## EXPERTS.

1. It is competent to show by experts that there are differences between an original and a reissued patent. *Philadelphia and Trenton R. R. v. Stimpson*, 292.
2. Experts may be examined as to the meaning of terms of art, but not as to the construction of written instruments. *Corning v. Burden*, 867.
3. Experts are men as often skilled in producing obscurity, as in the elucidation of truth. *McCormick v. Talcott*, 1085.
4. Experts may be examined to explain terms of art, and the state of the art, and may explain the machines, models, and drawings exhibited. The maxim, "*cuique in sua arte credendum*," permits them to be examined as to questions of art peculiar to their trade. *Winans v. New York and Erie R. Co.*, 1096.
5. Experts cannot be received to prove what is the proper or legal construction of any instrument of writing. A judge may, however, obtain information from them on matters which he does not clearly comprehend. *Ibid.*

See DRAWINGS; MODELS.

## EXTENSION.

1. The extension of a patent under section 18 of the act of 1836, does not inure to the benefit of grantees under the original patent, so as to vest in them any exclusive right. The benefit of such renewal is limited to those who were using the patented article at the time of the renewal, and saves to them the right to use the machines held at the time of such renewal "to the extent of their interests." *Wilson v. Rousseau*, 357.
2. A covenant as to a renewal of a patent, must be construed by the law as it stood at the time of such covenant. *Ibid.*
3. Where, in an assignment made before there was any provision authorizing a renewal, there was a covenant that any "renewal" should inure to the benefit of the assignees: *Held*, That such "renewal" could be satisfied by a reference to the law as it then stood, and that in renewal by virtue of subsequent acts of Congress, no right was acquired by virtue of the assignment. *Ibid.*
4. Under *Wilson v. Rousseau*, 4 How., 688, one in the lawful use of a patented machine, under a purchase made during the original term, may continue to use such a machine during an extension, under the provisions of section 18 of the act of 1836, and is also entitled to continue to use such machine during an after extension made by special act of Congress. *Bloomer v. McQuewan*, 730.
5. The jury are to determine from the facts in the case whether a renewed patent is for the same invention as the original patent. *Battin v. Taggart*, 969.
6. Where a patent has been extended, and the patentee then conveyed all his interest therein to another person, who brought suit against certain parties for an infringement of the patent, and such parties claimed under a license from the patentee under the original patent: *Held*, That it was necessary for the defendants to show a connected chain of title to themselves, in order to justify, under the clause of section 18 of the act of 1836, as to assignees, their use of the improvements secured by the patent. *Chaffee v. Boston Belting Co.*, 1124.

See ADMINISTRATOR; ASSIGNMENT; COMMISSIONER OF PATENTS; CONGRESS; REISSUE; STATUTE, CONSTRUCTION OF.

## FEIGNED ISSUE.

A court of equity may disregard the finding of a jury upon the trial of feigned issues. *Silsby v. Foote*, 1071.

**FORM.**

1. Under our law, a patent cannot be granted for merely a change of form. *Winans v. Denmead*, 887.
2. Where a particular geometrical form is alone capable of embodying a patentee's invention, if the form is not used there is no infringement. *Ibid.*
3. Patentees sometimes add to their claims a declaration that the claim extends to the thing patented, however its form may be varied. The law so interprets the claim, without the addition of these words. *Ibid.*
4. There may be cases where the letters patent include only the particular form claimed, because such form only is capable of embodying the invention; and, consequently, if the form is not copied, the invention is not used. *Ibid.*
5. When the whole substance of the invention may be copied in a different form, it is the duty of courts and juries to look through the form for that which the patent was designed to secure; and when that is found, there is an infringement. *Ibid.*
6. The mere change in the form of machinery, or the use of known equivalent powers, will not make the machine a new invention. *O'Reilly v. Morse*, 763.

See EQUIVALENT; NEW APPLICATION; INFRINGEMENT.

**FOREIGN PATENT.**

See APPLICATION; PATENT.

**FRAUD.**

1. Under the act of 1793, evidence of fraudulent intent is required only for the purpose stated in section 6; that is, to annul the patent. *Grant v. Raymond*, 146.
2. The procuring a patent for a machine, as a reissue, which was not useful as patented in the surrendered patent, for want of parts used in the reissued patent, would present a question of fraud committed on the public by the patentee. *Brooks v. Fiske*, 846.

See EVIDENCE.

**GENERAL ISSUE.**

1. The section of the Patent Act relative to notices of special matter with the general issue, is for the security of the plaintiff. *Evans v. Eaton*, 8.
2. The defendant may set up special matter by special pleas, and then the plea is the only notice the plaintiff can claim. *Ibid.*
3. Evidence of the defendant as to whether the machine used by him is like the model of the plaintiff, is proper under the general issue. *Evans v. Hettich*, 104.
4. No notice is necessary to authorize the inquiry by defendant of a witness, whether the machine used by defendant was like the model of plaintiff's machine. *Ibid.*
5. A general reference, in a notice of special matter, to a volume, as "Ure's Dictionary of Arts, Manufactures, and Mines," is not sufficient; there must be a reference to the part relied on. *Silsby v. Foote*, 717.
6. Where a defendant relies on the fact of previous invention, knowledge, or use of the thing patented, he must give notice of the persons by whom he intends to prove such fact. *Philadelphia and Trenton R. R. v. Stimpson*, 292.
7. A defendant will not be allowed to surprise a patentee by evidence of a prior invention, of which no notice has been given. *O'Reilly v. Morse*, 763.

GENERAL ISSUE—*continued*.

8. The defenses mentioned and allowed by section 15 of the act of 1836, to be given in evidence with the general issue, by way of notice, may also be set up by special pleas. *Smith v. Ely*, 838.
9. Under section 15 of the act of 1836, a defendant may, with notice as required by that act, give any special matter in evidence tending to prove that the patentee was not the original and first inventor or discoverer of the thing patented, or a substantial or material part thereof claimed as new, or that it had been described in some public work anterior to the supposed discovery by the patentee, or had been in public use or on sale, with the consent and allowance of the patentee, before his application. *Teese v. Huntington*, 1130.
10. But whenever the defendant relies on the fact of a previous invention, or knowledge, or use, he must state in his notice the names and places of residence of those who had such prior knowledge of the thing, and where the same had been used. *Ibid*.
11. No order of court is necessary to enable a defendant to serve and file the notice of special matter required in section 15 of the act of 1836. *Ibid*.
12. And if a first notice is defective, the defendant may give other notices, to remedy such defect or supply the deficiency. *Ibid*.
13. Depositions taken before the notice was served, as well as those taken afterward, are admissible. *Ibid*.

See DEFENSES.

## IMPROVEMENTS.

1. The distinction between a machine and an improvement on a machine is too clear for them to be confounded together. *Evans v. Eaton*, 8.
2. If the party's invention consists in adding some new machinery, or some improved mode of operating, to the old machine, the patent should be limited to such improvement. *Evans v. Eaton*, 48.
3. A specification which mixes up the old and the new, but does not explain what is the nature of the improvement which the party claims, cannot be sustained. *Ibid*.
4. A party should describe what his improvement is, and limit his patent to such improvement; and if he does not, his patent is defective. *Ibid*.
5. A patent for an improvement embraces nothing more than the improvement claimed as new; and one who afterward discovers a method of accomplishing the same object, substantially differing from the one described, has a right to use it. *O'Reilly v. Morse*, 763.
6. Under section 13 of the act of 1836, a patentee may annex an improvement upon a former invention already patented to his specification, so as to make it from that time a part of the original patent. But there is nothing which prevents him from taking out a new patent for the improvement, if he prefers it. *Ibid*.
7. The inventor of a first improvement cannot invoke the doctrine of mechanical equivalents to suppress all other improvements which are not mere colorable evasions of the first. *McCormick v. Talcott*, 1085.
8. The specification should distinguish the new from the old, and claim only the new. *Phillips v. Page*, 1143.

See COMBINATION; EQUIVALENT; FORM; INFRINGEMENT; SPECIFICATION.

## INFRINGEMENT.

1. A contract to purchase articles manufactured in violation of a patent, is not of itself an infringement of such patent. *Keplinger v. De Young*, 122.

INFRINGEMENT—*continued.*

2. No prior use of a patent can authorize the use of the invention, after the issue of an amended patent, under section 3 of the act of 1832, or section 13 of the act of 1836. *Stimpson v. West Chester R. R. Co.*, 330.
3. Any person using an invention protected by a renewed patent subsequent to the date of the act of 1836, (July 4,) is guilty of an infringement, however long he may have used the same after the date of the defective and surrendered patent. *Ibid.*
4. Whether the defendant has constructed, used, or sold the thing patented to the plaintiffs, is a question of fact for the jury. *Winans v. Denmead*, 887.
5. It is a familiar rule, that to copy the principle or mode of operation described in a patent is an infringement, although such copy should be totally unlike the original in form or proportions. *Ibid.*
6. To constitute an infringement, the thing used must be such as to embody the patentee's mode of operation, and thereby attain the same result as was reached by his invention. It is not necessary that the defendant should embody the plaintiff's invention to as good advantage as he employed it, or that the result should be the same in degree; but it must be the same in kind. *Ibid.*
7. Where a patent was granted for constructing the body of a railroad-car in the form of the frustum of a cone, and the claim was for making it in such form, whereby certain specified advantages were secured, and a new and useful result produced, and the defendants constructed the body of their car *octagonal*, the effect of which was, however, the same as when made circular, as described in plaintiff's patent: *Held*, That it was an infringement upon plaintiff's patent. *Ibid.*
8. The right of property which a patentee has in his invention, is derived from the acts of Congress, and cannot extend beyond the limits to which the law itself is confined. The use of his invention outside of the jurisdiction of the United States is not an infringement of his rights. *Brown v. Duchesne*, 1015.
9. The exclusive use granted to a patentee does not extend to a foreign vessel lawfully entering our ports. *Ibid.*
10. If the patentee be an original inventor of a machine, he has the right to treat as infringers all who make a like invention, performing the same functions by analogous means or equivalent combinations, even though the infringing machine may be an improvement on the patented one. *McCormick v. Talcott*, 1085.
11. In the absence of any suggestion to the contrary, it will be inferred that the use of machinery constructed according to the specification of a patent is without the license or consent of the patentee. *Chaffee v. Boston Belting Co.*, 1124.

See ACTION; COMBINATION; CORPORATION; EQUIVALENT; FORM;  
IMPROVEMENT.

## INJUNCTIONS.

See ACCOUNT OF PROFITS.

## INTENT.

The intent not to injure, in the infringement of a patent, never exonerates from all damages for the actual injury or encroachment, though it may mitigate them. *Hogg v. Emerson*, 634.

See FRAUD.



## INVENTION.

1. If the thing patented had been in use, or described in a public work, anterior to the supposed discovery of the patentee, his patent is void. Although he had no knowledge of such previous use or previous description, the law supposes he may have known it. *Evans v. Eaton*, 8.
  2. The jury are to determine whether two machines are identical, or act upon different principles. *Battin v. Taggart*, 969.
  3. The enlargement of the organization of a machine does not afford any ground for a patent. *Phillips v. Page*, 1143.
- See ART; COMBINATION; EQUIVALENT; FORM; MANUFACTURE; MODE.

## INVENTOR.

1. It was the intention of the legislature to invest an exclusive right in the inventor only, on condition that his invention was not known or used by the public. *Shaw v. Cooper*, 173.
2. Under section 15 of the act of 1836, an original inventor is entitled to receive a patent for his invention, even though such invention has been known in a foreign country, provided he believed himself to be the first inventor, and such foreign invention had not been patented or described in any printed publication. *O'Reilly v. Morse*, 763.

## JURISDICTION.

See ACTION; AMOUNT IN CONTROVERSY; COURTS; INFRINGEMENT.

## JURY.

1. The question whether the acts or acquiescence of the party furnish satisfactory proof of an abandonment of the invention to the public, is one of fact rather than law. *Pennock v. Dialogue*, 127.
2. The knowledge of an inventor, or his acquiescence in the public use of his invention, is a fact for the jury. *Shaw v. Cooper*, 173.
3. Whether a reissued patent is substantially for a different invention from the first patent, is a question of fact for a jury. *Stimpson v. West Chester R. R.*, 330.
4. The jury are to determine as to the novelty of the invention; and whether a renewed patent is for the same invention as the original patent; and whether an invention has been abandoned to the public; and whether two machines are identical, or are constructed and act on different principles. *Battin v. Taggart*, 969.
5. Whether an inventor has abandoned his invention, and whether this is sought to be proved from his acts, or from a forbearance to act, is an inquiry for the jury to decide. *Kendall v. Winsor*, 1108.

See ABANDONMENT; EVIDENCE; EXTENSION; INVENTION; INFRINGEMENT; PATENT.

## LICENSE.

1. If an inventor allow another to use his invention before applying for a patent therefor, and a patent is afterward obtained, such permission and allowance will justify the jury in presuming a license from the patentee. *McClurg v. Kingsland*, 322.
2. Under section 7 of the act of 1839, the person who has had the use of an invention prior to the application for a patent therefor, is on the same footing as if he had a special license from the inventor. *Ibid.*
3. But the use of an invention before an application for a patent must be of the

**LICENSE—continued.**

specific improvement then invented and used by the person who had purchased and used the machine to which the invention is applied. *Ibid.*

4. An agreement conveying to the grantee the exclusive right to make and vend the thing patented within a certain territory, but reserving to the grantor the right to make and sell within the same territory, is not an assignment, but only a license. *Gayler v. Wilder*, 576.
5. The difference is well understood between licenses which may be assigned or used by others, and those which the licensees could only personally use. *Troy Iron and Nail Factory v. Corning*, 691.
6. A mere license to a party, without words showing that it was meant to be assignable, is only a grant of a personal power to the licensee, and is not transferable by him to another. *Ibid.*

See **ASSIGNMENT**; **PATENTED ARTICLES**; **STATUTES, CONSTRUCTION OF**.

**LOST ARTS.**

See **ARTS, LOST**.

**MACHINE.**

1. There is no substantial difference between a patent for an improvement on a machine, and a patent for an improved machine. *Evans v. Eaton*, 8.
2. The term machine includes any combination of mechanical powers to perform some function and produce a certain effect or result. *Corning v. Burden*, 867.
3. Principle is often applied to a machine to describe its movements and effects. *Le Roy v. Tatham*, 1116.

See **ACTION**; **ASSIGNMENT**; **EFFECT**; **PATENTED ARTICLES**.

**MANUFACTURE.**

1. A new manufacture, as the use of a new composition to form knobs for doors, &c., and which results in a new and useful article, is the proper subject of a patent, though the means employed to adapt the new composition to a useful purpose are old or well known. *Hotchkiss v. Greenwood*, 610.
2. But if porcelain knobs were not new, and the same kind of shanks and splindles had been used with other knobs, the use or substitution of porcelain instead of other material, in a combination with such shanks, &c., will not entitle the manufacturer to a patent, even though such material may be better adapted for the purpose. *Ibid.*
3. A new property in matter, when practically applied in the construction of a useful article, is patentable; but the process through which the new property is applied must be stated with such precision as to enable a mechanic to apply the necessary process. *Le Roy v. Tatham*, 657.

See **COMPOSITION OF MATTER**.

**MANUSCRIPTS.**

1. The rights of an assignee of a manuscript will be protected by a court of chancery. *Wheaton v. Peters*, 200.
2. This is presumed to be the "copyright" recognized in section 1 of the act of 1790. *Ibid.*
3. Congress, by the act of 1790, instead of sanctioning an existing right, created it. *Ibid.*
4. At common law, an author has a right to his unpublished manuscripts; and the act of February 3, 1831, gives him a remedy by injunction to protect his right. *Little v. Hall*, 989.

See **ACTION**; **COPYRIGHT**.

**MATERIAL.**

The substitution of one material for another, as clay for wood or metal in the construction of door-knobs, is not patentable. *Hotchkiss v. Greenwood*, 610.

See COMPOSITION OF MATTER; MANUFACTURE.

**MISTAKES IN PATENTS.**

If a mistake should be committed in the Department of State, it may be corrected, and a new patent be issued, correcting the error, even though such act is not expressly authorized by law. The emanation of the new patent is not founded on the words of the law, but is necessary to the faithful execution of the solemn promise made by the United States to the inventor. The same step may be taken, if a mistake has been innocently committed by the inventor. *Grant v. Raymond*, 146.

See DISCLAIMER; REISSUE.

**MODE.**

1. An exclusive right cannot exist in a new power, should one be discovered, as steam, electricity, or any other power of nature. In all such cases, the processes used to extract, modify, and concentrate natural agencies, constitute the invention. The elements of the power exist; the invention is not in discovering them, but in applying them to useful objects. The right of the inventor is secured against all who use the same mechanical power, or one substantially the same. *Le Roy v. Tatham*, 657.
2. An art may require one or more processes of machines in order to produce a certain result or manufacture. *Corning v. Burden*, 867.
3. Where the result is produced by chemical action, by the operation of some element or power of nature, or of one substance on another, such operations are called *processes*. *Ibid*.
4. The arts of tanning, dyeing, making water-proof cloth, vulcanizing India-rubber, smelting ores, &c., are carried on by processes, as distinguished from machines. *Ibid*.
5. One may discover an improvement in such a process, irrespective of any particular form of machinery; and another may invent a machine by which the operation or process may be performed, and each be entitled to a patent. *Ibid*.
6. It is when the term process is used to represent some method of producing a result, that it is patentable. *Ibid*.
7. The term process is often used, however, in a more vague sense, as when we say a board is undergoing the process of being planed, in which it cannot be the subject of a patent. *Ibid*.
8. In this use of the term it represents the effect produced by the machine on the material subjected to its action. *Ibid*.
9. A patentee cannot have a patent for "the motive-power of electro-magnetism, *however developed*, for marking characters at a distance." His patent must be confined to the process described and invented by him. *O'Reilly v. Morse*, 763.
10. A patent cannot be for an effect produced distinct from the machinery necessary to produce it. *Ibid*.

See ART; EFFECT; PRINCIPLE.

**MODELS.**

1. Models are a species of evidence best calculated to conduct to the truth—evidence unaffected by the prejudices of partisans, or by the opinions (the reveries, they may often be called) of experts. *McCormick v. Talcott*, 1085. (Dissenting opinion.)

MODELS—*continued*.

2. No witnesses can testify so clearly as do the subjects (though mute) concerning which a controversy about identity is pending. *Ibid.* (Dissenting opinion.)

See EXPERTS; GENERAL ISSUE.

## NEW APPLICATION.

1. The meaning of the rule laid down in *Howe v. Abbott*, 2 Story, 194, and in *Winans v. Boston and Providence Railroad*, 2 Story, 416, is that the application of an old machine, or old composition of matter, before patented, to a new object, does not entitle one to a patent connected with the new object. *Hotchkiss v. Greenwood*, 610, Diss. Opin.
2. But it is entirely different if one apply an old principle in physics to a new object. There is then a new form adapted, or a new combination for the purpose—a new shape, consistency, and use given, or a new *modus operandi*, which, if cheaper and better, deserves protection. *Ibid.*

See ART; DISCOVERY; EFFECT; MATERIAL.

## NEW TRIAL.

See DAMAGES.

## NONSUIT.

The United States courts have no power to order a peremptory nonsuit, against the will of the plaintiff. *Silsby v. Foote*, 717.

## OATH OF INVENTION.

The oath of the patentee is to be considered as extending to the specification, no less than the title of his invention. *Hogg v. Emerson*, 438.

See PATENT.

## PARTIES.

See ACTION.

## PARTNERSHIP.

One partner in the manufacture and sale of a patented article cannot acquire, as assignee, an outstanding right of a third person, as an inventor of the same thing, and set it up against his joint partner. *Kinsman v. Parkhurst*, 997.

## PATENT.

1. *Quære*: Whether improvements on different machines can be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as the right to the exclusive use of these machines in combination? *Evans v. Eaton*, 8.
2. Where the words are ambiguous, there may be circumstances which ought to have great influence in expounding them. The intention of the parties is entitled to great consideration. Therefore a special act may be referred to, as well as the patentee's petition. *Ibid.*
3. Every discoverer should realize the benefits resulting from his discovery; but these can only be secured by a compliance with every legal requisite. His exclusive right does not rest alone upon his discovery, but upon the legal sanctions which have been given to it. *Shaw v. Cooper*, 173.
4. As a patentee is required to make oath that he is the true inventor of the thing patented, the patent is regarded by the courts of the United States as *prima-facie* evidence that he made the invention. *Philadelphia and Trenton R. R. v. Stimpson*, 292.

PATENT—*continued.*

5. A patent must be construed according to the laws in force at the time of the granting of it. *McChurg v. Kingsland*, 322.
6. The sufficiency of the description in a specification is, in general, a question of fact for the jury. *Wood v. Underhill*, 432.
7. The sufficiency of a description in a specification is, in general, in patents for a composition of matter, as well as in patents for machines, a question of fact for the jury; but when the specification of a new composition of matter gives only the names of the substances to be mixed together, without stating any relative proportion, it is the duty of the court to declare the patent vacant. *Ibid.*
8. But when the patentee gives a certain proportion as a general rule, which on the face of the specification seems generally applicable, the patent will be valid, though some small difference in the proportions may be occasionally required, according to the quality of the materials made use of. *Ibid.*
9. The specification, under our laws and practice, is to be regarded as a component part of the letters patent. *Hogg v. Emerson*, 438.
10. Patents may be united, if two or more, included in one set of letters, relate to a like subject, or are in their nature connected together. *Ibid.*
11. Models and drawings are a part of the letters patent. *Ibid.*
12. A patent is to be construed by the acts in force at the time of its issue. *Ibid.*
13. The true rule of construction, in respect to patents, is to apply to them plain and ordinary principles, and not to yield to subtleties and technicalities likely to prove ruinous to a class of the community so inconsiderate and unskilled in business as men of genius and inventors usually are. *Ibid.*
14. The question whether the patent is sufficiently clear in its description, is one of law only so far as regards the construction of the written words used. *Ibid.*
15. Under the act of 1793, the specification was not necessarily made a part of the letters patent; but the inventor had a right, if he pleased, to incorporate it into the letters as a part of them. *Hogg v. Emerson*, 634.
16. The specification, when thus voluntarily annexed, became a part of the patent by general principles, as clearly as it does since by the words of the law. *Ibid.*
17. A patent for more than one invention is not void, if they are connected in their operation. *Ibid.*
18. The drawings, as well as the specifications, may be looked to for explanation of anything obscure in the patent. *Ibid.*
19. A patent is not void because it does not bear the same date with a previous foreign patent, taken out by the patentee; the monopoly, however, is limited to fourteen years from the date of the foreign patent. *O'Reilly v. Morse*, 763.
20. A patentee cannot take out a subsequent patent for a portion of his first invention, and thereby extend his monopoly. *Ibid.*
21. But the validity of a patent cannot be impeached upon the ground that it is an improvement upon a former invention. *Ibid.*
22. The claim is not to be taken alone, but in connection with the specification; the whole instrument is to be construed together. *Brooks v. Fiske*, 846.
23. Under the act of 1790, a patent was made *prima-facie* evidence; that act was repealed by the act of 1793. Hence a patent was not received in courts of justice as even *prima-facie* evidence that the invention patented was new or useful. But the act of 1836 introduced a new system, and under it—its

PATENT—*continued.*

- inquisition and examination—a patent is received as *prima-facie* evidence of the truth of the facts asserted in it. *Corning v. Burden*, 867.
25. The patentee may so restrict his claim as to cover less than he invented, yet such an interpretation should not be put upon his claim if it can fairly be construed otherwise. *Winans v. Denmead*, 887.
  26. What is the thing patented, is a question of law, to be determined by the court from the letters patent. *Ibid.*
  27. The jury are to determine whether the specifications, including the claim, are so precise as to enable any skillful person to make the thing described. *Battin v. Taggart*, 969.
  28. The Patent Acts do not operate beyond the limits of the United States ; and the patentee's right of property cannot extend beyond the limits to which the law itself is confined. *Brown v. Duchesne*, 1015.
  29. The rights of property and exclusive use granted to a patentee, do not extend to a foreign vessel entering our ports. *Ibid.*
  30. The benefit to the community at large was doubtless the primary object in granting and securing the monopoly. *Kendall v. Winsor*, 1108.
  31. This was at once the equivalent given by the public for the benefits bestowed by the genius and skill of individuals, and the incentive to further efforts. *Ibid.*

## PARTICULAR PATENTS.

1. Burden's patent for rolling puddle balls, issued December 10, 1840. *Corning v. Burden*, 867.
2. Carver's patent for ribs of cotton-gins, issued June 12, 1838 ; reissued November 16, 1839. *Carver v. Hyde*, 316.
3. Foote's patent for stoves, issued May 26, 1842. *Silsby v. Foote*, 1071.
4. Goodyear's patent for India-rubber. Shined-goods patent, issued March 9, 1844 ; soft-rubber patent, issued June 15, 1844 ; reissued December 25, 1849. *Hartshorn v. Day*, 1031 ; *Day v. Union Rubber Co.*, 1062.
5. Hanson's patent for lead pipe machines, issued March 29, 1841 ; antedated August 31, 1837 ; reissued March 14, 1846. *Le Roy v. Tatham*, 657 ; *Ibid.*, 1116.
6. McCormick's patents for harvesters, issued June 21, 1834 ; issued June 31, 1845 ; issued October 23, 1847 ; reissued May 24, 1853. *Seymour v. McCormick*, 1004 ; *McCormick v. Talcott*, 1085.
7. Morse's patents for electric telegraphs. "Magnetic," issued June 20, 1840 ; reissued January 25, 1846 ; reissued June 13, 1848. "Local Circuit," issued April 11, 1846 ; reissued June 13, 1848. "Chemical," issued May 1, 1849. House Instrument ; Columbian Instrument. *O'Reilly v. Morse*, 763.
8. Page's patent for circular portable saw-mills, issued July 16, 1841 ; extended July 17, 1855. *Phillips v. Page*, 1143.
9. Prouty & Mears' patent for plows, issued March 4, 1836. *Prouty v. Ruggles*, 311.
10. Stimpson's patent for rails for railroad carriages, issued August 23, 1831. *Stimpson v. Baltimore and Susquehanna R. R. Co.*, 535.
11. Winans' patent for eight-wheeled cars, issued October 1, 1834. *Winans v. New York and Erie R. R. Co.*, 1096.
12. Winans' patent for coal cars, issued June 26, 1846. *Winans v. Denmead*, 887.
13. Wood's patent for making brick or tiles, issued November 9, 1836. *Wood v. Underhill*, 432.
14. Woodworth's patent for planing-machines, issued December 27, 1828 ; extended November 16, 1842 ; reissued July 8, 1845 ; disclaimer as to the

PARTICULAR PATENTS—*continued.*

application of the circular saw filed January 2, 1843. *Wilson v. Rousseau*, 357; *Woodworth v. Wilson*, 428; *Brooks v. Fiske*, 846; *Livingston v. Woodworth*, 922.

## PATENTED ARTICLES OR MACHINES.

1. Under the rule laid down in *Wilson v. Rousseau*, 4 How., 646, (1845,) where the material of a combination ceases to exist, in whatever way that may occur, the right to renew depends upon the right to make the invention. If the right to make does not exist, there is no right to rebuild. *Wilson v. Simpson*, 515.
2. But it does not follow, when one of the elements of the combination has become so much worn as to become inoperative, or has been broken, that the machine no longer exists for restoration to its original use by the owner who has bought its use. When the wearing or injury is partial, then repair is restoration, and not reconstruction. *Ibid.*
3. Repairing partial injuries, whether they occur from accident or wear, is only refitting a machine for use; and it is no more than that, though it shall be a replacement of an essential part of a combination. *Ibid.*
4. But if a patented machine, as a whole, should happen to be broken so that its parts cannot be readjusted, or be so much worn as to be useless, a purchaser cannot make or replace it by another, but must buy a new one. The doing of either would be a reconstruction. *Ibid.*
5. If, however, it is a part essential to its use, then the right to repair and replace occurs. *Ibid.*
6. The right to replace the cutters in Woodworth's planing-machine is a part of the invention transferred to an assignee, as the cutters must be replaced every sixty or ninety days. *Ibid.*
7. And an assignee of a right to use such a planing-machine, who has the right to continue the use of a particular machine after the extension of the patent, may replace the cutters when worn-out, without destroying the identity of the machine. The right to replace is a part of the invention transferred. *Ibid.*
8. A replacement of temporary parts does not alter the identity of a machine, but preserves it, though there may not be in it every part of its original material. *Ibid.*
9. Contracts in relation to a patented machine are regulated by the laws of the States, and are subject to State jurisdiction. *Wilson v. Sandford*, 532.
10. A patented article, when individual property, is subject to State taxation. *Bloomer v. McQuewan*, 730.
11. The value of the machine in the hands of a purchaser for use, does not depend on the time for which the exclusive possession is granted to the patentee, nor upon the exclusion of others from its use. He does not look to the duration of the exclusive privilege, but to the usefulness of the thing he buys. *Ibid.*
12. When a patented machine rightfully passes to the hands of a purchaser from any person authorized to convey it, such machine is no longer under the peculiar protection granted to patented rights. *Chaffee v. Boston Belting Co.*, 1124.
13. By a valid sale, the patented machine becomes the individual property of the purchaser, and it is no longer protected by the laws of the United States, but by the laws of the State in which it is situated. *Ibid.*
14. The person acquiring title may continue to use the machine until it is worn-out, or may repair it. *Ibid.*

See ACTION; ADMINISTRATORS; EXTENSION.

## PENALTIES.

1. Under section 6 of the act of 1831, the penalty of fifty cents on each sheet, (whether printed, or being printed, or published, or exposed to sale.) is limited to the sheets in the possession of the defendant. *Backus v. Gould*, 495.
2. A penal statute must be construed strictly. *Ibid.*

## PLEADING.

If the matter alleged in a plea is not a bar to the action, the plaintiffs may submit the question of law to the court, or they may deny the facts alleged in the plea, and go to the jury. *Grant v. Raymond*, 146.

See DEFENSE; GENERAL ISSUE.

## PRINCIPLE.

1. The patentees claim the combination described as their invention, which can only be sustained by establishing its novelty. The question whether a newly-discovered property of lead might be patented, is not in the case. *Le Roy v. Tatham*, 657.
2. A patentee claimed the application of the expansive and contractive power of a metallic rod, by different degrees of heat, to open and close a damper: *Held*, That it was a valid claim, and that the patent was good. *Silsby v. Foote*, 1071.
3. However brilliant the discovery of a new principle may be, to make it useful it must be applied to some practical purpose. *Le Roy v. Tatham*, 1116.
4. The practical application of the principle to some useful purpose is the test of its value. *Ibid.*

See ART; EFFECT; MACHINE; MODE; NEW APPLICATION.

## PRIOR KNOWLEDGE OR INVENTION.

1. The prior construction and use of a thing, in one instance only, for private use, and which had been forgotten or abandoned, before the invention of the same thing by another who obtained a patent for it, will not invalidate such patent. *Gayler v. Wilder*, 576.
2. Where a person, F, invented an improvement in safes, for which improvement letters patent were secured in 1843, and it was proved that C, between the years 1829 and 1832, had constructed for his own use a safe substantially the same, and used the same until 1838, when it passed out of his hands, and no other trace of it was shown, and there was no evidence that F even had any knowledge of the invention and use by C: *Held*, That F was to be considered as a first and original inventor, notwithstanding the prior use by C. *Ibid.*
3. By the knowledge referred to in section 6 of the act of 1836, is meant knowledge and use existing in a manner accessible to the public. *Ibid.*
4. The original inventor, means the first inventor, subject only to the provision of section 15 of the act of 1836. The law authorizes no presumption of forgetfulness. The question is, Was C's invention prior to F's? It is of no importance that C's was only used for his *private* purpose. The invention is the question, and not the manner of its use. If F was not the original and first inventor, he is not entitled to a patent. The illustration of a lost art is not apposite to the case. *Ibid.* (McLean, J., and Daniel, J., dissenting.)  
See DEFENSES; GENERAL ISSUE; INVENTION; PUBLIC WORK.

## PRIOR USE.

1. The meaning of the words "not known or used," in section 1 of the act of 1793, is that the invention must not have been known or used *by others* be-



PRIOR USE—*continued*.

fore the application. If it were necessary for the inventor to employ others to assist him, or if before his application his invention should be used without his consent, such knowledge or use will not invalidate the patent. *Pen-nock v. Dialogue*, 127.

2. If the inventor puts his invention into public use, or sells it for public use, before he makes application for a patent, such use can be set up as a bar to his patent, under section 6 of the act of 1793. *Ibid*.
3. There may be cases in which a knowledge of the invention may be surreptitiously obtained, and communicated to the public, that do not affect the right of the inventor. Under such circumstances, no presumption can arise in favor of an abandonment of the right to the public by the inventor, though an acquiescence on his part will lay the foundation for such a presumption. *Shaw v. Cooper*, 173.
4. It would be a fair construction of section 15 of the act of 1836, that if an inventor allow another to use his invention before making application for a patent, such public use would make the subsequently-obtained patent void. But if such use is regarded as under a license, the patent might still be valid. *McClurg v. Kingsland*, 322.
5. Section 7 of the act of 1839 has exclusive reference to an original application for a patent, not to a renewal or reissue of it. *Stimpson v. West Chester R. R. Co.*, 330.

See ABANDONMENT; ARTS, LOST; DEFENSES; GENERAL ISSUE; INVENTION;  
LICENSE; REISSUE; STATUTES, CONSTRUCTION OF.

## PROCESS.

See ART; MANUFACTURE; MODE; PRINCIPLE.

## PUBLIC WORK.

A book introduced in evidence, under section 15 of the act of 1836, is not evidence of any other facts or matter contained in it, beyond the description of the invention referred to. *Seymour v. McCormick*, 1004.

See DEFENSES; GENERAL ISSUE; INVENTION.

## REISSUE.

1. Under the Patent Act of 1793, the Secretary of State had power to receive a surrender of a patent, and issue a new patent for the unexpired portion of the term, when the defect in the specification arose from mistake, without fraud or misconduct of the patentee. *Grant v. Raymond*, 146.
2. In the case of a surrender of a patent and a reissue, the new patent, and the proceedings on which it issues, have relation to the original transaction. The time of the privilege still runs from the date of the original. The second patent cannot, in any respect, be considered as independent of the first. *Ibid*.
3. The holder of a defective patent may surrender it to the Department of State, and obtain a new one. The new patent has relation to the original transaction. *Shaw v. Cooper*, 173.
4. A reissued patent being only a continuation of the first one, the rights of the patentee are to be ascertained by the law under which the original application was made. *Ibid*.
5. Evidence is admissible to show that there are differences between an original and a reissued patent, and to explain those differences. *Philadelphia and Trenton R. R. Co. v. Stimpson*, 292.
6. It is not necessary that a reissued patent should contain any recitals that the

**REISSUE—continued.**

prerequisites to the grant of it have been duly complied with, for the law presumes that they have been. *Ibid.*

7. Under the acts of 1830 and 1836, no prior use of an invention under a defective patent can take away the right to take out a new and amended one. *Stimpson v. West Chester R. R. Co.*, 330.
8. As by section 13 of the act of 1836 the Commissioner of Patents is authorized to issue a renewed patent, the inquiry afterward in regard to the surrender is limited to the question of fraud in the surrender. *Ibid.*
9. The manner in which the mistake or inadvertence may have occurred, is immaterial. The action of the government in renewing the patent must be considered as closing this point, and as leaving open for inquiry the question of fraud only. *Ibid.*
10. The Commissioner of Patents can lawfully reissue letters patent on an amended specification during the existence of an extended term. *Wilson v. Rousseau*, 357.
11. The right to surrender an old patent and to receive another was given for the purpose of enabling the patentee to give a more perfect description of his invention, when any mistake was committed in his first. *O'Reilly v. Morse*, 763.
12. It is the duty of the Commissioner of Patents to see that a reissued patent does not cover more than the first. *Ibid.*
13. It is presumed that the reissued patent does not cover more than the original. *Ibid.*
14. Variations from the former specification do not necessarily imply that it is for a different discovery, as the right to surrender is given for the purpose of enabling the patentee to give a more perfect description. *Ibid.*
15. Whether the defect be in the specification or claim, under section 13 of the act of 1836 the patentee may, by an amended specification or claim, cure the defect. When the specification or claim is so vague as to be inoperative or invalid, an amendment may give it validity. *Battin v. Taggart*, 969.
16. The reissued patent must be for substantially the same invention, though it be described in terms more precise and accurate than in the former patent. But a new and different invention cannot be claimed. *Ibid.*
17. The describing a part of a machine in the first patent, but without making any claim to it, does not deprive the inventor of a right to a patent for such part. *Ibid.*

See **ALIENS; COMMISSIONER OF PATENTS; DEFENSES; DISCLAIMER; EXPERTS; FRAUD; INFRINGEMENT; JURY; MISTAKES IN PATENTS.**

**REPORTS.**

No reporter can have any copyright in the written opinions of a court, nor can the judges confer on any reporter any such right. *Wheaton v. Peters*, 200.

**REPEAL OF PATENT.**

See **COURTS.**

**RESTRAINT OF TRADE.**

An agreement stipulating that, under certain conditions, one party shall cease the manufacture of a patented article, is not void as being in restraint of trade. *Kinsman v. Parkhurst*, 997.

**REVERSED CASES.**

See **EXAMINED CASES.**

## SECRET USE OF INVENTION.

An inventor who designedly, and with the view of applying an invention indefinitely and exclusively for his own profit, withholds it from the public, comes not within the policy of the acts of Congress, and is not entitled to favor, if during such concealment another person should bring into use the same invention. *Kendall v. Winsor*, 1108.

See ABANDONMENT.

## SPECIFICATION.

1. The specification has two objects: one, to make known the manner of constructing the invention; the other, to put the public in possession of what the party claims as his own invention. • *Evans v. Eaton*, 48.
2. A specification which mixes up the new and the old, but does not explain what is the nature or limit of the invention claimed, cannot be sustained. *Ibid.*
3. All that the law requires is that the specification should be clear enough to be understood by ordinary mechanics, and that the thing described could be made from it, considering the specification as a whole, and adverting to the drawings on file. *Hogg v. Emerson*, 634.

See COMBINATION; COMPOSITION OF MATTER; DEFENSES; DRAWINGS; FORM; OATH; PATENT.

## STATUTES, CONSTRUCTION OF.

1. The act of January, 1808, for the relief of Oliver Evans, is not to be construed so as to exempt, either from treble or single damages, the use subsequent to the passage of such act of the machinery mentioned therein, which was erected subsequent to the expiration of the original patent and previous to the passage of such act. *Evans v. Jordan*, 3.
2. The right to recover damages for using his patent arises not under this law, but under the general Patent Law of 1793. *Ibid.*
3. Though, under the general Patent Law, a doubt might arise whether improvements on different machines could be comprehended in the same patent, so as to give a right to the exclusive use of the several machines separately, as well as a right to the exclusive use of those machines in combination, the "act for the relief of Oliver Evans" authorizes the issuing to him of a patent granting to him the full and exclusive right in his invention and improvements in the art of manufacturing flour, and in the several machines he has invented, discovered, improved, and applied to that purpose. *Evans v. Eaton*, 8.
4. Taking the whole together, his patent, under such act, is to be construed as a grant of the general result of the whole machinery and of the improvements in each machine; and he may claim under his patent the exclusive use of his inventions and improvements in the art of manufacturing flour, and in the several machines which he has invented, and in his improvements on machines previously discovered. *Ibid.*
5. Many of the provisions of our Patent Acts are derived from the principles and practice which have prevailed in the construction of those of England. *Pennock v. Dialogue*, 127.
6. The Patent Act of 1790 used the words "not known or used before," without adding the words "the application," in connection with the structure of the sentence in which they stand; they might have referred either to the time of the invention or of the application. The addition of the latter words in the act of 1793 must have been *ex industria*, and with the intention to clear away a doubt. *Ibid.*

STATUTES, CONSTRUCTION OF—*continued.*

7. The settled purpose of the United States has ever been to confer on the authors of useful inventions an exclusive right in their inventions for the time mentioned in their patent. The laws which are passed to give effect to this purpose ought to be construed in the spirit in which they have been made, and should be fairly executed on the part of the United States. *Grant v. Raymond*, 146.
8. The great object of the Patent Acts is to secure to the public the advantages to be derived from the discoveries of individuals, and the means it employs are the compensation made to those individuals for the time and labor devoted to these discoveries, by the exclusive right to make, use, and sell the things discovered for a limited time. *Ibid.*
9. The "copyright" recognized by the act of 1790, is presumed to be the right of property which an author has at common law in his manuscript. This protection is given as well to books published as to manuscript copies. *Wheaton v. Peters*, 200.
10. The proviso of section 3 of the act of 1832, is in affirmance of the principles laid down by the Supreme Court in *Pennock v. Dialogue*, 2 Pet., 1; *Grant v. Raymond*, 6 Pet., 241-45; and *Shaw v. Cooper*, 7 Pet., 314, 315. *McClurg v. Kingsland*, 322.
11. As the exception in the proviso is limited to the use of the invention under a special license, after the grant of the original patent, it leaves the use prior to the application for such patent clearly obnoxious to the principle established in *Pennock v. Dialogue*, 2 Pet., 1 (1829), whereby the patent would become void. *Ibid.*
12. The object of section 7 of the act of 1832, is, first, to protect the person who has used the thing patented from any liability to the patentee or his assignee; and, second, to protect the rights granted to the patentee against any infringement by any other person. *Ibid.*
13. This section relieved the patentee from the effects of the former laws, while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor; which, if given before the application for a patent, would justify a continued use of it after it issued, without liability. *Ibid.*
14. It is not limited to patents for machines, but embraces inventions for modes of doing a thing, as a new improvement in the art of casting iron. *Ibid.*
15. The words "newly-invented machine, manufacture, or composition of matter," and "such invention," mean the "invention patented," and the words "specific machine," refer to "the thing as originally patented," but not to any newly-invented improvement on a thing once patented. *Ibid.*
16. Prior to the act of 1832, the only mode of prolonging the term of a patent was by means of private acts of Congress. *Wilson v. Rousseau*, 357.
17. The meaning of the words "things patented," in the latter part of section 18 of the act of 1836, when construed in connection with the simple right to use, without the right to make and vend, has reference to the machine patented. *Ibid.*
18. The phrase "to the extent of their interests therein," means their interests in the patented machines, be that interest in one or more at the time of the extension. *Ibid.*
19. After the act of 1790, the petition alone seldom contained anything as to the patent beyond a mere title; sometimes fuller, and again very imperfect and general, with no other allegations, or suggestions, or descriptions whatever, except those in the schedule or specification. *Hogg v. Emerson*, 438.
20. But the specification, being filed at the same time, and often in the sam-

STATUTES, CONSTRUCTION OF—*continued.*

paper, seems to have been regarded as a part of it. To comply with the law, by inserting in the patent at least the substance of the petition, the officers inserted, by express reference, the whole descriptive portion of it as contained in the schedule. *Ibid.*

21. The phraseology of the act of 1836, in respect to what the patent shall contain, was changed from that of the acts of 1790 and 1793, in order to conform to the usage and construction under the act of 1793. *Ibid.*
22. A formal transfer of a copyright, by the act of 1834, is required to be proved and recorded as a deed for the conveyance of land, and such record operates as a notice. *Little v. Hall*, 989.

## SUGGESTIONS.

Information or advice received from men of science, in the course of an inventor's researches, will not impair his right to the character of an inventor. *O'Reilly v. Morse*, 763.

## SUPERSEDEAS.

Where an appeal from a decree is taken within ten days from the rendition of the decree, it is in time to operate as a *supersedeas*; and so also if taken within ten days after the decree is settled and signed. *Silsby v. Foote*, 1065.

## WITNESSES.

See EVIDENCE; MODELS.

## WRIT OF ERROR.

1. A judgment of a Circuit Court, rendered upon an agreed statement of facts, may be reëxamined by this court on a writ of error. *Stimpson v. Baltimore and Susquehanna R. R. Co.*, 535.
2. A writ of error will not lie from an act the doing of which was a matter of discretion with the court. *Silsby v. Foote*, 717.
3. A second writ of error brings up for revision nothing but the proceedings subsequent to the mandate. *Sizer v. Many*, 937.
4. Where, after the mandate, the court below did nothing but tax the costs, and these amounted to less than two thousand dollars: *Held*, That no writ of error would lie. *Ibid.*

See APPEAL; BILLS OF EXCEPTIONS.











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